THE PATENTS AND DESIGNS ACT 1907.

J. ROBERTS
AND
H. FLETCHER MOULTON.

4/- Net

B2g L13
ROB

MIDDLE TEMPLE LIBRARY
WITHDRAWN STOCK

KN 1141 ROB

Price 25/- net.

THE

GRANT AND VALIDITY

OF

BRITISH PATENTS

FOR

INVENTIONS.

By JAMES ROBERTS, Esq.,

M.A., LL.B.

EXTRACTS FROM PRESS NOTICES.

"The valuable feature of this book is, that each statement of principle is backed up and illustrated not by a mere cursory reference to cases that support it, but by a careful statement of the facts of the case, and of the point upon which the decision hinged. We commend the book to inventors and others as an honest and laborious attempt to touch the rock bottom upon which those principles are built which govern the validity or non-validity of patents for inventions."—*The Law Journal.*

"Under the new procedure of the Patents Act, 1902, objections on the ground of anticipations will be made by the Comptroller before the grant of the Patent, so the inventor will have to consider these questions before the grant is made. It is for the purpose of enabling him to do this thoroughly and effectively that Mr. Roberts has written this work."—*Law Magazine and Review.*

"In making the abstracts of cases no trouble seems to have been spared to elucidate the facts, and Mr. Roberts merits high praise for the trouble and pains he has bestowed; in fact, so far as we are aware, nothing similar has been produced before."—*Engineering.*

"The treatment of opposition and amendment is more exhaustive, more thoroughly lucid, and better illustrated by typical cases that have been decided, than in the case of any treatise on Patent Law that we have yet come across . . . . on the ground which he does cover, Mr. Roberts is singularly lucid, convincing and compendious . . . . the collection of cases is singularly representative."—*Automotor Journal.*

"The author lays great stress upon claims; and rightly so. In our opinion this important part is never dealt with in works on patents as it should be."—*The Auto-Car.*

London: JOHN MURRAY, Albemarle Street, W.

THE PATENTS AND DESIGNS ACT, 1907.

Digitized by the Internet Archive
in 2026

https://archive.org/details/patentsdesignsac0000jame

THE

Patents and Designs Act, 1907

WITH NOTES

AND THE

PRACTICE THEREUNDER.

BY

JAMES ROBERTS, ESQ.

Of the Inner Temple, Barrister-at-Law

AND

H. FLETCHER MOULTON, ESQ.

Of the Middle Temple, Barrister-at-Law.

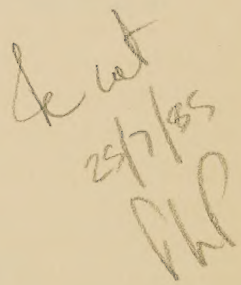
LONDON:

BUTTERWORTH & CO., 11 & 12, BELL YARD, TEMPLE BAR, W.C.

Law Publishers.

1907.

EYRE AND SPOTTISWOODE,
His Majesty's Printers,
EAST HARDING STREET, LONDON, E.C.



PREFACE.

THIS book does not pretend to be a treatise on Patent Law. There are already many excellent works on the existing Patent Law, and it will not, for a considerable time and until there have been many judicial decisions, be possible to write a treatise on the new Law. This book is an attempt to fill the gap which must therefore necessarily exist. Its object is to give assistance to the reader in the interpretation of the new enactments and to point out their practical effects.

The new Act introduces many changes in the law affecting the rights of patentees, and in many cases, as, for example, the provisions relating to compulsory working and the prohibition of restrictive conditions in licences, these changes have evidently been suggested to the framers of the Act by the laws of other countries. The authors have, of course, not discussed the wisdom of these changes, this being a practical guide to the law as enacted, and they have finally considered that no useful purpose would be attained by discussing the working of foreign laws. This is an English Act, and, whatever was in the minds of its framers, must be interpreted according to the principles of English Law, and the decisions of foreign Courts on foreign statutes of different wording would give little assistance in such interpretation. Moreover the interpretations put by the Courts of different foreign countries on, for example, the law of compulsory working, are so conflicting that they afford no guide.

Many of the new provisions are unfortunately framed in language which is far from clear. The authors have

not attempted in such cases to dogmatise on points which must necessarily await judicial decision, the result of which is in many cases highly doubtful. But they have tried to indicate these difficulties and to call attention to both aspects of the questions involved so as to enable persons dealing with patents to appreciate the dangers ahead of them in any particular case.

It must be remembered that in actual practice it is rare to find a case where all the difficulties attending the interpretation of a particular enactment occur together, and in cases where the authors have not felt competent to give an opinion as to the general application of a particular section, the reader may find enough to assist him in the special circumstances of the case in hand.

In the notes the authors have chiefly directed their attention to changes in the law, but they have also added brief notes of decisions and other information where they thought it would be useful.

In the introduction the authors have endeavoured to summarise the changes in the law and also to give sufficient information to enable this book to be a guide to the practice before the Comptroller.

The authors take this opportunity of expressing their indebtedness to Mr. J. W. Gordon for several valuable suggestions, and also to Dr. William Martin for information on certain points of Patent Practice.

JAMES ROBERTS,
H. FLETCHER MOULTON.

TEMPLE,
October 1907.

CONTENTS.

	PAGE
TABLE OF CASES	xii
INTRODUCTION :—	
INTRODUCTORY NOTE	1
THE JURISDICTION AND POWERS OF THE COMPTROLLER ...	2
THE JURISDICTION AND POWERS OF THE BOARD OF TRADE	3
THE JURISDICTION AND POWERS OF THE COURT ...	3
APPLICATION FOR LETTERS PATENT	3
FIRST EXAMINATION	6
EXAMINATION OF COMPLETE SPECIFICATION	6
CONSTRUCTION OF CLAIMS	9
OPPOSITION TO GRANTS	12
THE OBJECT OF EVIDENCE BEFORE THE COMPTROLLER ...	14
CONVENTION APPLICATIONS	18
SEALING OF THE PATENT	20
PATENTS OF ADDITION	20
AMENDMENT	20
REVOCATION BY THE COMPTROLLER	22
REVOCATION BY THE BOARD OF TRADE AND COMPULSORY LICENCES	24
REVOCATION BY THE COURT	24
RESTORATION OF LAPSED PATENT	26
ABANDONMENT OF PATENT	26
PROLONGATION OR EXTENSION OF TERM OF A PATENT ...	26
ACTIONS FOR INFRINGEMENT...	27
THREATS	27
REGISTER OF PATENTS	28
RIGHTS OF CO-OWNERS OF THE PATENT	30
CROWN, WAR OFFICE AND ADMIRALTY	30
DUTIES OF THE PATENTEE	30
DESIGNS	31
APPLICATION FOR REGISTRATION OF DESIGNS	31
COPYRIGHT IN DESIGNS	33
REGISTER OF DESIGNS	34
OTHER POINTS IN THE LAW AS TO DESIGNS	34
PATENT AGENTS	34

THE PATENTS AND DESIGNS ACT, 1907.

PART I.

PATENTS.

Application for and Grant of Patent.

SECTION		PAGE
1.	Application	36
2.	Specifications	36
3.	Proceedings upon application	37
4.	Provisional protection	38
5.	Time for leaving complete specification	38
6.	Comparison of provisional and complete specification	38
7.	Investigation of previous specifications in United Kingdom on applications for patents	40
8.	Investigation of specifications published subsequently to application	42
9.	Advertisement on acceptance of complete specification	43
10.	Effect of acceptance of complete specification	44
11.	Opposition to grant of patent	44
12.	Grant and sealing of patent	47
13.	Date of patent	48
14.	Effect, extent, and form of patent	48
15.	Fraudulent applications for patents	49
16.	Single patent for cognate inventions	49

Term of Patent.

17.	Term of patent	50
18.	Extension of term of patent	51
19.	Patents of addition	53

Restoration of lapsed Patents.

20.	Restoration of lapsed patents	54

Amendment of Specification.

21.	Amendment of specification by Comptroller	56
22.	Amendment of specification by the court	57
23.	Restriction on recovery of damages	58

Compulsory Licences and Revocation.

24.	Compulsory licences and revocation	58
25.	Revocation of patent	60
26.	Power to Comptroller to revoke patents on certain grounds	61
27.	Revocation of patents worked outside the United Kingdom	63

Register of Patents.

28.	Register of patents	65

Crown.

SECTION		PAGE
29.	Patent to bind Crown	65
30.	Assignment to Secretary for War or the Admiralty of certain inventions	66

Legal Proceedings.

31.	Hearing with assessor	68
32.	Power to counterclaim for revocation in an action for infringement	68
33.	Exemption of innocent infringer from liability for damages	69
34.	Order for inspection, &c., in action	72
35.	Certificate of validity questioned and costs thereon	72
36.	Remedy in case of groundless threats of legal proceedings	72

Miscellaneous.

37.	Grant of patents to two or more persons	73
38.	Avoidance of certain conditions attached to the sale, &c. of patented articles	74
39.	Costs and security for costs	78
40.	Procedure on appeal to law officer	79
41.	Provision as to anticipation	79
42.	Disconformity	80
43.	Patent on application of representative of deceased inventor	81
44.	Loss or destruction of patent	82
45.	Provisions as to exhibitions	82
46.	Publication of illustrated journal, indexes, &c.	82
47.	Patent Museum	83
48.	Foreign vessels in British waters	83

PART II.

DESIGNS.

Registration of Designs.

49.	Application for registration of designs	83
50.	Registration of designs in new classes	84
51.	Certificate of registration	84
52.	Register of designs	85

Copyright in registered Designs.

53.	Copyright on registration	85
54.	Requirements before delivery on sale	86
55.	Effect of disclosure on copyright	87
56.	Inspection of registered designs	88
57.	Information as to existence of copyright	88
58.	Cancellation of registration of designs used wholly or mainly abroad	89

Industrial and International Exhibitions.

59.	Provisions as to exhibitions	89

Legal Proceedings.

SECTION		PAGE
60.	Piracy of registered design	90
61.	Application of certain provisions of the Act as to patents to designs	90

PART III.

GENERAL.

Patent Office, and Proceedings thereat.

62.	Patent Office	91
63.	Officers and clerks	91
64.	Seal of Patent Office	92

Fees.

65.	Fees	92

Provisions as to Registers and other Documents in Patent Office.

66.	Trust not to be entered in registers	92
67.	Inspection of and extracts from registers	92
68.	Privilege of reports of examiners	92
69.	Prohibition of publication of specification, drawings, &c., where application abandoned, &c.	93
70.	Power for Comptroller to correct clerical errors	93
71.	Entry of assignments and transmissions in registers	93
72.	Rectification of registers by court	94

Powers and Duties of Comptroller.

73.	Exercise of discretionary power by Comptroller	95
74.	Power of Comptroller to take directions of law officers	95
75.	Refusal to grant patent, &c. in certain cases	95
76.	Annual reports of Comptroller	95

Evidence.

77.	Evidence before Comptroller	95
78.	Certificate of Comptroller to be evidence	96
79.	Evidence of documents in Patent Office	96
80.	Transmission of certified printed copies of specifications, &c.	96
81.	Applications and notices by post	97
82.	Excluded days	97
83.	Declaration by infant, lunatic, &c.	97

Register of Patent Agents.

84.	Register of patent agents	97
85.	Agents for patents	98

Powers, &c., of Board of Trade.

86.	Power for Board of Trade to make general rules	98
87.	Proceedings of the Board of Trade	99
88.	Provision as to Order in Council	100

Offences.

SECTION PAGE
89. Offences - - - - - - - - - 100
90. Unauthorised assumption of Royal Arms - - - - 101

International and Colonial Arrangements.

91. International and Colonial arrangements - - - 101

Definitions.

92. Provisions as to "the court" - - - - - 104
93. Definitions - - - - - - - - 105

Application to Scotland, Ireland, and the Isle of Man.

94. Application to Scotland - - - - - - 106
95. Application to Ireland - - - - - - 108
96. Isle of Man - - - - - - - - 108

Repeal, Savings, and Short Title.

97. Saving for prerogative - - - - - - 108
98. Repeal and savings - - - - - - - 109
99. Short title and commencement - - - - - 109
SCHEDULES.

APPENDIX.
Abstracts of recent Comptroller's cases - - - - 112
Table of corresponding sections of old and new Acts - - 114

INDEX - - - - - - - - - - 120

TABLE OF CASES.

PAGE

Application, in the matter of an - - - - - 104, 114
Arnold *v.* Bradbury- - - - - - - 9
Automatic Weighing Machine Co. *v.* Knight - - - 14
Avery's Patent - - - - - - - - 4

Bailey *v.* Roberton - - - - - - - 81
Barstow's Patent - - - - - - - 47
Betts *v.* Menzies - - - - - - - 11, 17
Blank *v.* Footman, Pretty & Co. - - - - - 87, 88
British Dynamite Co. *v.* Krebs - - - - - 11
Brooks, Ltd. *v.* Lycett, Ltd. - - - - - 58, 63, 72

Casey's Patents - - - - - - - 29, 92
Castner-Kellner Alkali Co. *v.* Commercial Development Corporation - - - - - - - - 81
Cera Light Co. *v.* Dobbie - - - - - - 40
Crist's Application- - - - - - - 13, 112
Cropper *v.* Smith - - - - - - - 63
Crossley *v.* Derby Gaslight Co. - - - - - 72

Dege's Patent - - - - - - - 69
Deutsche Gold, &c. - - - - - - - 20
Duckett *v.* Whitehead - - - - - - 16
Dudgeon *v.* Thomson - - - - - - - 58
Dunnicliffe *v.* Mallet - - - - - - 74

Electric Construction Corporation *v.* Imperial Tram Co. - 10, 80
Elves *v.* Crofts - - - - - - - 78

Fletcher's Patent - - - - - - - 29

Gadd *v.* Mayor of Manchester - - - - - 81
Glossop's Patent - - - - - - - 46
Guest and Barrow's Patent - - - - - 15

Hall's Patent - - - - - - - - 63
Hattersley *v.* Hodgson - - - - - - 113
Hattersley and Jackson's Patent - - - - 113, 114
Haworth *v.* Hardcastle - - - - - - 10
Hoffman's Application - - - - - - 14
Hopkinson *v.* The St. James' and Pall Mall Electric Light Co., Ltd. 58
Hothersall *v.* Moore - - - - - - - 87
Humpherson *v.* Syer - - - - - - - 80

Incandescent Gas Light Co. *v.* Brogden - - - - 60
Incandescent Gas Light Co. *v.* Cantelo - - - - 60

PAGE

Ingram *v.* Edwards Bros. - - - - - - - 87

Johnson *v.* Bailey - - - - - - - - 86

Kaye *v.* Chubb - - - - - - - - 16
Kempton and Mollan's Application - - - - 112

Lancaster's Application - - - - - - - 13
Lang's Patent - - - - - - - - 22, 58
Lynde's Application - - - - - - - - 14
Lyons *v.* Goddard - - - - - - - 16

MacEvoy's Patent - - - - - - - - 47
Mallan *v.* May - - - - - - - - 77
Mathers *v.* Green - - - - - - - - 73

Meyenberg and Clayton Aniline Co.'s Application- - - 112
Meyer's Application - - - - - - - - - 46, 47
Mica Insulator Co. *v.* Electrical Co., Ltd. - - - 9
Morton's Design - - - - - - - - - 87
Moser *v.* Marsden - - - - - - - - 58

National Co. *v.* Gibbes - - - - - - - - 73
Newall *v.* Elliott - - - - - - - - 81
Newton's Application - - - - - - - - - 15
Nobel *v.* Anderson - - - - - - - - 66
Nuttall *v.* Hargreaves - - - - - - - - - 40

Owen's Patent - - - - - - - - 22, 58

Pickard *v.* Prescott - - - - - - - - 80
Pneumatic Tyre Co. *v.* Leicester, &c. - - - - 81
Presto Gear-case Co. *v.* Orme, Evans & Co. - - - 68

R. *v.* C. G. of Patents, ex parte Tomlinson - - - 46
R. *v.* Mussary - - - - - - - - 25
Robertson *v.* Purdey - - - - - - - 9

Sheehan *v.* G.E.R. - - - - - - - 74
Sherwood and Cotton *v.* Decorative Art Tile Society - - 90
Steers *v.* Rogers - - - - - - - - 73
Sugg *v.* Bray - - - - - - - - 28

Thomas and Prevost's Application - - - - - - 13, 112
Tomlinson's Case - - - - - - - - - - 46, 47
Tubes, Ltd. *v.* Perfecta, &c. - - - - - - - 10
Turner *v.* Winter - - - - - - - - - 25

Van Gelder Apsimon & Co. *v.* Sowerby Bridge Flour Society, Ltd. - - - - - - - - - - - - - 94
Viola *v.* Sharpe - - - - - - - - - - 29

PAGE

Walker & Co. *v.* Falkirk Iron Co. - - - - - - 31
Wedekind *v.* The General Electric Co. - - - - - 86
Winfield *v.* Snow - - - - - - - - - - 88
Wilfley Ore Concentrator Syndicate, Ltd. *v.* Guthridge, Ltd. - 15
Woodward *v.* Sansum - - - - - - - 81
Woolley *v.* Broad - - - - - - - - 87
Woolfe *v.* Automatic Picture Gallery - - - 63

THE PATENTS AND DESIGNS ACT, 1907.

[7 Edw. 7. Cap. 29.]

INTRODUCTION.

Introductory Note.

THIS new Act consolidates and amends the statute law as embodied in the Patents, &c., Acts, of the years 1883, 1885, 1886, 1888, 1901, and 1902.

The amendments of the law were embodied in the Patents and Designs (Amendment) Bill, 1907. That Bill was passed through its various stages in advance of the Patents and Designs (Consolidation) Bill, 1907. After the former had passed the third reading in the House of Lords, the Consolidation Bill came up on Report from the Committee stage in that House on 26th August. At that final stage a large number of amendments were moved, the effect of which was to embody the whole of the Amendment Bill in the Consolidation Bill, together with a few other amendments. These final amendments account for the discrepancies between certain corresponding sections in the two Acts.

The two Acts received the Royal Assent on the 28th August, but as the Patents and Designs Act, 1907 (formerly the Consolidation Bill), repeals the Amending Act (7 Edw. 7. c. 28), the latter was only for a few moments the law of the land. It remains merely as a guide to the history of the amendments, without which parts of the second Act would not be very intelligible. A table showing the sections of the repealed Acts and the corresponding sections of the new Act is inserted in the Appendix.

In the following pages a summary of the procedure is given, and the notes to the sections deal with the amendment and alterations in the law finally embodied in the new Act. The numbers in heavy type refer to the pages of the *Grant and Validity of British Patents for Inventions*,* in which the subject of procedure on taking out a patent is dealt with in detail.

* By James Roberts. Published by John Murray, London.

The new Act, like the preceding Acts of 1852 and 1883, has not modified substantially the essentials of patent law either in regard to what is patentable or what is an infringement, and the validity of the patent is still to be determined by seeing whether it is within the words of the exceptions contained in the sixth section of the Statute of Monopolies, which, while declaring all monopolies void except grants for fourteen years for "any "manner of new manufactures within this realm to the true "and first Inventor and Inventors of such manufactures which "others at the time of making such Letters Patent and Grants "shall not use so as also they be not contrary to the law or "mischievous to the State by raising prices of commodities at "home or hurt of trade or generally inconvenient" (*Grant, &c., of Patents*, **1**).

It has, however, substantially altered the law as to the rights and duties of patentees, and the machinery for dealing with the various questions arising in connection with patents. This machinery is exercised by three bodies :—The Comptroller-General of Patents, the Board of Trade, and the Court, and it is proposed first to examine briefly the changes in their respective jurisdictions and powers.

The Jurisdiction and Powers of the Comptroller.

The jurisdiction of the Comptroller has been altered in three respects ; first, his jurisdiction as to the granting of patents has been extended by giving him the power to refuse a patent altogether on his own initiative in certain specified cases, by extending the limits of the search to be made in the Patent Office for the purpose of seeing what references are necessary, and by enlarging the grounds of opposition before him. With regard to these matters the appeal is still to the law officers. Secondly, he has been relieved of the duty of deciding as to what amendments, if any, should be allowed during the pendency of legal proceedings. Thirdly, he has been given entirely new jurisdiction as to revocation of patents and the revival of lapsed patents. The appeal with regard to these matters is to the Court. New duties not involving jurisdiction have been assigned to him with a view to assisting the Court in relation to the prolongation of patents and amendment while legal proceedings are pending. He is also given new powers as to

prolongation and other matters with regard to designs. He is also given powers to refuse to recognise certain persons as patent agents.

The Jurisdiction and Powers of the Board of Trade.

The jurisdiction of the Board of Trade has not been substantially modified. It is, as before, confined to the question of compulsory licences, with the accompanying power of revocation; but, should it decide to refer the question, it will in future refer it, not to the Privy Council, but to a Judge of the High Court, whose decision will be final. The power of making new rules is also continued to the Board of Trade, and enlarged. It is also given further powers with reference to preventing certain persons being recognised as Patent Agents.

The Jurisdiction and Powers of the Court.

The jurisdiction of the court has been altered in that it has now power to grant an extension of Letters Patent. It may also revoke a patent on many new grounds, and has to consider these grounds and others in connection with infringement actions. It may also have to consider references to it from the Board of Trade, and questions as to compulsory licences. A new action for groundless threats in regard to registered designs has been created. The Court also has to act in certain cases as a Court of Appeal from the Comptroller. Provision has also been made for certain business in regard to patents being assigned to a particular judge, and in certain cases a decision of this judge is rendered final, which is believed to be the first instance of an executive judgment in a civil case being without appeal. New rules are also to be made by the Court with regard to certain business before it.

Application for Letters Patent.

The mode of application for a patent remains unchanged. The following classes of persons may obtain Letters Patent :—

(1) Inventors in this country.
(2) Persons in this country to whom an invention has been communicated from abroad.
(3) Legal representatives of deceased inventors.
(4) Persons entitled under the International Convention.

Special Forms A. and A.1 are provided for the applications for the first two classes. It has never been decided whether a patent is invalid because applied for on Form A as an original invention, whereas in fact it is a communication from abroad, though the matter was discussed in *Avery's Patent*, 4 R.P.C. 322. Should an applicant desire to protect for his own benefit a process which he has seen abroad, but which he believes to be novel in England, he should apply as an original inventor, as the English law considers the importer of an invention as an inventor (**48, 50**).

The application by the representatives of a deceased inventor is made substantially in the same way [sections 5, 43]. The limit of six months formerly prescribed is now removed.

The application must contain a declaration that the applicant, or one of them, is the true and first inventor, and, in the case of a deceased inventor, that the legal representative applying believes him to have been the true and first inventor [sections 1 (3), 43 (2)].

The application may be accompanied either by a provisional or a complete specification (*Grant, &c. of Patents*, **100**, *et seq.*). An application for provisional protection consists of (1) the application Form A (or, for inventions communicated from abroad, Form A.1), stamped £1, duly filled in and signed by the applicant; and (2) the provisional specification, Form B, in duplicate. This form does not require to be stamped (**106**). Forms are usually kept on sale at certain chief post offices in London and certain towns in the United Kingdom (**590**).

A provisional specification must describe the nature of the invention [section 2 (1)]. It should describe it generally and fairly, and need not give the mode of carrying it into practice, though it may do so (**55, 56**). There is no objection to a provisional specification first describing the invention in wide terms, so as to cover possible developments which the inventor may foresee, and then describing, by way of example, some particular form which the inventor has tested and is sure of. It must commence with a title indicating the subject-matter of the invention [section 2 (4)]. This should not be too narrow, for, on the one hand, any part of the invention described in the provisional may be omitted from the complete specification, but, on the other hand, the claims may be restricted by reference to the title in the subsequent interpretation of the specification.

The provisional specification should describe one invention only, as a patent will only be granted for a single invention ; but an error in this respect is not usually fatal, as the Comptroller generally permits the grant to be divided after the examiner discovers and reports on the application.

It is most important to bear in mind the fact that the patent when granted dates from the application [section 13]. The date of application therefore is that with regard to which questions as to the novelty of anything described or foreshadowed in the provisional are decided, and the rights of a patentee with regard to them determined as against other inventors.

As the applicant develops his invention he may now put in two or more supplementary provisional specifications for inventions which are "cognate or modifications one of the other," the Comptroller may accept one complete specification for them and include them in one patent, if he is of opinion that they "constitute a single invention" (**107**) ; but as regards validity or opposition to the grant the novelty of each is to be tested as of the date of the corresponding provisional specification [section 16]. Rules must be made to provide for the identification of the several claims with their respective provisional specifications.

When the application is accompanied by a complete specification, Forms A. or A.1 are used as before, as the case may require. But for applications made under the International Convention another form, A.2 is used. With the application the complete specification, Form C., stamped £3, and an unstamped duplicate are lodged (**111**). The conditions to be fulfilled in the complete specification remain unaffected by the recent amendments in the law (**111–114**). Briefly, these are that the specification must describe the invention so that a workman having an ordinary knowledge of the trade in question could carry it out, and that the claims must clearly indicate the scope of the invention and claim only what is novel and useful.

Formerly the Comptroller might require drawings to be supplied along with the specifications, now he may require them to be delivered either at that stage or a later period, if on examination of the specifications it appear desirable that further drawings should be supplied to elucidate the description of the invention. The drawings so supplied form part of the respective specifications [section 2 (3)].

If the invention be a chemical one, the Comptroller may now require typical samples and specimens to be supplied before the acceptance of the complete specification [section 2 (5)].

First Examination.

When the application is made, it and the specification are thereupon referred to an examiner whose duty it is to ascertain and report whether the nature of the invention has been fairly described, and the application, specification, &c. are in proper form, and the rules have been observed (**108**).

If the examiner report that the required conditions have not been fulfilled, the Comptroller may refuse to accept the application, or require it to be amended, and in the latter event may direct that the application bear the date on which his requirements have been complied with (**108**). Where the irregularity consists in the applicant having included more than one invention in his specification the Comptroller will require it to be confined by amendment to one invention, and may allow the other inventions to be made the subject of separate applications bearing the same date as the original application. When the application has been accepted its date is determined, and is the date from which the patentee's rights run (**107**).

That first examination of the application takes place in all cases. There is a material difference in the extent and effect of this examination in cases in which there is a provisional specification from those in which a complete specification is lodged with the application. In the former case there is no examination of the claims of the applicant until after the date of the application and consequent date of the patent has been fixed. It is on the general statement of the "nature of the invention" that the applicant's claim to a particular date for his patent is based. The claims merely limit the scope of the monopoly more precisely, and must therefore keep within the ambit of the invention described in the provisional specification (**64**).

Examination of the Complete Specifications.

Where an application is accompanied by a complete specification, it is referred to an examiner and dealt with in the same way as a provisional specification.

In cases where there is filed with the application only a provisional specification, the applicant is allowed six months wherein

to file a complete specification [section 5]. On payment of the prescribed fee an extension of one month will be allowed by the Comptroller. If a complete specification be not left, the application is deemed to be abandoned. Both specifications are referred to an examiner who examines and reports whether the invention particularly described in the complete is substantially the same as that in the provisional, and whether the complete has been prepared in the prescribed manner [section 6 (1)].

If the report be unfavourable, the Comptroller may refuse to accept the complete specification, unless and until it is amended to his satisfaction [section 6 (2)]. If the examiner report that the invention described in the complete specification is not substantially the same as that in the provisional, the Comptroller may refuse to accept it until it is amended, or, with the consent of the applicant, he may cancel the provisional specification, and treat the case as an application with a complete specification only; or he may allow the original application to proceed, and treat the claim made for the additional invention as one for that invention made on the date the complete specification was left. In either case the application for the new features of the invention is to be taken as made on the date the complete specification was left [section 6 (3)].

It is on lodging the complete specification which contains the claims (whether with the application or six months later) that the official and partial search as to the novelty of the invention is made [section 7 and notes]. The section directs that the inquiry is to be for the purpose of ascertaining whether the "invention *claimed* has been wholly or in part *claimed or described* in any specification, &c." It does not deal with the case of an invention which consists only of an improvement on an existing invention, or of an invention which cannot be used except along with some invention the subject of a prior patent. Hence, if the applicant's specification be confined to what is wholly novel the Comptroller has no jurisdiction to require a reference to any previous specification, not even to that on which the applicant's is an improvement.

In practice the search is conducted by assistant examiners who report to the "examiner" in charge of the particular application. The applicant is informed by the office of any defects in his application, and the provisions of section 6 come into operation. If the application be made with a complete

specification the applicant will also receive a notice of the earlier specifications in which it appears that his invention as claimed has been "wholly or in part claimed or described" [section 7]. If the examiner find a previous specification in which the whole of the applicant's invention has been described, the search will not be pursued further, but a provisional report be made and due notice given to the applicant.

On receipt of notices of defects in his application, or of the results of the search, the applicant must consider the amendment of his specification. In the case of prior specifications being cited as disclosing his invention, he must endeavour to recast his specification, or claims, so as to confine his claims to what is really novel. Two months is the time allowed for these amendments. If the matter presents any difficulties the applicant or his agent may apply to the Patent Office for an interview with the examiner in charge of his application. Due notice will be given him of the time appointed. At that informal hearing the applicant, or his agent or counsel, have a friendly argument with the examiner which facilitates the subsequent proceedings. When amendments have been made the specification is again submitted officially for another examination.

If the applicant cannot accept the examiner's view or persuade him that it is erroneous, he must amend his patent so as to keep clear of the prior inventions which he is alleged to have included in his claim, or he may apply for a hearing before the Comptroller. Unless he satisfy the Comptroller that his view is correct, the latter may order the insertion of references to the earlier specifications [section 7 (4)].

But it is now provided that if the Comptroller is satisfied that "the invention claimed has been wholly and specifically claimed" in any specification dealt with in this search, *i.e.*, published before the date of the application for the patent in question, he may refuse a patent to the later applicant [section 7 (4)].

From the decision of the Comptroller as to the insertion of references or the refusal of a patent there is an appeal to the law officer.

A second search will in future be made and will include specifications deposited in pursuance of applications of a prior date to that in respect of which the search is made, but which are not published until after the date of the application in question. If such a specification disclosed the applicant's invention it would

not constitute an "anticipation" of it, but if that specification also claimed the applicant's invention a patent granted in pursuance of it would constitute a "prior grant," which would, if itself valid, render invalid a patent granted on the application in question (**20, 51**), *Robertson* v. *Purdey*, 24 R.P.C. 291 ; *Mica Insulator Co.* v. *Electrical Co., Ld.*, 15 R.P.C. 495. But the section authorising this second search is not to come into operation until a date to be fixed by the Board of Trade, and will only apply to applications made after that date [section 8 and notes]. New rules must be made as to the procedure to be adopted.

The official search is only directed to the invention "claimed" and only includes British complete specifications published within the 50 years before the application [section 7 (1)]. Publication in a specification of an earlier date than that does not in itself constitute an anticipation [section 41 (1)]. Questions arising from the limited nature of the search have been dealt with fully by Mr. J. Dundas White, M.P., in an article in the *Law Quarterly Review* for July 1903 (vol. 19, p. 807).

It is advisable here to consider briefly the question of the object and construction of claims.

Construction of Claims.

In order to explain fully the invention and the manner of carrying it out, it is usually necessary to describe much that is old, and the object of the claim is to show what part of the thing described the patentee claims as his invention. In fact the object of the claim is really equivalent to a disclaimer, and the result is to say to the public : "Now you have read my "description of my invention. It describes both what is old "and what is new, and I only claim a monopoly in the following "matters."

In construing claims the claim must be read in connection with and as part of the specification (**89**). The rule was thus stated by Lord Hatherley (Lord Chancellor) in *Arnold* v. *Bradbury*, L.R., 6 Ch. App. 712 :—"I do not think that the "proper way of dealing with this question is to look first "at the claims, and then see what the full description of the "invention is ; but rather first to read the description of the "invention, in order that your mind may be prepared for "what the inventor is about to claim." Chief Justice Tindal,

in *Haworth* v. *Hardcastle* (1 Webs. 485), expressed the rule in a slightly different form :—"There can be no rule of law which "requires the court to make any forced construction of the "specification, so as to extend the claim of the patentee to a "wider range than the facts would warrant ; on the contrary, "such construction ought to be made as will, consistently with "the fair import of the language used, make the claim of the "invention co-extensive with the discovery of the grantee of "the patent."

The Courts nowadays construe the specification and claims exactly like any other document, that is to say, they endeavour to arrive at the meaning it would fairly be understood to have to the person to whom it is addressed. The old doctrine that the specification must be construed strictly against the patentee, and the later idea that a "benevolent construction" should be put on it in the patentee's favour, have both gone. If a claim, however, is ambiguous in that it might either only claim what is new, or on the other hand might also include something old, the Courts tend to the former construction, which is in favour of the patentee.

This is really no breach of the above rule since the patent is supposed to be addressed to those who have a competent knowledge of the art to which it relates, and these persons would not be likely to understand such a claim as claiming as new what they know to be old. This last rule is specially applicable to a case which a patentee has referred in his specification to a previous specification. *Tubes Limited* v. *Perfecta, &c.*, 20 R.P.C. 97 (**461**).

The Courts are naturally apt to interpret two claims differing in wording as being different in scope, though the highest Court has never laid this down as an inflexible rule. Where, however, two claims differ by there being a specific limitation in one which is omitted in the other, the second would be interpreted as claiming generally without this limitation. *Electric Construction Company* v. *Imperial Tramways Company*, 17 R.P.C. 537 (**436**).

The practice as regards interpretation of specifications and claims pursued by the Patent Office is as nearly as possible the same as that pursued in the Courts. Were it otherwise the whole of the system of references might prove a trap, as the claims might mean one thing to the official examiner and another to the judge who in subsequent litigation might have

to pronounce on the validity of the patent. However, in the case of an admittedly ambiguous claim, the Patent Office may properly require the inventor to draft his specification so as to remove the ambiguity.

The specification may have several claims, as, for example, where an inventor wishes to protect a new combination, and also certain subordinate integers which are themselves new. Each claim must be for something which is itself patentable, since the invalidity of any one claim renders the whole patent invalid (**63**). It is not necessary that the thing or process which constitutes the difference between the subject-matter of one claim and another in the same specification should itself constitute patentable subject-matter, *e.g.*, in the specification of the patent for dynamite, besides the claim for the explosive, a further claim for its detonation by a known cap was held to be good, because the monopoly claimed could not be infringed without taking the invention, the subject-matter of the patent (**274**), *British Dynamite Company* v. *Krebs*, 13 R.P.C. 190, &c.

The limits of the power of the Comptroller with regard to the specification should be clearly understood. He has no power to decide the question whether what is claimed is patentable subject-matter in the sense that it involves "inventive ingenuity" (**34**, **35**). If there is anything which is new, and the specification is so drawn that this alone is claimed, the Comptroller cannot refuse a patent, nor, if the claim properly describes, and is strictly confined to what is new, has he any jurisdiction to insert a reference. If claims are well and properly drawn, disclaimers or references to prior publications will be unnecessary.

The Comptroller has, however, the right to refuse a patent which is not for an invention as defined by the Act, *i.e.*, a new "manufacture." Thus patents would be refused for financial schemes, systems of insurance, &c.

Evidence may be given by the applicant in reference to the novelty of his invention, or its alleged identity with a prior one. It may also be necessary for the purpose of explaining technical terms in the earlier specification, and showing that they do not mean what at first sight they might be supposed to, by reason of the change of meaning after lapse of time (*Betts* v. *Menzies*, **220**, 31 L.J., Q.B. 233), and also possibly with reference to statements in the applicant's specification. Such evidence will be by statutory declaration.

The question of evidence is now of much greater importance than heretofore, owing to the new powers given to the Comptroller. It is more fully considered, *post*, p. 14.

On the whole question of construction of specifications, *see* the *Grant, &c. of Patents*, pp. **84–99**.

Opposition to Grants.

After the specification has passed the ordeal of the official search it may be accepted, but it does not follow that a patent will be granted.

Whether the specification is "clear" or contains a reference to an earlier specification the grant of the patent may be opposed by third parties (**118**).

Opposition, however, is limited to definite grounds and to certain persons. The grounds for opposition shortly are as follows :—

(1) That the applicant has obtained his invention from, or in fraud of, the opponent.

(2) That the invention has been claimed in the complete specification of a British patent of a date within fifty years of the application in question.

(3) That the description of the invention in the complete specification is insufficient.

(4) That the patentee in his complete specification claims something different to what is described in the provisional specification, and that the opponent has applied for a patent for this further invention in the interval.

The question as to who may oppose and certain questions as to the grounds for opposition are discussed in the notes to section 11. With regard to the first ground, it should be noted that the fraud to constitute a ground of opposition must be within the realm, and that an opponent will not be heard to say that the invention was obtained from him abroad (**126**). The notice of opposition, on Form D, must be lodged within two months from the date of the advertisement of the acceptance of the complete specification. In the case of an opposition under the second ground the numbers and dates of the specification relied on must be given [**534,** Rule 35 (1903)]. Where the opponent relies on fraud he must file evidence ; and he may do so in other cases [**534,** Rule 36 (1903)]. Such evidence should be filed within fourteen days after the expiration of the two

months above referred to. Whether or not the opponent has filed evidence, the applicant may do so within a further fourteen days, and evidence in reply may then be filed. This evidence is by statutory declaration. (See *Evidence*, next page.)

The applicant and opponent are then heard.

At the hearing the applicant has the right to begin, except in an opposition on the ground of fraud. The Comptroller may now hear oral evidence on such proceedings [section 77].

If there is any difference between respective inventions, the patent is usually granted, but amendments may be made if necessary, so as to make it clear that only what is new is claimed. Such amendments may be either in the claims or in the body of the specification in the form of references. These references may either be "general," *i.e.*, referring to certain matters as prior knowledge, without mentioning any particular specification or "specific," referring to certain specifications by name and number.

The general rule is that specific references are only ordered when the prior specifications were the first to give the knowledge in question, or, as they are commonly called, "master patents." It is a rule of practice at the Patent Office that, if the opponent wishes such a specific reference on the ground that his patent is a master patent, he should file an affidavit to this effect, but this excellent rule is often neglected. The applicant cannot claim as a matter of right to amend at this stage, so as to avoid prior specifications; where an applicant wished to make very extensive amendments, so as to leave only a very small portion of the original claim, the patent was refused (*Lancaster's Application*, 20 R.P.C. 366; *Thomas' Application*, 16 R.P.C. 69; *Crist's Application*, 20 R.P.C. 475. *See* Appendix, p. 112.)

It should be remembered that the ground of opposition is the repetition of a claim, and the mere fact that the later patent will be an infringement of the earlier one is no ground for opposition, nor therefore for either a refusal or a reference (**127, 133**).

The practice of the Patent Office and the law officer has always been to grant a patent where there is any doubt at all, since if this is done the rights of the parties can be afterwards tested in a court of law, while if the patent is wrongfully refused the injustice is irremediable.

In some cases the fact that the applicant's patent might be held to be incapable of being put in practice except by licence

of the prior patentees was taken into consideration in granting a specific reference. There was no authority in the Act of 1883 for such a practice, as the fact that the later patent would be an infringement of the earlier formed no ground of opposition. The issue was whether the applicant *claimed* anything *included in the earlier patent*, and not whether the *claim of the earlier patent* included the applicant's invention. Such a course was pursued in the cases of *Lynde's Application* (5 R.P.C. 664) and *Hoffman's Application* (7 R.P.C. 93), in which references were allowed to Everitt's patent for a penny-in-the-slot weighing machine. The decision of the Court of Appeal (*Automatic Weighing Machine Co.* v. *Knight*, 6 R.P.C. 297) showed that Everitt's claims were not nearly so wide as had been supposed. From that it followed that the references so granted were injurious to the applicants, Lynde and Hoffman, as they went beyond what Everitt would be entitled to on the correct interpretation of his specification.

The Comptroller has now power to give either party costs in opposition cases, and to require security for costs from an opponent not residing in this country [section 39].

In all cases of opposition there is an appeal to the law officer.

(The questions relating to disclaimers and amendments in opposition cases are dealt with in the *Grant, etc., of Patents*, **118–159**. *See also* Appendix, p. 112.)

The complete specification must be accepted within twelve months with a possible extension of three months, unless an appeal has been lodged [section 6 (5)].

The Object of Evidence before the Comptroller.

Under the former Acts the validity of the applicant's patent did not come in question in proceedings before the Comptroller, except in the comparatively few cases in which he felt justified in refusing to seal a patent in cases of successful opposition. The insertion of a specific reference did not prejudice the rights of either party from the point of view of validity or infringement (except possibly in the case of concurrent applications), for if it subsequently appeared that the claims of the earlier specification were not so wide as the opponent believed them to be, the specific reference to a corresponding extent had a narrower effect, and left the applicant a wider field if he found it advisable

thereafter to seek for a wider interpretation of his claims (**139**). The object of inserting disclaimers was to avoid prejudicing the rights of either party, but to leave the issues open for future decision by the High Court. *Guest & Barrow's Patent*, 5 R.P.C. 315 (**142**); *Newton's Application*, 17 R.P.C. 123 (**144**).

But now the effect of sections 7 (4), 11 (1*b*), and 26 (1) of the Act is to make (*inter alia*) documentary descriptions of anticipations in specifications if claimed, grounds not only for opposition but also for refusal and revocation of a patent. If the tests for invalidity or the practice as to evidence before the Comptroller be different from those prevailing in the High Court, the result of a petition for revocation before the Comptroller might be different from that before the High Court even when presented on the same grounds, and the law and practice would then produce confusion.

In view of the greater responsibility now cast upon the Comptroller, the Legislature has given him larger powers as to taking evidence. Section 77 provides that "in any case in which "the Comptroller thinks it right so to do, he may take evidence "vivâ voce in lieu of or in addition to evidence by declaration," &c. With regard to alleged anticipations in specifications published before the application in question there is nothing in the Act to show that the Legislature intended to stop the grant of a patent in any case in which the patent if granted would be valid. It is necessary therefore to consider shortly the question of anticipation by a published prior specification.

The circumstances under which the description in a prior specification will anticipate a subsequent invention have recently been considered by the Judicial Committee of the Privy Council and laid down in the following terms:—"The anticipation is "not required to contain explanations or directions which will "enable a workman of ordinary skill to construct the patented "invention; but all that is required is that it should give such "information as would give men of science and employers of "labour information which would enable them without any "exercise of inventive ingenuity to understand the invention and "to give a workman the specific directions which the anticipating "document failed to communicate."—*Wilfley Ore Concentrator Syndicate, Ld.*, v. *N. Guthridge, Ld.*, 23 R.P.C. 538. For instance, the invention of the compound (or series shunt) winding in dynamos was anticipated by a description introduced into

an earlier specification in which there was no claim for it, nor was it illustrated, nor were there any directions for carrying it out (**343**). But as the earlier invention was not *claimed*, the Comptroller in like circumstances would not have jurisdiction to revoke a patent. (For full discussion of this subject *see* the *Grant, &c., of Patents*, pp. **211, 212, 224, 225**.)

On the other hand an alleged anticipating specification may apparently give a full description of the invention in question, but on putting it into practice failure may result. If this failure be due to something lacking in the earlier invention, then the later inventor, who turns failure into success, is entitled not only to a patent for the crucial difference, but for the whole successful invention. For the earlier publication tends to lead the public to think that the device or process in part disclosed is based on wrong principles to effect the object desired, and so tends to discourage further attempts in the same direction. This principle has been laid down in a number of cases (**27, 212, 257**). For instance, in 1877, a patent was taken out for a door-fastener. On pulling the handle the bolt was withdrawn, but on pushing the door to close it the bolt projected too soon. The device was abandoned as useless. A subsequent inventor, in 1888, constructed a similar fastener, but made a slight alteration by which the difficulty was overcome. The patent of the later inventor for the whole contrivance was held valid by the House of Lords. *Kaye* v. *Chubb*, 5 R.P.C. 641 (**315**). In an invention for a certain form of flushing apparatus an alleged anticipation at first sight appeared identical in principle and mode of action. But, owing to a difference in the relative position of the parts, the flushing action of the later invention was effective, whereas that of the earlier was not. The later patent for the whole invention was upheld. *Duckett* v. *Whitehead*, 12 R.P.C. 376 (**370**).

The cases mentioned in the preceding paragraph apply to the case of an opposition on the ground that "the invention has "been claimed in any complete specification for a British "patent" which is of prior date to the applicant's, and also to a petition for revocation (under section 26) of the patent on the same ground. If the earlier invention be a failure and the later a success, then they are not the "same invention." It sometimes happens that specifications may be apparently identical, but really apply to different inventions. For instance, in Lyons patent (*Lyons* v. *Goddard*, 11 R.P.C. 354) the real invention lay in

constructing a disinfector to be used for disinfecting with steam at *a very high pressure*. No prominence was given to this fact in the specification, which contained references to a "high pressure boiler," but the drawings showed that the door was very strong. The documentary description and drawings of an alleged anticipation appeared to show the same invention, but it was proved by evidence that the machine constructed, if used with steam at a high pressure, would have burst. Had this machine been claimed in a specification, expert engineering and other evidence of this state of the art, and the fact that the alleged anticipation would not fulfil the same functions as the later form, would have been necessary to save the patent in any procedure like that under section 11 (**358–362**).

Evidence may be directed to any point or facts that are in issue or relevant to the issue, such as the state of knowledge of the art at the date of the opponents alleged anticipating specification (**121**), in order to ascertain the meaning of it (**148**). In *Betts* v. *Menzies* (31 L.J.Q.B. 233) an alleged anticipating specification 40 years old apparently described the patentee's process of manufacture in almost identical terms, but it was proved by expert evidence as to the state of the art at the times in question that the inventions were quite different (**217–220**).

"As the specification described external objects, though the "language in both specifications should be identically the same, "it would be impossible to predicate of the two that they de- "scribed exactly the same identical external object, unless the "terms of art used in both specifications could be ascertained "to have been the same at the date of both the patents. The "question of identity of signification belonged to the province "of evidence and not to the province of construction" (*per* Lord Westbury, L.C., in *Betts* v. *Menzies*, **219**).

Instances such as the foregoing show the great risk of injustice involved in either refusing or revoking a patent on documentary evidence alone. The same reasoning applies to cases of references to prior specifications (under sections 7 and 8), supposed to contain descriptions of anticipating inventions.

Where opposition is made, or a petition for revocation presented under section 11 (1 *c*), on the ground that the specification is insufficient either as regards the defining of the invention or the directions necessary for putting it in practice, vivâ voce evidence will very often be necessary. (As to evidence of

Insufficiency, *see* the *Grant, &c., of Patents,* pages **76–79, 288, 299, 314, 319, 349, 365.**

Convention Applications.

Persons residing elsewhere than in the United Kingdom or the Isle of Man can obtain British patents, either in their own names or by means of an agent within the realm, who is the "importer" of the invention and trustee for the real inventor (**48**).

Such persons, whether British subjects or citizens of foreign states, may apply under the provisions of section 91 to have their patents dated as of the same date as the earliest protection in any of the States to which the section applies. These States are :—

Australia (including Tasmania).
Austria-Hungary.
Belgium.
Brazil.
Ceylon.
Cuba.
Denmark.
France, with Algeria and Colonies.
Germany.
Italy.
Japan.
Mexico.
Netherlands, with the Dutch East Indies, Surinam, and Curaçoa.
New Zealand.
Norway.
Paraguay.*
Portugal, with the Azores and Madeira.
San Domingo.
Servia.
Spain.
Sweden.
Switzerland.
Trinidad and Tobago.
Tunis.
United States of America.
Uruguay.*

The application must be filed within twelve months of the date of the first successful application for the foreign or colonial patent, and must be accompanied by a complete specification [*see* section 91 (3*a*) and notes]. Form A.2 (**549**) must be used, and copies be furnished of the foreign specifications and drawings, and other documents filed or deposited by the applicant abroad in respect of the first foreign or colonial application, duly certified by proper official or otherwise verified to the satisfaction of the Comptroller. If the deposited documents be in a foreign language, all translations must be annexed thereto, and verified by statutory declaration or otherwise to the satisfaction of the Comptroller. The foreign or colonial patentee may be a corporation. All foreign States or British Possessions in

* These countries have not joined the Convention, but there are treaties with them applying section 91.

which such applications have been made, with the official dates thereof, must be specified. The privilege is only granted by the Act to the patentee, and cannot be exercised by his agent. The application must be signed by the person or persons by whom the foreign or colonial applications have been made ; if any be dead, then by their legal representatives (**177, 178**).

Protection is given as from the date of the first successful foreign or colonial application, but no damages can be recovered for infringement committed before the acceptance of the specification. The protection of the section cannot be extended to cases where an applicant applies in the ordinary way during the twelve months, and subsequently wishes to fall back on the Convention, but is confined to cases in which the proper forms and procedure are adopted in making the application for antedating the patent (**177**). It is sufficient if the earlier application has been made abroad, although a patent has not been granted on it before the application in this country (**178**).

The subsequent proceedings are the same as in a British application. Persons registered under section 91, in case amendments be required, must proceed in the same way as in the case of a British patent obtained in the ordinary way (**178**).

With regard to the procedure in the British Patent Office important changes have been made. The second search under section 8 will include specifications lodged in pursuance of applications under the Convention. The definition of "prior application" in section 8 (3) includes one made under the Convention on the basis of a foreign application of prior date to that in respect of which the search is made. Under section 11 (1*b*) in like circumstances an applicant under the Convention is allowed to oppose the grant of a patent on an application made in fact before him in the British Office, provided he applies within the two months prescribed. Under section 26 (1) the Convention applicant may apply to the Comptroller to revoke a British patent, which he would have been entitled to oppose under section 11 (1*b*) had he applied within the two months.

On the other hand, if a person apply for a British patent and subsequently another apply for one abroad for a similar invention, and after some months applies under the Convention, the complete specification of the first applicant may be included in the official search under section 7, although the contents thereof would not be an anticipation of the second patent if

it was not published before the date of the foreign application which will be the date of the patent granted on the second application, *Deutsche Gold, &c.*, 24 R.P.C. 209. And now under section 11 (1*b*) the second applicant proceeding under the Convention may be opposed by the first British applicant, whether his specification has been published in time to be included in the search or not.

Sealing of the Patent.

Where there has been no opposition or extension of time required, a patent is usually sealed about 10 days after the time allowed for notice of opposition. The fee is £1 and must be paid by means of a stamp, as Form X. (request for sealing) on or before the last day on which the patent can be lawfully sealed (Rule 12 of 1905).

The latest time for sealing is 15 months from the date of application, with the following exceptions [section 12] :—

(*a*) Where the time for leaving or accepting the complete specification has been extended, an extra four months may be allowed.

(*b*) In cases of appeals to the law officer or opposition, the limit of time is fixed by the law officer.

(*c*) On the death of an applicant his legal representative is allowed 12 months from the death.

(*d*) Where delay is due to the failure of the applicant to pay any fee a further time may be allowed.

The powers of extension given under (*d*) are to meet the cases of persons who omitted to pay the sealing fee under Rule 12 of 1905.

Patents of Addition.

The patentee may now for the first time apply for a patent for an improvement in or modification of his invention as a patent of addition, which relieves him from paying further fees on it [section 19 and notes].

Amendment.

The object of amendment is to save a patent where the inventor finds he has included in his claims something which is not new or useful, or where he has not complied with the requirements as to describing fully his invention or the manner of performing the same, or where he finds he has made some error

in the specification, by so altering the specification as to confine it to what is new or useful, to complete the description, or to remove the error.

Amendments may generally be by way of disclaimer, correction, or explanation. In no case must an amendment substantially enlarge or substantially alter the invention, nor may an amendment introduce knowledge acquired since the date of the specification amended. Once an amendment has been made, the amended specification is for all purposes the same as if it had been originally drawn in the amended form [*but see* note to section 22].

Damages cannot be recovered for an infringement before the amendment, unless the Court is of opinion that the original specification was drawn in good faith and with reasonable skill and knowledge [section 23].

Amendments may be made under the following circumstances :—

1. After deposit, but before acceptance of the complete specification. They may be either made at the suggestion of the Patent Office or at the request of the applicant. They need not be advertised, nor is there any notification on the printed specification that they have been made.

2. In consequence of and during proceedings on opposition. In this case also there is no need for advertisement. The specification simply bears the notification that it has been amended.

3. After the acceptance of the complete specification in consequence of the results of the further search under section 8. Rules will be made as to the manner of making these, and as to how they will be shown.

4. After the acceptance of the complete specification, and while no legal proceedings are pending, on the patentee's initiative. In this case the patentee has to make an application for leave to amend showing the amendment desired [section 39]. This application is then advertised for one month, and any person interested may appear and oppose the amendment, and terms may be imposed as a condition of allowing the amendment. In this case the specification is printed so as to show the amendment made and how the specification stood originally by the use of italic and deleted type. The Comptroller has power

to make an order as to costs and to order security for costs where the opponent resides out of the kingdom [section 39].

5. When legal proceedings are pending application can no longer be made to the Comptroller as in paragraph 4 above, but an application must be made to the Court as provided in section 22. Such an amendment may only be by a disclaimer, as to which *see Owen's Patent*, 15 R.P.C. 755, and *Lang's Patent*, 7 R.P.C. 469. The amendment may also have to be advertised. Terms are generally imposed as to date from which damages may be recovered, &c.; in the earlier cases a common condition was that the amended specification should not be given in evidence, but the modern practice is to allow it to be so used.

The amendment will presumably be shown in the case of 4. Nothing is said as to whether there will be any appeal in the case of such an amendment, but probably there would be an appeal to the Court of Appeal and the House of Lords. It is also doubtful whether the question of the propriety of the amendment can be subsequently raised, *see* note to section 22.

6. Amendments may also be made on a petition to the Comptroller to revoke the patent. Until rules are made, it will not be clear whether these amendments will be made at once or whether the patentee will be required to apply in the ordinary way, nor is it clear whether such an amendment can be made during the pendency of legal proceedings. There is in this case an appeal to the High Court, but not to the Court of Appeal or the House of Lords.

In addition to amendments of a substantial nature, the Comptroller has power to correct any clerical error in or in connection with an application for a patent, or in any patent, or in any specification [section 70].

The only amendment possible in a provisional specification, apart from the correction of mere clerical errors, is that the applicant is allowed to discard a part of the provisional, independent of the rest, at any time before the acceptance of the complete specification. The discarded part will not then be published. (*See* further, *Grant, &c. of Patents*, p. **160**, and Appendix, p. 112.)

Revocation by the Comptroller.

Revocation may be ordered either by the Comptroller or by the Board of Trade, or by the Court. Application to the

Comptroller for revocation may be made by a person who would have been entitled to oppose [*see further* note to section 11].

It cannot be made during the pendency of legal proceedings without the sanction of the court [*see* note to section 26]. The Comptroller cannot revoke a patent except under such circumstances as would have justified him in refusing the grant were the case one of opposition, *i.e.*, the patentee is to be given the benefit of any doubt. In lieu of revoking a patent the Comptroller may require an amendment. The evidence will be by Statutory Declaration or if the Comptroller thinks fit it may be taken vivâ voice [*see* "Evidence," *ante, p.* 14]. He has power to give costs or make an order for security when the applicant for revocation resides out of the kingdom [section 39]. The right to begin would presumably be the same as in the case of opposition. The appeal is to the court, that is to say to a judge in the first instance specially appointed whose decision will be final, except that either party may appeal to the highest court if the Comptroller has made an order revoking the patent [*see* notes to section 26].

At any time after four years from the date of a patent, and after the 28th day of August, 1908, any person may apply for revocation under section 27 on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom. In reply the patentee may prove that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom or give satisfactory reasons why the article or process is not so manufactured or carried on, in which case no order can be made against him. If he fails to do so an order may be made revoking the patent, either forthwith or after a reasonable interval of time, unless in the meantime he shows that the patented article or process is manufactured and carried on in the United Kingdom to an adequate extent, or if within the time he gives satisfactory reasons why it is not so manufactured or carried on. The period may be extended, but not for more than a year.

No order shall be made which is at variance with any treaty, arrangement, or acknowledgment with any foreign country or British possession.

The appeal in this case is to a judge specially selected in the first instance, whose decision shall be final. The rules as to costs, evidence, &c. will be as in the last case [section 27].

Revocation by the Board of Trade and Compulsory Licences.[*]

Any person interested may present a petition for a compulsory licence, or, in the alternative, for the revocation of the patent, on the ground that the reasonable requirements of the public with respect to the patented invention have not been satisfied [section 24 and notes]. The grant of a compulsory licence is a remedy less drastic than revocation for the mischief mentioned *ante*, p. 23. This remedy was provided by the Act of 1883, but proved inadequate. The application of it was then by the Act of 1902 transferred from the Board of Trade to the Judicial Committee of the Privy Council, and the conditions under which it could be resorted to were altered. That Act proved a dead letter. The present Act substitutes the High Court for the Judicial Committee. The conditions under which compulsory licences may be obtained are given in section 24. If the hearing is referred to the Court, there is no appeal from the decision of the judge of first instance. No order can be made for the revocation of a patent under this section within three years from the date of grant.

Revocation by the Court.

The court can grant revocation on any of the grounds on which the Comptroller or the Board of Trade could, and also on any grounds on which the action of scire facias could have been brought [section 25], subject to the modification as to disconformity introduced by section 42. It is difficult to give an exhaustive list of these grounds, but the following is fairly comprehensive :—

(1) That the patentee was not the true and first inventor.
(2) That the alleged invention was not new.
(3) That the alleged invention was not useful.
(4) That the alleged invention was not any manner of manufacture.
(5) That the manufacture claimed as the invention is contrary to law.
(6) That the grant is mischievous to the State.
(7) That the patent was hurtful to trade or generally inconvenient or prejudicial.

[*] For an exhaustive examination of the subject, *see* Mr. Gordon's "Compulsory Licences under the Patents Acts."

(8) That others used the alleged invention claimed at the date of the grant.

(9) That there had been a prior grant of the monopoly claimed.

(10) That the alleged invention was not "subject-matter" for a patent.

(11) That the specification contains material false statement.

(12) That the invention claimed in the complete specification was different from that described in the provisional and that such further invention was not new at the date of the complete specification [*see* note to section 42].

(13) That the specification does not sufficiently describe how the invention is to be put in practice.

(14) That the specification does not distinguish clearly what is the invention claimed.

(15) That the monopoly claimed is larger than the actual invention made.

(16) That the Crown has been deceived.

With regard to want of "subject-matter" (No. 10), it should be observed that this term is used in two senses. In one sense it means that the subject of a patent lacks some of the essentials laid down in the Statute of Monopolies. In the narrower sense in which the term is more often used, it denotes either that the alleged invention is not a manufacture at all, or is merely a new application or use of old means which does amount to a "new manufacture" (**45**), or that it exhibits so little inventive ingenuity that it would be "to the hurt of trade and generally inconvenient" to grant a monopoly for it (**34**).

The last ground (No. 16) will include some of the others, as, for instance, where the false suggestion is as regards the utility of the invention. *Turner* v. *Winter*, 1 Webs. 77 (**181**); *R.* v. *Mussary*, 1 Webs. 41; *Gordon on Monopolies*, p. 268.

The persons who may present a petition to the Court are set out in section 25, subsection 3. Shortly, they are any person alleging that he was the first and true inventor, or that the patent was obtained in fraud of his rights or the rights of some person through whom he claims, or that he, or some person through whom he claims, had exercised the invention before the date of the grant. Any other person authorised by the Attorney-General may present a petition. It is prudent in any case to obtain the

Attorney-General's fiat, as this enables a petitioner to succeed if he establishes any of the grounds of revocation, whereas if he relies on his being a person entitled to present a petition, the petitioner will fail if he cannot establish one of the grounds entitling him to present it.

This last form of petition is by far the most favourable to the petitioner, as it enables him to rely on any ground.

The defendant in an action for infringement may bring such a petition by way of a counterclaim if he would have been entitled or can get himself authorised to present one.

In Scotland revocation is claimed by the action of reduction. There is an unlimited right of appeal if revocation is sought by counterclaim or action of reduction, but the decision of the judge of first instance is final if it is sought by petition.

If the patent is revoked on the ground of fraud, either by the Comptroller or the court, the true inventor may apply to the Comptroller to grant him a patent in place of the one revoked. Such patent will bear the date of the revoked patent, but no action can be brought in respect of any infringement before it was actually granted [section 15; *see also* notes to section 25].

Restoration of lapsed Patent.

Where a patent has become void owing to the failure of the patentee to pay a fee and the patentee shows that such failure was unintentional, and that he has applied as soon as possible, the Comptroller may restore the patent subject to such conditions as he thinks fit. Formerly this could only be done by a special Act of Parliament. [*See* notes to section 20.]

Abandonment of Patent.

The patentee is now for the first time given power to abandon a patent by application to the Comptroller. Other persons interested may appear and oppose. The only circumstances under which it seems likely this power will be used will be where the patentee wishes to avoid a petition for revocation [section 26 (3)].

Prolongation or Extension of Terms of a Patent.

The power to grant this has been transferred from the Privy Council to the court, but no change has been made in the grounds on which an application may be based. [*See* note to section 18.]

Actions for Infringement.

The chief changes in regard to this are the extension of the possible grounds of defence and the power now given to the defendant to apply by counterclaim for revocation.

In an ordinary infringement action, besides non-infringement, the defendant can rely as a ground of defence on any of the grounds for revocation (set out on pp. 24, 25) and in addition may plead as a defence to the action that the patentee has inserted in a contract made after the passing of this Act (*i.e.*, the 28th day of August 1907), and which is still in force at the time when the action was brought, a condition which is declared null and void by section 38 of this Act, which deals with certain conditions in restraint of trade. He may further plead that the plantiff cannot recover any damages on the ground that the defendant was not aware, nor had reasonable means of making himself aware, of the existence of the patent [section 33], that the infringement was committed before the publication of the complete specification [section 13], or that it was committed before the amendment of the patent and that the original claims were not drafted in good faith and with reasonable skill and knowledge [section 23], or that it was committed while the patent was dormant owing to non-payment of fees [section 17 (3)].

The grounds of defence have been restricted in that disconformity is no longer a defence, unless the further invention in the complete specification was not new at the date on which it was lodged [section 42], and also in that certain publications are declared to be no longer anticipations [section 41]. In the case of patents where several provisional specifications have been lodged the form of the plea of want of novelty may have to be modified to suit the special circumstances.

The Act provides that the court may make fresh rules as to particulars of objections, &c. [section 98 (1*b*)]. These are not yet made.

Threats.

The Act of 1883 provided that where any person claiming to be a patentee threatened any other person with legal proceedings or liability in respect of any acts, any person aggrieved might bring an action if he was not in fact infringing any legal rights of the person threatening, but there was a proviso that the section

should not apply if the person issuing the threats brought and prosecuted with due diligence an action for infringement. It was not necessary that such action should be successful, and a patentee might abandon it after seeing the defence. It was sufficient if he brought one *bonâ fide* action against any alleged infringer.

The person threatened could also join with this action the old Common Law action for maliciously making false statements to injure him. It was not necessarily an answer to this action that an action for infringement had been brought, but substantial evidence had to be given of actual *mala fides* (see *Sugg* v. *Bray*, 2 R.P.C. 223).

All these provisions are continued by the new Act and the law as to threats is not changed except indirectly by the change as to the law of infringement. The mere fact that damages could not be recovered by the patentee, on account of the infringer having had no notice of the existence of the patent, would not render him liable to an action if he threatened such infringer.

Register of Patents.

A register of patents is kept at the Patent Office for the purpose of notifying to the public facts in connection with the ownership and validity of letters patents and designs. By section 71 (3), "The person registered as the proprietor of a "patent or design shall, subject to the provisions of this Act, "and to any rights appearing from the register to be vested "in any other person, have power absolutely to assign, grant "licences as to, or otherwise deal with the patent or design, "and to give effectual receipts for any consideration for any "such assignment, licence, or dealing: Provided that any equities "in respect of the patent or design may be enforced in like "manner as in respect of any other personal property."

The entries on the register may be divided into three classes. First, entries of persons as proprietors or as having a specific interest in or under the letters patent as mortgagees or licensees. The applicant for such an entry must prove his title to the satisfaction of the Comptroller. Secondly, entries of facts which affect or may affect the proprietorship, but which entries do not declare that any special person has acquired any special interest. As examples of these may be mentioned equitable assignments,

options, &c. Thirdly, entries as to amendments, payment of fees, &c.

It is very important that there should be no delay in registering notices of transactions as to patents, in view of the very wide powers given to the registered proprietor by the Act. Once the transaction has been registered, however, no subsequent dealings with the patent can affect it, since all the world is then presumed to have notice. This is the reason for the registration of matters in the second class.

The practice of the Patent Office tends therefore to permit of the registration of documents which may affect the title, without determining the rights of the parties, since the registration of an invalid agreement, for example, would do no harm, whereas the omission of a document which did affect the rights of the parties might enable such rights to be defeated by subsequent transactions. A document, however, to be entitled to registration must represent a complete transaction or agreement, *e.g.*, an agreement for a licence on terms to be arranged was ordered to be taken off the register, as until such terms were arranged there was no binding agreement between the parties. (*Fletcher's Patent*, 10 R.P.C. 252.)

No notice of a trust will be entered on the register, but this does not prevent the entry of an agreement which amounts to an equitable assignment. (*Casey's Patents*, 9 R.P.C. 9.)

Any person aggrieved either by an entry on the register or the refusal to make an entry may apply to the Court to rectify the register [section 72]. The Comptroller is to be served with a notice of such proceeding, and may (and shall if directed by the Court) appear on them.

There has been a practice at the Patent Office to give a certain notice to persons interested. On payment of a small fee any person interested in a particular patent might leave a request to be informed when any attempt was made to register an assignment or other similar document in connection with the patent in question. Notice of any such proposed registration would then be given to the person lodging such request and the registration would be suspended for a few days in order to allow him to take steps to protect his interests. The person interested could then issue a writ and ask for leave to serve notice of motion for an early date in order to have his rights determined. (*Viola* v. *Sharpe*, 22 R.P.C. 23.)

It has never been decided how far registration is necessary to perfect the title of an assignee. The Act says that the registered proprietor shall have the right to assign, but it does not say that an unregistered proprietor shall not, and in fact assignments are made by persons who have never registered their title. Nor has it ever been decided whether registration is a condition precedent to the right to bring an action for infringement, though it is of course prudent to register before doing so.

Rights of Co-Owners of the Patent.

If a patent is granted to two or more persons they may, in the absence of agreement, each use the process covered for their own advantage without accounting to the other, but they may not separately grant licences. If one of them dies the legal estate in the patent goes to the survivors who hold the share of the deceased patentee in trust for the benefit of his personal estate [*see* section 37]. Any of the co-patentees, however, may assign his share in his lifetime.

Crown, War Office, and Admiralty.

A patent has the same effect against the Crown as against the subject, except that any Government department may use a process covered by a patent, either by themselves or by contractors, on payment of an amount to be agreed or settled by the Treasury either before or after such use [section 29]. An inventor may also assign an invention to the War Office or Admiralty, and such patent may be kept secret [section 30].

The extension of these provisions to the Admiralty is new.

Duties of the Patentee.

The Patentee, if he wishes to preserve his rights, has now got to work his patent in this country to an adequate extent if it is worked abroad [section 27]. He must further not use his patent so as to prejudice any existing industry or the establishment of any new industry in this country [section 24]. He must not impose certain conditions in contracts relating to the patent [section 38], and he must see the possible infringers have reasonable notice of the existence of the patent, either by seeing that the patented articles are numbered with the particulars of the patent, or in some other way.

Designs.

The present Act, although making changes in the machinery and effects of registration, and in the law applicable to designs, has not made any alteration as to what may be registered.

Section 93 declares that in this Act—

> "'Design' means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814) applicable to any article whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined."

This, however, does not solve the question of what a design is; it merely says which class of designs can be registered. No definition has ever really been given of a design, but it may be said that a design must contain some peculiarity of shape or appearance, capable of application to the class of objects for which it is registered. Of course the application of a shape means making the article in the particular shape, though it is the shape and not the article which is registered.

It is not in itself an objection to a design that it might have been the subject of a patent (*Walker, Hunter & Co.* v. *Falkirk Iron Co.*, 4 R.P.C. 390). But, on the other hand, not everything which is capable of being protected by letters patent can be registered as a design. For example, a process of manufacture or an arrangement characterised, not by its shape, but by its object or function, could not be so registered. There is no need for invention in the case of a design, but the design must be "new or original." This may, perhaps, be paraphrased by saying that a substantially similar design must not have been known for the same or similar goods as those for which the design in question is registered. It is provided by the present Act that the publication involved in the registration of a design, or its use after registration on goods of the class for which it is registered, shall not invalidate a subsequent registration by the same proprietor in another class.

Application for Registration of Design.

A design is not registered generally, but only for particular classes of goods, and the applicant should first decide which class or classes he desires to register in, a separate fee having to be

paid for each class in which it is registered. In case of doubt the Comptroller may decide in which class it should be registered. The classes at present prescribed are as follows :—

Classes.

1. Articles composed wholly or chiefly of metal, not included in class 2.
2. Jewellery.
3. Articles composed wholly or chiefly of wood, bone, ivory, papier-mâché, or other solid substances not included in other classes.
4. Articles composed wholly or chiefly of glass, earthenware, or porcelain, bricks, tiles, or cement.
5. Articles composed wholly or chiefly of paper (except hangings).
6. Articles composed wholly or chiefly of leather, including book-binding, of all materials.
7. Paper hangings.
8. Carpets and rugs in all materials, floorcloths and oilcloths.
9. Lace, hosiery.
10. Millinery and wearing apparel, including boots and shoes.
11. Ornamental needlework on muslin or other textile fabrics.
12. Goods not included in other classes.
13. Printed or woven designs on textile piece goods.
14. Printed or woven designs on handkerchiefs and shawls.

The application is made on Forms E., E.1, O., or O.1, according to the class of the design desired to be registered. By section 50 a design registered in one class can subsequently be registered in another class. The registration will in future always be as of the date of application for registration [sub-section 5]. New rules may be made as to the drawing to accompany the application, at present it need only be a sketch "sufficiently definite to identify the same." At present three exact drawings or photographs of the design have to be sent to the Comptroller before a certificate is issued. The Comptroller may refuse to register any design, and the applicant has then the right to appeal to the Board of Trade [section 49 (3)]. If the design is refused on the ground that an identical design is registered the applicant has the right to inspect such design [section 56 (1)].

Any person claiming to be the proprietor of a design may apply for registration. The proprietor is defined by section 93 as follows :—

"The proprietor of a new and original design."

(*a*) Where the author of the design for good consideration executes the work for some other person, means the person for whom the design is so executed; and

(*b*) Where any person acquires the design or the right to apply the design to any article either exclusively of any other person or

otherwise, means in the respect and to the extent in and to which the design or right has been so acquired the person by whom the design or right is so acquired; and

(*c*) In any other case means the author of the design.

And where the property in and the right to apply the design has devolved from the original proprietor upon any other person, includes that other person.

The fees for registering one design to be applied to a single article in the first 12 classes, not being lace, is 10*s*., and for lace or articles in classes 13 and 14, 1*s*. The fee to register one design to be applied to a set of articles, not being lace, is £1; if it is to be applied to a set of lace articles, 2*s*.

The Comptroller does not in general inquire whether the applicant rightly claims to be proprietor.

The International Convention applies to designs, but application must be made within four months from the application for protection in a convention state. (*See* note to section 91.)

There is no specification left with the design, but a statement may be left with the drawings if necessary stating what special part of what is shown is claimed as the design.

If through any neglect of an applicant registration cannot be effected within the prescribed time (which will be fixed by rules to be made) the application shall be deemed to be abandoned [section 49 (4)]. The drawings, &c., relating to an abandoned design will be kept secret [section 69 (2)].

Copyright in Designs.

A copyright by registration lasts for five years. It can be extended on application for another five years and the Comptroller may, subject to rules to be made, grant an extension for a third period of five years [section 53].

Formerly a registered design was never open to inspection while the copyright still existed, except for the purpose of proceedings in the office or court. Now periods of not less than two years may be prescribed after which the design will be open to inspection, and it will always be open to inspection after the copyright has expired. It can also be inspected by any person authorised by the Court or the Comptroller. Any person may discover if a particular design is registered if he furnishes the Comptroller with sufficient information to enable to identify the design [section 56].

Register of Designs.

The proceedings as to rectification of the register, registration of change of proprietorship, &c. are like those in the case of patents dealt with on pp. 28–30 above.

Other Points in the Law as to Designs.

The law as to the marking of designs is modified so that failure to mark no longer voids the registration but only makes it necessary, in order that the proprietor may recover penalties or damages, to prove that the infringer knew of the copyright. [Section 54.]

The law as to non-user in this country is modified so that, instead of non-user for six months of a design used abroad voiding the registration, it only gives the right to apply for an order such as is provided for by section 27 in regard to patents. But such order may be applied for at any time, and there is no appeal from the decision of the Comptroller. The existence of facts which would justify such an order is made a defence in an action for infringement. [Section 58.]

A design is no longer invalidated by a disclosure in breach of good faith, or by the acceptance of a first confidential order for a textile design. [Section 55.]

The right of action in the case of groundless threats and the provisions as to certificate of validity, already in existence in the case of patents, have been applied to designs. [Section 61.]

It has also been made a criminal offence to put the word "registered," or any similar word, on a design of which the copyright has expired. [Section 69 (4)].

For the subject of designs in general, *see* Graham's "Designs and Trade Marks," and "Knox and Hind's Law of Copyright in Designs."

Patent Agents.

Although any person, generally speaking, may act as an agent in regard to obtaining patents in the United Kingdom, he must not represent himself as a "patent agent" unless he is on the register of patent agents, but the Board of Trade has power, if after inquiry it is of opinion that any person has been

guilty of disgraceful professional conduct, to strike his name off the register if it was on it, or if not to authorise the Comptroller to refuse to recognise him as agent in respect of any patent business [sections 84, 85]. This power extends to refusing to allow a company, of which he is manager, or a firm in which he is partner, to act as agent.

No person may act as agent unless he has a residence or place of business in the United Kingdom. The Act also renders illegal the use of the word "patent office" or other words suggesting that a person's place of business is officially connected with or is a patent office. [Section 89 (5)].

A table is given in the Appendix showing where the sections of previous Acts in force at the time of the passing of the new Act are contained in the latter.

THE PATENTS AND DESIGNS ACT, 1907.

7 Edw. 7. Ch. 29.

An Act to consolidate the enactments relating to Patents for Inventions and the Registration of Designs and certain enactments relating to Trade Marks.

[28th August 1907.]

BE it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :—

Part I.

Patents.

Application for and Grant of Patent.

Application. [1883, ss. 4, 5; 1885, s. 2.]

1.—(1) An application for a patent may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not, and whether alone or jointly with any other person.

(2) The application must be made in the prescribed form, and must be left at, or sent by post to, the patent office in the prescribed manner.

(3) The application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application one at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification.

(4) The declaration required by this section may be either a statutory declaration or not, as may be prescribed.

For definitions of "invention," *see* section 93, and Introduction, page 2.

Specifications.

2.—(1) A provisional specification must describe the nature of the invention.

(2) A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.

(3) In the case of any provisional or complete specification where the Comptroller deems it desirable he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification. [1883, s. 5; 1886, s. 2; 1907, s. 2.]

(4) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

(5) Where the invention in respect of which an application is made is a chemical invention, such typical samples and specimens as may be prescribed shall, if in any particular case the Comptroller considers it desirable so to require, be furnished before the acceptance of the complete specification. [1907, s. 3.]

Subsection (5) is new.

This section extends the power of the Comptroller to require drawings to be furnished. Formerly he might require the drawings to be supplied with the specification, now he may require them either at that stage or at a later period, if on examination of the specification it appears desirable that further drawings should be supplied to elucidate the description of the invention. They may be required to remove ambiguities brought to light by the official search.

The object of subsection (5) is to prevent persons from taking out "blocking" patents, and making claims for inventions which they have not actually tested experimentally. It does not interfere with the right of the inventor to apply for provisional protection before he has tested his theories by actual experiment. Samples will not be required in every case.

The power of the Comptroller to require either drawings or samples will not limit the scope of the claims that the patentee may choose to make. These may be quite general, and need have no reference either to the drawings or samples, and the question of infringement will have to be determined with regard to the wording and true construction of the claims. It will be no defence to an action for infringement of a chemical patent to allege that the infringer has produced a substance of which no sample had been deposited, if what he has done is within the claim.

The specification should not refer at all to the samples deposited, as it must itself be a complete description of the invention, and the samples, unlike the drawings, form no part of the specification.

It may be that the new Rules will provide for some notification being given to the public in cases in which samples have been deposited.

Proceedings upon application.

3.—(1) The Comptroller General of Patents, Designs, and Trade Marks (hereinafter referred to as the Comptroller) shall refer every application to an examiner.

[1883, s. 6, 1888, s. 7.]

(2) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application or require that the application, specification, or drawings be amended before he proceeds with the application ; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with.

(3) Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions (if any) the application shall be accepted.

(4) The Comptroller shall, when an application has been accepted, give notice thereof to the applicant.

Provisional protection.
[1883, s. 14.]

4. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the invention ; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

Time for leaving complete specification.
[1883, s. 8 ; 1885, s. 3 ; 1902, s. 1 (8) ; 1907, s. 12.]

5.—(1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within six months from the date of the application.

Provided that where an application is made for an extension of the time for leaving a complete specification, the Comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding one month.

(2) Unless a complete specification is so left the application shall be deemed to be abandoned.

The proviso in subsection (1) is new and enables the Comptroller to grant an extension of time without the formality of requiring reasons to be given for the application.

Comparison of provisional and complete specification.

6.—(1) Where a complete specification is left after a provisional specification, the Comptroller shall refer both specifications to an examiner.

(2) If the examiner reports that the complete specification has not been prepared in the prescribed manner, the Comptroller may refuse to accept the complete specification until it has been amended to his satisfaction. [1883, s. 9.]

(3) If the examiner reports that the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification the Comptroller may— [1907, s. 8.]

(*a*) refuse to accept the complete specification until it has been amended to his satisfaction ; or

(*b*) (with the consent of the applicant) cancel the provisional specification and treat the application as having been made on the date at which the complete specification was left, and the application shall have effect as if made on that date :

Provided that where the complete specification includes an invention not included in the provisional specification, the Comptroller may allow the original application to proceed, so far as the invention included both in the provisional and in the complete specification is concerned, and treat the claim for the additional invention included in the complete specification as an application for that invention made on the date at which the complete specification was left.

(4) A refusal of the Comptroller to accept a complete specification shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the Comptroller and may make an order determining whether and subject to what conditions (if any) the complete specification shall be accepted.

(5) Unless a complete specification is accepted within twelve months from the date of the application, the application shall (except where an appeal has been lodged) become void.

Provided that where an application is made for an extension of time for the acceptance of a complete specification, the Comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding three months. [1907, s. 12.]

Section 9 of the Act of 1883 provided for an examination for disconformity before the complete specification was accepted, but the only power the Comptroller had thereunder was to refuse to accept the specification until the disconforming parts had been

eliminated. Subsection (3) effects an important amendment by which the application may either be allowed to proceed as a whole, the monopoly commencing from the date when the complete specification was left, or may be divided, and proceed, so far as regards the matter foreshadowed in the provisional specification, with the original date, and as to the new matter with the date on which the complete specification was left. It is not clear whether, if the latter course is adopted, the Comptroller may, if the original and new inventions are cognate or modifications of one another, exercise his powers under section 16 of accepting one complete specification for the whole, but there seems no reason why he should not do so, or why an inventor who has included a new invention in his complete specification should be in a less favourable position as to obtaining one patent than an inventor who has put in two provisional specifications. As to the subject of disconformity in general, *see* notes to section 42 and *Grant, &c., of Patents*, **64–71.**

The search under the Act of 1902 disclosed many cases in which the only novel part of the invention as described in the complete specification was never in the provisional at all. A patent granted under these circumstances would have been invalid for disconformity. The cases of *Nuttall* v. *Hargreaves*, 8 R.P.C. 450; and *Cera Light Co.* v. *Dobbie*, 11 R.P.C. 10, are illustrations of disconformity arising in this way (see *Grant, &c., of Patents*, **71, 334**).

The proviso in subsection (5) is new and enables the Comptroller to grant an extension of time without requiring explanations in support of the application. Those were always given as a matter of course, but could not be tested.

Investigation of previous specifications in United Kingdom on applications for patents.
[1902, s. 1.]

7.—(1) Where an application for a patent has been made and a complete specification has been left, the examiner shall, in addition to the other inquiries which he is directed to make by this Act, make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date of the application, and left pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

(2) If on investigation it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

(3) If the Comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a

previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.

(4) If the Comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection is removed by amending the specification to the satisfaction of the Comptroller, determine whether a reference to any, and, if so, what prior specifications ought to be made in the specification by way of notice to the public.

Provided that the Comptroller, if satisfied that the invention claimed has been wholly and specifically claimed in any specification to which the investigation has extended, may, in lieu of requiring references to be made in the applicant's specification as aforesaid, refuse to grant a patent. [1907, s. 7.]

(5) An appeal shall lie from the decision of the Comptroller under this section to the law officer.

(6) The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of Trade or any officer thereof by reason of, or in connexion with, any such investigation or report, or any proceeding consequent thereon.

This section (except as to proviso to subsection (4)) is almost a verbatim reproduction of section 1 of the Act of 1902. The reference to "other inquiries" formerly read "other inquiries which he is directed to make by the principal Act," the other inquiries being those that are in this Act directed to be made by sections 3 and 6 above. They were not intended to refer to those mentioned in section 8 below. The language of this section remained the same as in the Consolidation Bill as introduced and before the addition of the amendments contained in the Amending Act, of which section 8 is one of the most important.

The proviso in subsection (4) is new. It gives the Comptroller power to refuse the grant of a patent in the case of a clear anticipation by prior publication of a claimed invention. In cases of opposition under section 11 of the Act of 1883, the Comptroller had power to refuse to grant a patent if the invention had already been "patented" in this country. In the majority of cases the patent was granted subject to disclaimers being inserted in the specification as an alternative to a refusal. But where the two inventions were indistinguishable the patent was refused. This proviso now gives power to the Comptroller to refuse the grant in a similar case. It extends the practice in opposition cases in this respect to cases coming under the official search instituted by the Act of 1902. (That practice is discussed at p. **132** of the *Grant, &c., of Patents. See also* Introduction, pp. 7, 12.)

The power of the Comptroller to refuse a patent must, in view of section 12, be exercised before the acceptance of the complete specification, except in the case of a successful opposition.

Should a patent however be granted, although anticipated in the manner just described, it may be revoked subsequently under section 26 below.

The words "wholly and specifically claimed" appear to mean described and claimed in substantially identical terms.

Investigation of specifications published subsequently to application. [1907, s. 6.]

8.—(1) An investigation under the last preceding section shall extend to specifications published after the date of the application in respect of which the investigation is made, and being specifications which have been deposited pursuant to prior applications; and that section shall, subject to rules under this Act, have effect accordingly.

(2) Where, on such an extended investigation, it appears that the invention claimed in the specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall, whether or not his specification has been accepted or a patent granted to him, be afforded such facilities as may be prescribed for amending his specification, and in the event of his failing to do so the Comptroller shall, in accordance with such procedure as may be prescribed, determine what reference, if any, to other specifications ought to be made in his specification by way of notice to the public.

(3) For the purposes of this section an application shall be deemed to be prior to another application if the patent applied for when granted would be of prior date to the patent granted pursuant to that other application.

(4) This section shall come into operation at such date as the Board of Trade may by order direct, and shall apply only to applications made after that date, and the order shall be laid before both Houses of Parliament.

The official search instituted by the Act of 1902 is at present confined to specifications published before the date of the application in question. This section extends the search to unpublished specifications of prior applications then pending. A patent for the earlier invention, if identical with the applicant's, would constitute a "prior grant," which, if itself valid, would invalidate the later patent **(20, 51).**

Subsection (2) shows that this section may operate even after a patent has been granted. The "extended investigation" therefore must be a second search, as that under section 7 must take place before the acceptance of the complete specification. There is no provision

for a continuing or third search, so this second search must be made after all the specifications lodged in pursuance of the prior applications have been completed.

Subsection (1) is at first sight general in its terms, but is narrowed by the enactment of subsections (2) and (3). Were this not so these would be unnecessary, as the same result could have been obtained by means of rules made under subsection (1).

Referring to section 7 above, it will be apparent that subsections (2), (3), and (4) apply only to the specification before it is finally settled. They are inconsistent with the supposition that they can apply to a case where the claims have been settled and a patent granted. Subsections (2) and (3) of section 8 therefore take the place of subsections (2), (3), and (4) of section 7 in the case of the second search.

The powers of the Comptroller with regard to the results of the second search are therefore restricted to those given by subsection (2), in which there is nothing to correspond to the proviso in subsection (4) of section 7, *i.e.*, the power to refuse a patent. Such a power, or the power to revoke a patent already granted, cannot be assumed unless expressly given, and it seems clear that the powers of the Comptroller under this section are exhaustively set out in subsection (2).

Difficult questions may arise under subsection (2) in the event of the Comptroller requiring a disclaimer in the specification of a patent already granted which the patentee objects to make.

The reason why the Comptroller is given power to refuse a patent in the first case, but not in the second, is clear. In the first case the prior specification would constitute a publication that would *ipso facto* be an anticipation of the patent granted on the application in question, but in the second case the specification filed in pursuance of the prior application would not be a prior publication and its only effect would be that the patent when granted would constitute a "prior grant" which would, if itself valid, render void the patent granted in pursuance of the application in question. (*See* Introduction, page 9.)

For the same reason the references to the publications disclosed by this second search will not necessarily be by way of disclaimer. For example, take the case where A. has lodged a provisional specification before B., and in his complete specification claims something not mentioned in his provisional specification which additional matter B. claims in his complete specification. If the Comptroller requires B. to insert a reference to A.'s claim it is only required under this section for the purpose of "notice to the public." It would be sufficient for B. to refer to A.'s claim without disclaiming what is covered thereby, thus leaving the parties to contest their respective rights before the Comptroller at a later stage, as by B. lodging a class opposition under section 11 (1*d*), or subsequently in the courts.

Subsection (1) of section 8 applies subsections (5) and (6) of section 7 to the second search, as the provisions are not inconsistent.

The definition of "prior application" in subsection (3) includes the case of one made under the convention if the patent be antedated to a date preceding the application.

Advertisement on acceptance of complete

9. On the acceptance of the complete specification the Comptroller shall advertise the acceptance; and the application and

specification. [1883, s. 10.] specifications with the drawings (if any) shall be open to public inspection.

Effect of acceptance of complete specification. [1883, s. 15.]

10. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification. Provided that an applicant shall not be entitled to institute any proceeding for infringement until a patent for the invention has been granted to him.

Opposition to grant of patent. [1883, s. 11.]

11.—(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds :—

(*a*) that the applicant obtained the invention from him or from a person of whom he is the legal representative ; or

[1907, s. 10.] (*b*) that the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last-mentioned patent ; or

(*c*) that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification ; or

[1888, s. 4.] (*d*) that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification ;

but on no other ground.

[1883, s. 11.] (2) Where such notice is given the Comptroller shall give notice of the opposition to the applicant, and shall, on the

expiration of those two months, after hearing the applicant and the opponent, if desirous of being heard, decide on the case.

(3) The decision of the Comptroller shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and shall decide the case; and the law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer with the consent of the Treasury may determine.

This section makes material additions as to the grounds on which the grant of a patent may be opposed. Those mentioned in pars. (*a*) and (*d*) are the same as the first and third grounds in section 11 of the Act of 1883 as amended by section 4 of the Act of 1888. The second ground of opposition was "that the invention has been patented in this country on an application of prior date." For that ground is substituted pars. (*b*) and (*c*) above.

Paragraph (*b*) gives a ground larger than the second in the Act of 1883, for it includes contemporaneous specifications of patents which "will be of prior date" to that opposed. It will comprise specifications that come within the second search under section 8, including those lodged in pursuance of an application under the convention. Under the old law, however, references have in recent years occasionally been made to such specifications.

The wording of ground (*b*) also raises further difficulties in the case of "concurrent applications," referred to in the note to section 8 above. Under the old law the rights of the contending parties were dealt with by means of cross oppositions, but it would seem doubtful whether this machinery will apply. According to the strict wording of the Act a claim by A., whose date of application is prior to that of B., for something which B. has described in a provisional or complete specification lodged between the date of A.'s provisional specification and A.'s complete specification, would finally prevent B. from making this claim, and the possibility that B. might be able to prevent A. getting the claim in his patent under ground (*d*), would not affect the fact that it had been claimed in a complete specification on an application of prior date. Further cases might be cited as illustrations, as where B. had lodged a complete specification in the first instance, and where the time for opposition to A.'s patent had not arrived, because A.'s complete specification, though deposited, had not yet been accepted or published. Doubtless, some way will be found out of the injustice which would be caused by this, but whether it will be by deciding that the whole machinery of cross opposition still applies, or whether the law officer will, in spite of A. making a claim to what B. claims, direct B.'s patent to be sealed, with such reference as he may think necessary, cannot be predicted.

It should be noted that neither under the old law nor under the present Act is it anywhere laid down that the law officer must refuse a patent if a ground of opposition is established. According to the old law he was to decide "whether a patent ought to be granted," according to this section he is to "decide the case." The grant of

a patent is and always has been an exercise of the royal prerogative, and probably the law officer has a discretionary power to advise whether or not that prerogative shall be exercised in any particular case, even if the opponent shows that he comes within one of the grounds on which he is entitled to be heard in opposition.

Paragraph (*c*) creates a new ground of opposition, viz., insufficiency of the specification, either as to the delimiting of the invention ("not distinguishing new from old") or as regards the directions for putting it into practice. (These grounds of invalidity, with illustrative cases, are discussed in the *Grant, &c. of Patents*, pp. **59–63**, **72–9** respectively.)

The question of what persons are "entitled to be heard" in opposition to a grant is of greater importance than heretofore, inasmuch as it is only such persons who are entitled to oppose under this section are entitled to petition for the revocation of the patent under section 26(1) below.

It was held by the Court of Appeal in *Tomlinson's* case (*The Queen* v. *C. G. of Patents*, ex parte *Tomlinson*, 16 R. P. C. 242) that a member of the public who had no special interest was not entitled to oppose the grant of a patent under the second ground of opposition. Several reasons were given by the Lords Justices for the decision (1) that as the Comptroller had obtained the directions of the law officer under section 95 (1883) (now section 74 below), he could not be compelled by mandamus to hear a person whom the law officer held could not be heard, (2) that the words in subsection (3) showed that the law officer could decide if the opponent was "entitled to be heard," which narrowed the words "any person" to mean a particular class of interested persons, and (3) that in the case of the other two grounds of opposition (now (*a*) and (*d*)), the term "any person" was narrowed to refer to persons having a defined interest in the subject-matter of the ground of opposition. It was also pointed out that the law officer who was mainly responsible for the passing of the Act of 1883 had, in a case before him, *Glossop's Patent*, Griffin 285, held that an opponent, relying on the second ground of opposition, must show an interest in the earlier patent relied on.

In *Tomlinson's* case the question of the nature of the opponent's interest was subsequently raised before the Comptroller and an appeal taken to the law officer. *Tomlinson* sought to oppose a grant to *Meyer*. He was engaged in certain work which rendered him liable to royalties to *Meyer* under an existing patent. He would also have been liable under the patent then applied for. He discovered an earlier expired patent which anticipated both patents of *Meyer*. It was held by Lord *Alverstone* (then Attorney-General) that *Tomlinson* was entitled to be heard:—"I think he is a person who is entitled to be heard, and as far as I lay down any rule, I lay down the rule that if there has been a *bonâ fide* attempt to carry out the invention sought to be protected by the person who desires to be heard in opposition, and proof that he may be damnified or affected by the application which he desires to oppose, he is entitled to be heard, (**130**) *Meyer's Application*, 16 R.P.C. 526.

Two distinct views may be taken in respect of the right to oppose under the above section. One view is that the whole question has been altered by the introduction of the new ground (*c*). Clearly no person can have any special interest in that ground of opposition,

and therefore if the criterion of the right to oppose is the possession of some special interest in the ground of opposition the inclusion of this ground shows that "any person" cannot be limited as it was formerly, since no one person more than another can be said to be interested in this ground of opposition. In support of this view reference may also be made to the changed wording of (*b*) which, read with the introduction, provides that "any person" may oppose on the ground that the invention has been claimed in "any complete specification." But for the decisions under the former Act it would seem impossible to regard these words as limiting the class of persons entitled to oppose. Taking this view the words "in his opinion a person entitled to be heard" in subsection 3 would only apply to persons opposing on grounds (*a*) or (*d*).

The other view is that *Tomlinson's* case decided that a person having no interest could not oppose, if the law officer was of opinion he was not entitled to do so; that the reasons given would apply equally well to the ground (*c*) if the interest be not an interest in the alleged ground of opposition, but a direct interest in the refusal of the patent applied for, which, if granted, would interfere with the opponent's business, such as is mentioned in *Meyer's* application. According to this view the effect of *Tomlinson's* case and *Meyer's Application* (16 R.P.C. 526,) was to overrule *MacEvoy's Patent*, 5 R.P.C. 285, and *Barstow's Patent*, 5 R.P.C. 289, which are inconsistent with the latter. This view is also supported by the fact that in view of *Tomlinson's* case the Legislature did not in this section get rid of the effect of it by adding words to remove the restriction on the term "any person."

(On the whole subject of opposition, *see* the *Grant, &c. of Patents*, p. **122** *et seq.*, and Introduction, p. 12.)

Grant and sealing of patent.
[1883, s. 12; 1885, ss. 3, 5.]

12.—(1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, a patent shall, on payment of the prescribed fee, be granted to the applicant, or in the case of a joint application to the applicants jointly, and the Comptroller shall cause the patent to be sealed with the seal of the patent office.

(2) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, provided that—

(*a*) Where the Comptroller has allowed an extension of the time within which a complete specification may be left or accepted, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent:

(*b*) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct:

(*c*) Where the patent is granted to the legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after the date of his death :

[1907, s. 11.]

(*d*) Where in consequence of the neglect or failure of the applicant to pay any fee a patent cannot be sealed within the period allowed by this section, that period may, on payment of the prescribed fee and on compliance with the prescribed conditions, be extended to such an extent as may be prescribed, and this provision shall, in such cases as may be prescribed and subject to the prescribed conditions, apply where the period allowed for the sealing of the patent has expired before the commencement of this Act.

Paragraph (*2d*) is new.

Before the Act of 1902 sealing took place in due course. But the fee of £1 imposed towards the cost of the official search was made payable on the sealing of the patent. The onus was thus thrown on the applicant of making a formal "application for sealing" on form X in order to provide a mode of paying the £1. This was done by applying a stamp to that form. It was easy to forget that formality. This amendment gives power to the Comptroller to extend the time for sealing in such cases.

Rules must be made to define the conditions under which applicants may avail themselves of this section.

Date of patent.
[1883, s. 13.]

13. Except as otherwise expressly provided by this Act, a patent shall be dated and sealed as of the date of the application : Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification.

The proviso to section 13 of the Act of 1883 to the effect that the sealing of a patent for an invention on an application of a later date should not prevent the subsequent sealing of a patent on an application of an earlier one is omitted. This omission, probably, makes no change in the law.

Effect, extent, and form of patent.
[1883, ss. 12, 16, 33, 36.]

14.—(1) A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Great Seal of the United Kingdom, and shall have effect throughout the United Kingdom and the Isle of Man.

Provided that a patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

(2) Every patent may be in the prescribed form and shall be granted for one invention only, but the specification may contain more than one claim; and it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

The United Kingdom does not include the Channel Islands. This was also the case under the Act of 1883.

15.—(1) A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection. Fraudulent applications for patents. [1883, ss. 26, 35.]

(2) Where a patent has been revoked on the ground of fraud, the Comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the patent so revoked: [1907, s. 18.]

Provided that no action shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted.

The amendment in the law in this section is contained in the latter part of it. The date of the new patent will be the same as that of the one fraudulently obtained. It will, therefore, as regards the date on which its validity will be tested, be on the same footing as the revoked patent.

Under section 26 (8) of the Act of 1883, the second patent might be invalid, owing to the invention of a rival inventor, or by reason of publication of something between the date of the revoked patent and the substituted one.

The proviso makes no change in the law as to the period at which an action for infringement of such a patent might be brought.

16.—(1) Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the Comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon. Single patent for cognate inventions. [1907, s. 4.]

(2) Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same and for the purpose of the provisions of this Act with respect to oppositions to the grant of patents, the court or the Comptroller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed therein.

This clause is entirely new.

Under the old practice an applicant might have been in doubt whether he should include a development or improvement in his complete specification at the risk of disconformity, or should take the more expensive course of making a separate application, taking the risk of a rival inventor anticipating him during the interval between the first application and the second. This section gives the applicant an option; he may file several provisional specifications as improvements occur to him, and, in the event of the Comptroller allowing them to be included in one patent, he does not risk invalidity by reason of disconformity. (*See* notes to section 42 below.)

For the purpose of testing validity, or in cases of opposition, each part of the invention must be compared with the corresponding provisional specification.

The section will cause great difficulties unless the rules provide for a mode of earmarking the provisional specifications, so that each claim may be identified with its respective provisional, or *vice versâ*.

The "cognate" inventions are developments of the original idea As to the test to be applied to decide what is "one invention," *see* cases summarised at pages **107, 108,** of the *Grant, &c. of Patents.*

The provisions of this section apparently extend to provisional specifications lodged after the complete specification has been lodged on the first application, but before its acceptance. (*See also* note to section 6.)

It would seem that the rights and periods of protection under the International Convention are not affected by this clause, since they date from the application for the patent for the invention in question. Consequently the antedating under this section will not help the inventor in applications in other convention countries, nor, on the other hand, will his time for applying for protection for an invention first described in one of his later provisional specifications expire till twelve months from the date of such provisional.

Term of Patent.

Term of patent. [1883, s. 17.]

17.—(1) The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be fourteen years from its date.

(2) A patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to pay the prescribed fees within the prescribed times; provided that the Comptroller, upon

the application of the patentee, shall, on receipt of such additional fee, not exceeding ten pounds, as may be prescribed, enlarge the time to such an extent as may be applied for but not exceeding three months. [1907, s. 12.]

(3) If any proceeding is taken in respect of an infringement of the patent committed after a failure to pay any fee within the prescribed time, and before any enlargement thereof, the court before which the proceeding is proposed to be taken may, if it thinks fit, refuse to award any damages in respect of such infringement.

The Comptroller may now by reason of the amendment in this section grant an extension of time for payment of fees without requiring a case to be made out for such an extension.

Extension of term of patent. [1907, s. 17.]

18.—(1) A patentee may, after advertising in manner provided by rules of the Supreme Court his intention to do so, present a petition to the court praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent.

(2) Any person may give notice to the court of objection to the extension.

(3) On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the Comptroller shall be entitled to appear and be heard, and shall appear if so directed by the court.

(4) The court, in considering its decision, shall have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5) If it appears to the court that the patentee has been inadequately remunerated by his patent, the court may by order extend the term of the patent for a further term not exceeding seven, or, in exceptional cases, fourteen years, or may order the grant of a new patent for such term as may be specified in the order and containing any restriction, conditions, and provisions the court may think fit.

The effect of this section is to enable the High Court to grant an extension or prolongation of the patent under circumstances similar to those under which extension was recommended by the Judicial Committee under section 25 of the Act of 1883, for which this section is substituted.

The cases in and circumstances under which extension was granted by the Privy Council are illustrated by a long series of decisions and may be summarised as follows:—

(1) The nature and merits of the invention in relation to the public must be of an exceptional nature. "Merit" does not refer to the moral claim of an inventor to be rewarded for personal trouble, but to the value of the invention he has given to the public. This must be much more than what is required to support the validity of a patent. But the conduct and position of the inventor or applicant is also a matter for consideration. For instance, extension was refused where the British patent was held merely to protect the market, and the patented articles were made and imported from abroad. In another case where the patentee had kept secret the exact proportions necessary for carrying out his invention, and the Privy Council were of opinion that these were the essence of the invention, they refused a prolongation on these grounds.

(2) In order to ascertain the profits made by the patentee as such proper accounts must be kept. They must be so kept and exhibited to the Court that it may be apparent what profit, if any, has been made from the patent as distinguished from mere profits of manufacture. Where profits of manufacture are attributable to the existence of the patent they must be disclosed and will be considered.

(3) Where the applicant for an extension is an assignee of the original inventor he must show that he has done something to merit the grant, as, for instance, by incurring large expenditure in bringing the invention into public notice, or otherwise assisting the inventor. He must also show that the inventor has been inadequately remunerated, and will derive further remuneration by the proposed extension.

(4) In considering the question of remuneration of the patentee, the profits arising from foreign patents, or from articles made for sale abroad, will be included. The books must be kept, and accounts exhibited so as to include them.

(5) The utmost good faith must be shown, and the history of the patent fully disclosed. Delays in working must be explained. The existence of licences, the facts connected with the formation of companies when applicants, the value of their shares as shown by dealings in them and like matters should be fully stated.

(6) The validity of the patent is not considered, although the question of novelty may be gone into in order to determine the merit of the invention.

The rule regarding the full and lucid keeping and presentation of the accounts to the Judicial Committee was rigidly enforced. That was necessary because there was no appropriate machinery by which such an inquiry could be undertaken by the Judicial Committee. The case is otherwise with the High Court. As the matter of investigation of the accounts may be referred to Chambers, it may be that in future in cases that are in other respects meritorious, the petitions for prolongation will not be refused merely on the ground of the form of the accounts.

The Comptroller under the new procedure takes the place of the Attorney-General, who formerly appeared for the Crown, and will presumably have the same privileges as the latter, as, for example,

that of referring to prior specifications not mentioned in the notices of objections. The Attorney-General was not necessarily hostile to the petitioner, but it was his duty to bring to the notice of the Privy Council any irregularity in the petition and to see that they had before them all the facts necessary to enable them to form a just opinion on the merits of the case.

Patents of addition. [1907, s. 5.]

19.—(1) Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.

(2) Where an application containing such a request is made, a patent (hereinafter referred to as a patent of addition) may be granted for such term as aforesaid.

(3) A patent of addition shall remain in force so long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal.

(4) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

This section is new. If the improvement in question be made early in the life of the original patent it affords a cheaper mode of protecting it than by taking out a separate patent. If it be made before the complete specification is accepted this section affords a means of avoiding all difficulties as to disconformity, though in this case section 16 might afford an alternative remedy.

There is no definition of the term "improvement." It appears to be left to the decision of the Comptroller in each particular case as to whether an alleged "improvement in or modification of" the invention is a proper subject for a patent of addition. The difficulties arising in deciding such a question may be illustrated by a reference to cases turning on the question of what constitutes "one invention" (**107**). It is clear that "improvement" cannot be confined to something that is an infringement of the original patent, or a patent of addition would be valueless, since it gives no longer period of monopoly.

The wording of subsection (3) is not clear, but presumably the words "remain in force" mean exist as an unexpired and unrevoked patent, and the effect merely is that the terms of the two patents shall expire together. It is common in patent pleading to say that the letters patent are "valid and of full force" or "invalid

and of no force." But the words "in force" in this section cannot have reference to the validity of the patent, or the section would have the extraordinary result that a patent of addition which omitted the only element of novelty in the original patent would be valid and enforceable because the original patent was. It seems, therefore, that the mere invalidity of the original patent would have no effect on the patent of addition, though its revocation would automatically terminate the latter patent. It seems to be a doubtful point whether a patent of addition can be revoked apart from the original patent. The only advantage gained by applying for a patent as a patent of addition is the saving of fees. There is nothing in the section which says that there should be any other criterion for its validity than that which is applied to an ordinary patent, and in particular the publication of the original patent can be quoted against the patent of addition on the plea of want of novelty. Further, if the original patent is bad and is revoked the patent of addition *ipso facto* comes to an end.

The phrase originally in the Amending Bill 1907 was "improvement on the invention." Several subsequent amendments were made. In the corresponding section (5) of the Amending Act, it will be noted that the phrase is "improvement on or modification of." In other sections similar discrepancies may be observed; these are due to amendments being made on the Report stage when the Amending Bill was consolidated with the Consolidation Bill to form the present Act, the only Act now in force.

Restoration of lapsed Patents.

Restoration of lapsed patents. [1907, s. 23.]

20.—(1) Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Comptroller in the prescribed manner for an order for the restoration of the patent.

(2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.

(3) If it appears from such statement that the omission was unintentional, and that no undue delay has occurred in the making of the application, the Comptroller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office.

(4) Where such notice is given the Comptroller shall notify the applicant thereof.

(5) After the expiration of the prescribed period the Comptroller shall hear the case, and, subject to an appeal to the court, issue an order either restoring the patent or dismissing the

application : Provided that in every order under this section restoring a patent such provisions as may be prescribed shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had been announced as void in the illustrated official journal.

The only means hitherto of obtaining relief when a patent lapsed through an unintentional omission to pay renewal fees was by a private Act of Parliament. In the preamble it was customary to recite the circumstances fully under which the omission to pay the fees took place. These facts had to be proved to the satisfaction of the committee. The conditions upon which the patent was renewed were usually to the following effect :—

No action or other proceeding to be commenced or prosecuted nor any damage recovered—

(1) In respect of any infringement of the said letters patent which shall have taken place after the —— day of ——— 19— [being the day on which the letters patent were announced to be void in the official journal of the Patent Office] and before the passing of this Act :

(2) In respect of the use or employment at any time hereafter of any machine, machinery, process or operation actually made or carried on within the British Islands or of the use or sale of any article manufactured or made in infringement of the letters patent after the said [date of the said announcement in the official journal] and before the passing of this Act Provided that such use, sale or employment is by the person or corporation by or for whom such machine or machinery or article was bonâ fide manufactured or made or such process or operation was bonâ fide carried on, his or their executors, administrators, successors or vendees or his or their assigns respectively ;

(3) In respect of the use, employment or sale at any time hereafter by any person or corporation entitled for the time being under the preceding subsection to use or employ any machine, machinery, process or operation or any improved or additional machine or machinery, or any improved, extended or developed process or operation or of any article manufactured or made by any of the means aforesaid in infringement of the said letters patent. Provided that the use or employment of any such improved or additional machine or machinery or of any such improved, extended or developed process or operation shall be limited to the building, works or premises of the person or corporation by or for whom such machine or machinery was manufactured or such process or operation was carried on within the meaning of the preceding subsection, his or their executors, administrators, successors or assigns.

If any person shall within one year after the passing of this Act make an application to the Board of Trade for compensation in respect of money, time or labour expended by the applicant upon the subject-matter of the said letters patent in the bonâ fide belief that such letters patent had become and continued to be void, it shall be lawful for the said Board after hearing the parties concerned or their agents to assess the amount of such compensation if in their opinion the application ought to be

granted and to specify the party by whom and the day on which such compensation shall be paid and if default shall be made in payment of the sum awarded then the said letters patent shall by virtue of this Act become void, but the sum awarded shall not in that case be recovered as a debt or damages.

The foregoing conditions may be taken to be those that will generally be imposed.

It should be noted that under the provisions of section 98 (2) this section applies to patents granted before the passing of this Act and so to patents which have expired before the passing of the Act under circumstances which would have justified the exercise of the powers conferred by this section had it been in force at the date of such expiration. There was no means under the then existing law of getting the patent revived as procedure by private Bill was of an extraordinary nature and involved a change of the law. It seems therefore that the Comptroller ought to entertain the application if made immediately after the Act comes into force, although the patentee might have restored the patent at an earlier date by means of a private Act.

Amendment of Specification.

Amendment of specification by Comptroller.
[1883, ss. 18, 21; 1888, s. 5.]

21.—(1) An applicant or a patentee may at any time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of, and the reasons for, the proposed amendment.

(2) The request and the nature of the proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(3) Where such a notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case.

(4) Where no notice of opposition is given, or the person so giving notice of opposition does not appear, the Comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5) The decision of the Comptroller in either case shall be subject to an appeal to the law officer, who shall, if required, hear the person making the request to amend and, where notice of opposition has been given, the person giving that notice, if he is, in the opinion of the law officer, entitled to be heard in opposition to the request, and, where there is no opposition,

the Comptroller, and may make an order determining whether and subject to what conditions (if any) the amendment ought to be allowed.

(6) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(7) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall be advertised in the prescribed manner, and shall in all courts and for all purposes be deemed to form part of the specification.

(8) This section shall not apply when and so long as any action for infringement or proceeding before the court for the revocation of a patent is pending.

It is doubtful whether a petition to the Board of Trade for a compulsory licence, or, in the alternative, for revocation, which has been referred to the court under the provisions of section 24 (2), is a "proceeding before the court" within subsection (8). The validity of the patent is not in question in such proceedings, and there seems no reason why the power of amendment should be limited to amendment by disclaimer only by the mere fact of such petition having been presented. An appeal from a decision of the Comptroller under section 26 probably would be a proceeding within this section. (*See* note to section 26.)

Amendment of specification by the court. [1907, s. 13.]

22. In any action for infringement of a patent or proceedings before a court for the revocation of a patent the court may by order allow the patentee to amend his specification by way of disclaimer in such manner, and subject to such terms as to costs, advertisement or otherwise, as the court may think fit:

Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the court, notice of the application shall be given to the Comptroller, and the Comptroller shall have the right to appear and be heard, and shall appear if so directed by the court.

Under section 19 of the Act of 1883 the court could, subject to terms, give leave to apply to the Comptroller to amend a specification by disclaimer. But it did not necessarily follow that because leave was given the proposed amendment would be allowed. The court did not go into the question whether the proposed amendments were admissible (**173**).

This enactment gives the power of the court to allow an amendment by disclaimer instead of referring it to the Comptroller. When the application to amend is made to the court the Comptroller is given a right to appear and be heard.

The reference to "advertisement" suggests that rules may be made enabling third parties to be heard on the question of amendment, but this will introduce difficulties in the case of an action *inter partes*.

There is no clause in this section directing that the specification so amended shall be read as if an original specification. It does not appear whether the question of whether the amendment makes the claim wider than it stood before amendment can be raised in subsequent proceedings.

The decision of the House of Lords in *Moser* v. *Marsden* (13 R.P.C. 24), which decided that an amendment could not be questioned in a subsequent action, proceeded expressly on the provision which forms subsection (7) of section 21 of the present Act, which declares that such amendment shall be conclusive. But the provisions of section 21 are expressly excluded in the case of an amendment made while the action is pending.

It may therefore be that such an amendment could be challenged, either on appeal or by third parties in other proceedings either on the ground that it extended or altered the invention, or that it was not in the nature of a disclaimer (see *Owen's Patent*, 15 R.P.C. 755; *Lang's Patent*, 7 R.P.C. 469). As to the effect of amendment on injunctions previously granted, see *Dudgeon* v. *Thomson*, 3 A.C. 34 (**263**). As to the power of the court to amend in proceedings under section 26, *see* note to that section.

Restriction on recovery of damages.
[1883, s. 20.]

23. Where an amendment of a specification by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the court that his original claim was framed in good faith and with reasonable skill and knowledge.

Damages for breaches before amendment were given in *Hopkinson* v. *The St. James' and Pall Mall Electric Light Co., Ltd.* (10 R.P.C. 46), and in *Brooks & Co., Ltd.* v. *E. Lycett, Ltd.* (20 R.P.C. 390), but these are believed to be the only cases in which this has been done.

Compulsory licences and revocation.
[1902, s. 3; 1907, s. 16.]

24.—(1) Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent.

(2) The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves the Board of Trade, if satisfied that a primâ facie case has been

made out, shall refer the petition to the court, and, if the Board are not so satisfied, they may dismiss the petition.

(3) Where any such petition is referred by the Board of Trade to the court, and it is proved to the satisfaction of the court that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by the court to grant licences on such terms as the court may think just, or, if the court is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by order of the court :

Provided that an order of revocation shall not be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(4) On the hearing of any petition under this section the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

(5) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—

(*a*) if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or industry in the United Kingdom is unfairly prejudiced, or the demand for the patented article or the article produced by the patented process is not reasonably met ; or

(*b*) if any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act to the purchase, hire, or use of the patented article or to the using or working of the patented process.

(6) An order of the court directing the grant of any licence under this section shall, without prejudice to any other method of [1902, s. 3.]

enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.

The new provisions of this section are the substitution of the High Court as the tribunal for the Judicial Committee of the Privy Council as provided by the Act of 1902.

The definitions in subsection (5) are substituted for other provisions in the corresponding section of the Act of 1902.

This section varies the law, as it formerly existed in section 3 of the Act of 1902, relating to the grant of compulsory licences on the ground that "the reasonable requirements of the public with respect to a patented invention" have not been satisfied. That section has hitherto been practically a dead letter. The most important alteration is that contained in paragraph (*b*). A practice had grown up under which the patentee bound the purchaser of a patented article, or a licensee, by all sorts of various conditions respecting the use of the article, or otherwise. The Court in the cases of *Incandescent Gas Light Co.* v. *Cantelo*, 12 R.P.C. 262, and *Incandescent Gas Light Co.* v. *Brogden*, 16 R.P.C. 179, held that such conditions were binding in law and could be enforced. The principles involved have not been discussed by the House of Lords, and it may be that the above cases may yet be overruled. But as the final determination of the question involves a consideration of the nature and extent of the monopoly granted, and a review of the development of the law, it was easier to deal with the evil by legislation.

This section is one attempt to provide a remedy, another attempt will be found in section 38.

Revocation of patent. [1883, s. 26; 1907, s. 25.]

25.—(1) Revocation of a patent may be obtained on petition to the court.

(2) Every ground on which—

(*a*) a patent might, immediately before the first day of January, one thousand eight hundred and eighty-four, have been repealed by scire facias; or

(*b*) a patent may be revoked under this Act either by the Comptroller or as an alternative to the grant of a compulsory licence;

shall be available by way of defence to an action of infringement and shall also be a ground of revocation under this section.

(3) A petition for revocation of a patent may be presented—

(*a*) by the Attorney-General or any person authorised by him; or

(*b*) by any person alleging—

(i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; or

(ii) that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee ; or

(iii) that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold within this realm, before the date of the patent, anything claimed by the patentee as his invention.

Paragraph (*b*) of subsection (2) is new and enables a defence to be raised on the grounds on which the Comptroller could revoke a patent under sections 26 or 27, or those on which a patent could be revoked by the Court under section 24.

For a list of grounds for a petition for revocation, *see* Introduction, pp. 24, 25.

Disconformity was a ground for revocation by scire facias, but this is modified by section 42.

The 1883 Act included the Lord Advocate or any person authorised by him as possible petitioners, but the omission makes no difference to the law in view of section 94.

Fresh rules may be made as to the right to begin, &c.

Section 92 (2) provides that where by virtue of this Act a petition may be presented to the Court it shall be referred to a judge selected by the Lord Chancellor, whose decision shall be final. The right to present a petition is purely statutory and can only be by virtue of this Act, the former Patents Acts having been repealed. The result is to abolish the right of appeal in the case of a petition for revocation to the Court. This is clearly an oversight and was not intended. This is shown by the fact that in the less important case of an application to the Comptroller for revocation the parties are in certain events given an appeal to the Court of Appeal and the House of Lords, and further by the fact that where revocation is claimed by counterclaim, and in proceedings for revocation in Scotland, which are by action of reduction [section 94 (3)] there is a right of appeal. The mistake can only be put right by an amending Act.

It is clear how the error arose. Section 28 of the Patent Law Amendment Act, 1907, provided that "where by virtue of this Act . . . . a petition may be presented to the Court" the decision of the judge of first instance should be final. This only referred to petitions for prolongation, petitions for revocation being presented by virtue of the Act of 1883. In the Consolidation Act the clause was repeated in the same words, and it was not observed that, owing to the repeal of the 1883 Act, petitions for revocation became included in the class of petition "presented by virtue of this Act." The result is that this Act, which was only intended to consolidate the old law, completely changes it.

For another apparent error due to the wording of this clause, *see* note to section 26.

Power to Comptroller to revoke

26.—(1) Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who

patents on certain grounds. [1907, s. 14.]

was so entitled, may, within two years from the date of the patent, in the prescribed manner apply to the Comptroller for an order revoking the patent on any one or more of the grounds on which the grant of the patent might have been opposed.

Provided that when an action for infringement or proceedings for the revocation of the patent are pending in any court, an application under this section shall not be made except with the leave of the court.

(2) The Comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or explanation, or dismissing the application ; but the Comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent.

(3) A patentee may at any time by giving notice in the prescribed manner to the Comptroller offer to surrender his patent and the Comptroller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.

(4) Any decision of the Comptroller under this section shall be subject to appeal to the court.

This section is new. Subsections (1) and (2) extend the powers of the Comptroller, so as to enable him to revoke a patent that has been sealed, in any case in which he could have refused to seal it as the result of an effective opposition. (For grounds of opposition, *see* section 11.) This section allows an opponent to come in to petition for revocation after the time has expired in which he could have opposed the grant. There is, however, a difference in regard to the appeal. In the case of opposition the appeal is to the law officer. In the case of a petition to revoke under this section an appeal lies to the court. By the provisions of section 92 (2) the decision of the judge of first instance is final, "except in the case of an appeal from a decision of the Comp-" troller revoking a patent on any ground on which the grant of " such patent might have been opposed." The effect of this is that, if the Comptroller decides to revoke the patent, either party may carry the case to the Court of Appeal or the House of Lords. But if the decision of the Comptroller is against the revocation, then the decision of the judge of first instance is final, even though he orders revocation. It is impossible to see any reason for this distinction, and probably it was not intended and arises from a mistake in the wording of section 92 (2) (as to which, *see also* the

note to section 25). In the Bill as originally introduced there was no appeal from the decision of the judge of first instance, but an amendment was introduced on the report stage of the Amendment Bill in order to meet the objection that it was unfair that a patentee should be liable to lose his patent on the decision of a judge of first instance, whereas in order to establish it finally in an infringement action he would have to go to the House of Lords, and it was understood that the object of the amendment was to prevent this injustice by giving the patentee an appeal should the decision be against him. The wording, however, of section 92 (2) fails to carry this out.

As to evidence in these cases, *see* the Introduction, p. 14.

As to the persons entitled to oppose, *see* Note to section 11.

It is improbable that the course authorised by this section will be adopted, except in those cases which practically must be undefended. As, generally speaking, the ordinary grounds of want of novelty, want of utility, disconformity, &c., will not be available in proceedings under this section, the petitioner will be at a very great disadvantage.

The section says that no application shall be made during the pendency of legal proceedings, except by leave of the court, but it does not say whether, when an application has been made, further proceedings on it will be stayed if an action is commenced. By analogy with the case of leave to amend, it would seem that litigation commenced after the application has been made will not affect further proceedings, *Woolfe* v. *Automatic Picture Gallery*, 20 R.C.P. 177. In this way it seems that a patent may be amended under subsection (2) even while legal proceedings are pending. As to when legal proceedings are pending, *see Brookes* v. *Lycett*, 21 R.P.C. 651. If several actions are pending, it will probably be sufficient to apply for leave in one, *see Hall's Patent*, 5 R.P.C. 306. An appeal to the House of Lords is not a pending legal proceeding, *Cropper* v. *Smith*, 1 R.P.C. 251.

Although the point it is not clear, it is assumed that the court in an appeal under this section will have the same powers of requiring amendment as the Comptroller, *i.e.*, either by a disclaimer, correction or explanation, and not merely the power of amendment by disclaimer given by section 22. As to whether such an amendment is certainly conclusive or whether its conclusiveness is subject to the question raised in the note to section 22, depends on whether such an appeal is a "proceeding before the court" within section 21 (8).

Revocation of patents worked outside the United Kingdom. [1907, s. 15.]

27.—(1) At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the Comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.

(2) The Comptroller shall consider the application, and, if after inquiry he is satisfied that the allegations contained therein are correct, then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is

manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the Comptroller may make an order revoking the patent either—

(*a*) forthwith ; or

(*b*) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent :

Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

(3) If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the Comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

(4) Any decision of the Comptroller under this section shall be subject to appeal to the court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

An attempt was made to attain the object of this clause by section 3 of the Act of 1902, but that section has proved practically a dead letter, partly in consequence of its ambiguity and partly because of the heavy expense it entailed on a petitioner.

In the year 1906 out of 14,700 patents issued, 6,500 were granted to foreigners, in the case of patents for dyes the proportion was about 95 per cent. In many cases these inventions were worked abroad exclusively and the patented articles, or substances made by the patented processes, were imported in large quantities into this country, the British patents being used merely for the purpose of closing the market to persons other than the patentee and his licensees.

There is no explanation given of what constitutes carrying on of a manufacture "mainly outside the United Kingdom," nor what is carrying on a manufacture "to an adequate extent in the United Kingdom," nor what sort of reasons would be considered as a "satisfactory" explanation why the manufacture is not so carried on. These will have to be determined in regard to the facts of each particular case.

The proviso requiring that the order made shall be in accordance with treaties and conventions is a new one and without precedent. The treaties, &c., referred to seem to be those either existing on

the Act coming into force or future treaties; and it is understood that the object of the proviso is to facilitate mutual arrangements with other countries with regard to the working of patents in those countries. The 5th Article of the International Convention provides that no patent shall be forfeited on account of the importation by the patentee of articles made in accordance with it. That article also expressly stipulates that the various countries shall be at liberty to enforce the working of patents. Therefore the importation of patented articles from abroad, while not in itself a ground for revocation, can be used as evidence under this section to prove that the article was not manufactured to an adequate extent at home.

Similarly, although the fact that the patentee has offered to grant licences will not be an answer to a charge of non-working, it may substantially assist, or its absence may substantially prejudice, the patentee in showing that the process is worked to an adequate extent in the United Kingdom, or in proving satisfactory reasons why it is not so worked.

Many difficult problems will arise under this section. Its effects cannot be accurately understood until it is discussed in actual practice.

Register of Patents.

Register of patents. [1883, ss. 23, 114.]

28.—(1) There shall be kept at the Patent Office a book called the register of patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) The register of patents existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act.

(3) The register of patents shall be primâ facie evidence of any matters by this Act directed or authorised to be inserted therein.

(4) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office.

Crown.

Patent to bind Crown. [1883, s. 27.]

29. A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject:

Provided that any Government department may, by themselves, their agents, contractors, or others, at any time after

the application, use the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled by the Treasury after hearing all parties interested.

This section was pleaded as a defence in *Nobel* v. *Anderson*, 11 R.P.C. 115, but the case turned on the issue of infringement, and there was no discussion on its effect.

Assignment to Secretary for War or the Admiralty of certain inventions.

[1883, s. 44; 1907, s. 21.]

30.—(1) The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration) assign to the Secretary of State for War or the Admiralty on behalf of His Majesty all the benefit of the invention and of any patent obtained or to be obtained for the invention; and the Secretary of State or the Admiralty may be a party to the assignment.

(2) The assignment shall effectively vest the benefit of the invention and patent in the Secretary of State or the Admiralty on behalf of His Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State or the Admiralty.

(3) Where any such assignment has been made, the Secretary of State or the Admiralty may at any time before the publication of the complete specification certify to the Comptroller that, in the interests of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4) If the Secretary of State or the Admiralty so certify the application and specifications, with the drawings (if any) and any amendment of the complete specification, and any copies of such documents and drawings shall, instead of being left in the ordinary manner in the Patent Office, be delivered to the Comptroller in a packet sealed by authority of the Secretary of State or the Admiralty.

(5) The packet shall, until the expiration of the term during which a patent for the invention may be in force, be kept sealed by the Comptroller, and shall not be opened save under

the authority of an order of the Secretary of State or the Admiralty or of the law officer.

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by the Secretary of State or the Admiralty to receive it, and shall if returned to the Comptroller be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Secretary of State or the Admiralty.

(8) Where the Secretary of State or the Admiralty certify as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the complete specification, the application and specifications with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the Comptroller, and the packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State or the Admiralty.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which a certificate has been given by the Secretary of State or the Admiralty as aforesaid.

(10) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but, save as in this section otherwise directed, the provisions of this Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Secretary of State or the Admiralty may at any time waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State or the Admiralty, or to any person or persons authorised by the Secretary of State or the Admiralty to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

[1907, s. 21(2).] (13) Rules may be made under this Act, after consultation with the Secretary of State and the Admiralty, for the purpose of ensuring secrecy with respect to patents to which this section applies, and those rules may modify any of the provisions of this Act in their application to such patents as aforesaid so far as may appear necessary for the purpose aforesaid.

Subsection (13) is new, and also the extension of these provisions to the Admiralty. Formerly they applied only to the Secretary of State for War. In the case of inventions relating to Naval War the Secretary of State used to act as an agent for the Admiralty.

Legal Proceedings.

Hearing with assessor. [1883, s. 28.]

31.—(1) In an action or proceeding for infringement or revocation of a patent, the court may, if it think fit, and shall on the request of either of the parties to the proceedings call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance ; the action shall be tried without a jury unless the court otherwise directs.

(2) The Court of Appeal may, if they think fit, in any proceeding before them call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the court or the Court of Appeal, as the case may be, and be paid as part of the expenses of the execution of this Act.

Power to counterclaim for revocation in an action for infringement. [1907, s. 26.]

32. A defendant in an action for infringement of a patent, if entitled to present a petition to the court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent.

This section is new.

In an action for infringement invalidity of the patent was always a good defence to the plaintiff's claim, but when such a defence was proved it did not operate to revoke the patent. In such cases the plaintiff was frequently placed in a dilemma as regards the construction of his specification ; if he sought to interpret the claims so as to include what the defendant had done the patent might be held to be invalid, because the claims included something that was old, on the other hand a narrower interpretation which would uphold the patent might not include what the defendant had done. In theory the specification should be construed in the light of the state of knowledge of the art at the time "disregarding issues of novelty or subject-matter which may arise in the particular case." *Presto Gear-case Co.* v. *Orme, Evans & Co.*, 18 R.P.C. 23 (See *Grant of Patents*, pp. **84–99**). In practice, however, this counsel of perfection is seldom followed.

In a petition for Revocation, the dilemma just alluded to (known as the "usual dilemma") does not arise, and the patentee seeks only to put such a narrower construction on his claims as will save his patent. Under this section an alleged infringer may put the validity of the patent in issue so as to obtain an order for revocation thereof, if his defence is successful. The patentee will have more at stake, and will be more inclined to save his patent than before, when he could subsequently save it by disclaimer.

If the defendant make out a case for revocation, the court may, under sec. 22, save the patent by allowing a suitable amendment, such as disclaiming that portion which claimed what was old.

If the defendant is not entitled under section 25 (3*b*) to present a petition for the revocation of a patent, the proper course would seem to be for him to apply to the Attorney General for his authority to present a petition for revocation and then to proceed by way of counterclaim. Even if the defendant does come within section 25 (3*b*) this course is advisable, as, unless he makes out one of the specific grounds given in that subsection, his counterclaim would fail, even if he substantiated other grounds, because he would not be entitled to sustain it, *Dege's Patent*, 12 R.P.C. 448. The grounds on which this revocation can be claimed include, of course, all the grounds set out in sections 24 and 27. For a complete list, *see* Introduction, pp. 24, 25.

It should be noted that there is a right of appeal if revocation is sought by way of counterclaim. *See* note to section 25.

Exemption of innocent infringer from liability for damages. [1907, s. 27.]

33. A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and the marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent:

Provided that nothing in this section shall affect any proceedings for an injunction.

This section is new, and only applies to patents "granted after the commencement of this Act," *i.e.*, 1st January 1908. These words are difficult to interpret. Considering the language of this section, and of section 98 (2), to which it forms an exception, it would certainly appear that a patent granted after the commencement of the Act means one which had been in fact sealed and issued after that date. On the other hand, section 13 says that "a patent shall "be dated and sealed as of the date of the application," and for all other purposes the date of application is taken as the date of the grant. This point will need judicial determination, but it

Sec. **33.**

will be prudent, where possible, to actually get the grant before January next.

The object of this section is to introduce the practice in vogue in the United States of marking patented articles, and packets containing substances made by a patented process, with particulars of the patent under which they are protected. The difficulty on the part of a patentee of proving that an infringer had knowledge of the patent will compel him to mark the articles or packets with the desired particulars.

But it should be noted that the provisions of this section differ very considerably from those of the corresponding section (section 54) relating to designs. In the latter case the proprietor has an absolute right to damages for infringement of his copyright provided that he marks any article delivered on sale. By the provisions of this section a defendant can escape liability for damages if he proves that he did not, in fact, know, or have reasonable means of knowledge, of the existence of the patent. It seems clear that the mere publication of the specification at the Patent Office would not be sufficient, and it is therefore important to consider what would be sufficient. If a patentee has been unable to bring his patent into use, it is clear that the notice cannot be given by marking the articles, and it also seems clear that manufacture on a very limited scale, and confined, say, to one locality, might not be held notice to a manufacturer or user in another part of the kingdom.

The question may arise in a different form. A patent may cover articles or the means of production of articles of very different classes, and it is submitted that the marking of one class of article will not necessarily be notice to the manufacturers or users of another class.

This section seems to make it impossible, in the absence of proof of actual knowledge of the existence of the patent, to succeed in getting damages against a mere user or a dealer in a small way unless the patent in question has been very largely advertised or used. In order to prevent this class escaping wholesale, it may be that the Courts may take the view that it would be reasonable for a man on purchasing an article to ask whether it was covered by a patent. But of course this is not expressly laid down by the Act.

On the other hand it is submitted that the defendant may be fixed with reasonable means of knowledge, apart from the marking of the articles. The section in fact does not give any special value to the marking of articles as notice, but merely says that certain forms of marking shall not be notice. It is thought, for example, that if the recognised paper of a trade, generally circulated among manufacturers in that trade, was in the habit of publishing notices of patents affecting such trade, one of such manufacturers would be held to have had reasonable means of making himself aware of the existence of a patent of which such a notice had been published. Of course, in all cases the onus of proving the absence of knowledge or reasonable means of knowledge is on the defendant, who can be interrogated as to his knowledge.

This section makes a considerable difference in the theory of our law as to patents. The patentee so far as regards damages has no longer a right akin to property of which all the world is deemed to have knowledge, but only a cause of action against those who

infringe his rights, with knowledge of their existence. In this respect his rights resemble greatly those of the owner of a "common law trade mark," as to which see *Kerly on Trade Marks*, 2nd edition, page 317. On the other hand there is nothing in the wording of this section which makes it a penal section altering or suspending the rights of a patentee if he does not mark articles made under his patent. It merely deals with certain means of giving notice to infringers.

The effect under the provisions of this section of failing to mark certain of the articles manufactured, which is extremely important in the cases of designs, is simply that of diminishing the means of notice. If, however, articles of one class are marked and articles of another class are sent out unmarked, it is submitted that the marking of articles of the first class would be no notice as to the existence of a patent covering the other articles. Nor do the provisions as to the proprietor taking "all proper steps to insure the marking" apply. The only question is notice or no notice, and attempts by the patentee to give notice, if ineffectual, are of no importance.

What the defendant must have notice of is the "existence of the patent." These words again are far from easy to understand. It is clear that if the defendant knows the contents of the patent it does not matter either that he thinks that what he was doing was outside the claim, or, as in the case of a user or seller, that he was unaware that the article had been made by a patented process. But the question as to what is the minimum amount of knowledge to be brought home to the infringer is very hard to answer. Take the case of a patent for an improved method of stamping metal objects. The notice by marking can only be by marking the objects made. Is the fact that the infringer, who has been selling, say, infringing cartridge cases, has seen a boot eyelet marked with "Smith's patent, No. 10,000 of 1908," which might refer to anything in the manufacture, or to the special shape, enough to take him outside the protection of this section? Must he know that Smith has a patent number so and so, or that Smith has a patent number so and so and title so and so, or must he know what the patent claims? While the wording says he has only to know of the existence of the patent, common sense would seem to demand that he must at least know, to lose the protection of this section, that the patent had some relation to the class of article he is dealing with, so as to put him on his inquiry.

On the other hand this is a section diminishing or taking away the rights given to the patentee by Royal grant, and it may well be that the Courts will say that it is not to be extended beyond its strict grammatical sense, and that a defendant to avail himself of it must show that he did not even know of the "existence" of the patent sued on. After all, under the existing law the infringer is liable for the infringement of any patent, whether he knows its contents or not, and the clause, even with the strictest interpretation, would give him some protection, since he would only be bound to know the contents of patents of whose existence he had notice. Here again the authors can give no opinion as to what the construction adopted will be, but it may be well to add a warning against relying on the word "innocent" in the side note of the clause. It is an accepted rule in construing Acts of

Parliament, that the side note forms no part whatever of the section, which must be construed quite apart from it.

The authors can express no opinion as to the effect of this section on the plaintiff's right to an account of profits. An account of profits was an equitable remedy ancillary to an injunction (the right to which is expressly reserved), and the right to it was in some cases sharply distinguished from that to damages. See *Crossley* v. *Derby Gaslight Co.*, 1 Webster's P.C., 119. In the corresponding section as to designs it is carefully set out that the proprietor loses his rights to "either penalty or damages." It may be that the intention of this section is to leave the right to an account of profits while taking away the right to damages, and a reason may be seen for the distinction since an account of profits only deprives the infringer of the amount of profit he has made by the use of the plaintiff's invention over what he would otherwise have made, and so leaves him in a no worse position than if he had not taken the plaintiff's invention, whereas liability as to damages may expose him to a penalty far in excess of his profits. On the other hand, an argument may be drawn from the fact that, while the right to an injunction is expressly preserved, nothing is said about the right to an account of profits.

In cases where it is doubtful if the claims cover certain articles the patentee is given the pleasant choice between the risk of losing his rights if he does not mark as "patented" articles within the claims, and the risk of being subject to criminal proceedings under section 89 if he marks as "patented" articles not within the claims. See note to section 89.

Order for inspection, &c., in action. [1883, s. 30.]

34. In an action for infringement of a patent, the court may on the application of either party make such order for an injunction inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the court may see fit.

Certificate of validity questioned and costs thereon. [1883, s. 31.]

35. In an action for infringement of a patent, the court may certify that the validity of a patent came in question; and, if the court so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client.

It is sufficient to entitle a patentee to a certificate if the defendant has denied validity in his defence even if he does not appear at the trial. See *Brookes, Ltd.*, v. *Lycett, Ltd.*, 20 R.P.C. 392.

Remedy in case of groundless threats of legal proceedings. [1883, s. 32.]

36. Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats,

and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of any legal rights of the person making such threats:

Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

As to these proceedings, see the Introduction, p. 27.

Miscellaneous.

Grant of patents to two or more persons. [1907, s. 1.]

37. Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent, and if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate.

The rights of co-patentees have always been a matter of great doubt, which this section partially, though not wholly, dissipates. It was decided in *National Company* v. *Gibbs*, 16 R. P. C. 339, that the form of the grant made co-patentees joint owners, and that their rights in the letters patent were subject to the *jus accrescendi*, *i.e.*, that if one died the survivors took his share. This section remedies the injustice caused by this decision by providing that the beneficial interest in the share of a dead patentee shall pass to his representatives.

The provisions as to the rights of working and granting licences are in accordance with what was supposed to be the former law (see *Mathers* v. *Green*, L.R., 1. Ch. 29, and *Steers* v. *Rogers*, 9 R.P.C. 177).

It is presumed that this section does not prevent the joint ownership being terminated as it could formerly have been. There were two methods of doing this, first, by agreement between the co-patentees, and secondly, by one of them during his lifetime assigning his share or part of his share. In such case the remaining patentees continue joint owners as far as their share is concerned, but the assignee of the party assigning is the owner in common with the others, *i.e.*, the right of survivorship does not exist, but his share in the case of his death would go to his representatives.

This power of assignment indirectly affords means for one of several co-patentees granting a licence as he can assign a portion of his share to the would be licensee, who then becomes a co-owner, and entitled to work under the patent.

The right of one of several co-patentees to sue for infringement without making the other co-patentees parties either as plaintiffs or defendants is still somewhat doubtful. It was decided in *Dunnicliffe* v. *Mallet*, 7 C. B., N. S. 209, that where a patent had been divided up so that one of the parties had the whole rights in it so far as it referred to the manufacture of certain articles, and the other party the remaining rights, that either could sue alone. But this case was free from the evil that affects such actions generally, namely, that the defendant, whether he wins or loses, is still liable to other actions by the other patentees for their share of the damages, and these other patentees would not be bound by the result in the first action.

In *Sheehan* v. *G. E. Ry.* (16 Ch. D. 59) Bacon, V. C., expressed his opinion that one of several co-patentees could sue alone, but the reasoning of the learned Vice-Chancellor does not seem wholly satisfactory, and it is believed that in every decided case all the proprietors of the patents have been made parties.

Avoidance of certain conditions attached to the sale, &c. of patented articles. [1907, s. 24.]

38.—(1) It shall not be lawful in any contract made after the passing of this Act in relation to the sale or lease of, or licence to use or work, any article or process protected by a patent to insert a condition the effect of which will be—

(*a*) to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or

(*b*) to require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees, any article or class of articles not protected by the patent;

and any such condition shall be null and void, as being in restraint of trade and contrary to public policy.

Provided that this subsection shall not apply if—

(i) the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms, without such conditions as aforesaid; and

(ii) the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months' notice in writing and on payment in compensation for such relief in the case of a purchase

of such sum, or in the case of a lease or licence of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.

(2) Any contract relating to the lease of or licence to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party; but where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be liable to pay such compensation as failing agreement may be awarded by an arbitrator appointed by the Board of Trade.

(3) Any contract made before the passing of this Act relating to the lease of or licence to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may, at any time before the contract is determinable under the last preceding subsection, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party, but where any such notice is given the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

(4) The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.

(5) Nothing in this section shall—

(*a*) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or

Sec. **38.**

(*b*) be construed as validating any contract which would, apart from this section, be invalid ; or

(*c*) affect any right of determining a contract or condition in a contract exerciseable independently of this section ; or

(*d*) affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

This clause is entirely new, and its effect is to put persons trading in patented articles under disabilities imposed on no other class. The words are extremely wide, and it is difficult to predict how far they will be held to extend. Taking one interpretation—that they cover any contract which relates in any way to the sale, &c. of an article some stage of whose manufacture is covered by letters patent, and that they apply whether the seller has any interest in the patent or not, they would revolutionise the whole system of trading in this country. Take for example a contract relating to a ship. It is probably built of steel, and most of the steel in this country is manufactured by some patented process. It almost certainly has built into it, so as to be a part of it, engines or other apparatus covered by letters patent, and such an interpretation as that here indicated would render illegal clauses in the charter of a ship by which the lessor had the right to provide stock and materials.

But the courts, quite naturally, are unwilling, unless forced to do so, to give such wide effect to clauses of this kind. They hold that they are entitled to look at the evils against which the legislation was directed, in order to assist themselves in interpreting the words of an Act of Parliament. Perhaps the best known instance of this is the famous decision as to "a place" in connection with the Betting Act, 1853. The evils against which the present clause was aimed were the imposition by owners of patent rights, as the price of allowing persons to use a patented invention, of terms which bound such persons to very onerous conditions in regard to the whole conduct of their trade, and also a special class of condition by which a patented article was sold on the terms that it should only be used in connection with certain specified apparatus.

This clause will, therefore, probably be interpreted in the following manner: The words "contract for the sale lease or licence" must be confined to contracts for a licence, and contracts *ejusdem generis*, that is to say, contracts made by some person who has special rights under the letters patent, and of which the main object is either by sale, lease, or licence to give a right to infringe on such monopoly. A contract, for example, to take a supply of cycles from a manufacturer would not be brought within this clause by it being made a condition that the cycle should have a patented form of tyre, which patent was owned by third parties with whom neither of the parties had any special relation. But,

on the other hand, a contract by the patentee or exclusive licensee for the sale of such tyres would be within this clause.

Next, one must consider the interpretation of paragraphs (*a*) and (*b*) of subsection 1. It is submitted that paragraph (*a*) must be construed as referring only to continuing covenants against using an article, which, apart from this section, would have entitled a licensor to an injunction against the licensee continuing to use such article; or to restrictive conditions, a breach of which would have entitled the licensor to bring an action for infringement, and not to a merely restrictive clause as to purchase, a breach of which would only have given a right to damages. Unless this paragraph is so restricted paragraph (*b*) becomes meaningless, and it should be noted that paragraph (*b*) apparently contemplates as lawful a contract by which the purchaser or licensee agrees to take the articles covered by the patent solely from the seller or licensor, and unless paragraph (*a*) is restricted as above suggested, these contracts would clearly be unlawful.

It should be observed that a clause requiring the purchaser or licensee not to use a non-patented process is not within the words of this section, and is apparently still lawful.

Another difficult question is, to determine what is meant by an article "protected by a patent."

If the section is held only to apply to the restricted class of contracts suggested above, the difficulty does not arise, but, even if a wider interpretation is given to the section, the words "article protected by a patent" will probably be interpreted so as to be either confined to an article which is itself patented, or, if held to include articles produced by a patented process, will be confined to such articles as cannot practically be produced without the use of such patented process, or which the contract expressly contemplates being so produced. The wider interpretation, that it would include any article in the production of which a patented process was in fact used, would render this clause so wide as to include nearly every manufactured article sold.

The further question arises as to whether "protected" means validly protected, or whether it simply means covered by the claims of the patent. The first interpretation would give rise to great complications, as the legality of a condition might then depend on whether a patent was valid, which patent might not be owned by the parties to the contract but by a third person. The word "protected" in this relation, so far as the authors know, has received no judicial interpretation, "protection" being generally used in the sense of protection against patent rights being lost by publication or others claiming them, *cf.* section 4.

Covenants which are void as being in restraint of trade are divisible, that is to say, if a portion of the covenant is lawful, that portion will be enforced, even although the covenant includes something which is not lawful. For example, if the above interpretation of paragraphs (*a*) and (*b*) is correct, a covenant to buy different classes of articles from the licensor would be enforceable as to articles covered by the patent, but not as to other articles, see *Mallan* v. *May*, 12 L.J. Ex. 376.

Further questions may arise as to articles which at the time of making the contract were within the patent, but afterwards become outside them owing to amendment of the specification.

Covenants in restraint of trade which were reasonable when made, are not affected by a change in the position of the parties which afterwards renders them unnecessary for their protection, *Elves* v. *Crofts*, 10 C.B. 241.

The proviso is important, and is intended to give the seller, &c. the power of persuading the buyer to enter into restrictive conditions, though he can no longer force him to do so by making such conditions a necessary part of the price for using the patented invention.

The first part of the proviso presumably would be satisfied by showing that the Purchaser, Lessee, or Licensee could either have purchased the article or obtained a lease or licence, either from the other party to the contract or from third parties, and does not require that a lessee, for example, should have been able to obtain a lease on other terms, if it can be shown that he could have bought the article outright at a reasonable price.

It is presumed that the compensation for breach of the condition will be assessed on the ordinary principle of finding what profit the seller would have made by enforcing the condition.

The above also covers the questions arising on subsections 2 and 3. It is to be noted that, if the notice spoken of is once given, the party giving the notice then becomes liable to pay such sum as may be assessed, and will not be able to escape from the payment by proposing to leave the contract in force.

Subsection (4) imposes a very serious risk on patentees entering into contracts, since the insertion of any clause or any condition which the courts may hold to be void under this section practically suspends the patentee's rights against all the world, during the time that such contract continues in force, and the greatest care will have to be exercised by patentees in drawing up their contracts.

Subsection (5) seems to call for no remark.

Costs and security for costs.

[1907, s. 46.]

39.—(1) The Comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the court.

(2) If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the Comptroller for the revocation of a patent, or giving notice of appeal from any decision of the Comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man, the Comptroller, or, in case of appeal to the law officer, the law officer, may require such party to give security for costs of the proceedings or appeal, and in default of such

security being given may treat the proceedings or appeal as abandoned.

Under the Act of 1883 the Comptroller had no power to award costs in the cases here mentioned. By the present Act he is given jurisdiction to revoke patents, and in that respect to do work now done by the High Court. It is only fit, therefore, that he should have power to give costs. It is found desirable that he should have the like power in other cases.

Subsection (2) is new. The power here conferred on the Comptroller is found necessary in regard to the extended jurisdiction now conferred upon him. "Carrying on business" will probably be interpreted, in reference to firms and companies, as in the case of Order 48A., Rule 1, of the Rules of the Supreme Court, *i.e.*, having a place of business of their own in this country, and there carrying on business in their own name.

Procedure on appeal to law officer.

40. The law officer may examine witnesses on oath and administer oaths for that purpose, and may make rules regulating references and appeals to the law officer and the practice and procedure before him under this Part of this Act; and in any proceeding before the law officer under this Part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the court. [1883, s. 38.]

Provisions as to anticipation.

41.—(1) An invention covered by any patent applied for on or after the first day of January one thousand nine hundred and five shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification. [1902, s. 2.]

(2) A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof, having been published prior to the date of the patent, if the patentee proves to the satisfaction of the court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication. [1907, s. 22.]

Subsection (1) was first introduced in the Act of 1902. There has been no judicial decision as to whether the protection afforded by this section would extend to further publications taken from the specification, *e.g.*, a notice in a scientific journal of the contents of

the specification. It does not cover publication in a foreign specification published in this country.

Subsection (2) is new.

Prior publication of the invention before the date of application will, generally speaking, invalidate a patent. Although a disclosure of the invention in confidence to professional or expert advisers, or workmen employed by the inventor to make experiments, was not considered such a publication as would have invalidated the patent, yet if any of these persons in breach of his duty disclosed the invention to others before the present Act, it became published (*Humpherson* v. *Syer*, 4 R.P.C. 415, per *Fry*, L.J.). This section is intended to mitigate the hardship of the existing law in such cases.

As an illustration there may be mentioned the case of *Pickard* v. *Prescott*, 9 R.P.C. 195. The inventor sent a description to a person in Paris for the purpose of having a pair of pince-nez made experimentally. That individual published a description of the article in a foreign review, which reached England and was known there a few days before the date of application. The patent was held invalid **(26, 339)**. In another case an anticipation consisted of a drawing from the inventor's own U.S. specification, almost identical with one in his British specification. It was published with the claims in the American Official Gazette, a copy of which was lodged in the British Patent Office four weeks before the date of application for the patent. The patent was held invalid; *Electric Const. Corps.* v. *Imp. Tram. Co.*, 17 R.P.C. 537 **(435)**.

It should be noted that the words are "without his knowledge *and* consent," so that for such a publication to invalidate the court must hold that the inventor both knew and consented.

The section is a large step towards assimilating our law to the American law, by which a man may get valid protection for an invention if he can prove that he was the true inventor, and that it had not been published for more than two years at the time of application. It is doubtful how far it will be held to apply to cases where the inventor has published abroad either by working or taking out a foreign patent, and then publication has been made in this country either by an account of the working being published here, or by the foreign specification being sent here.

Disconformity. [1907, s. 9.]

42. A patent shall not be held to be invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof.

This section is new.

The ground on which disconformity has been held to invalidate a patent is that the Crown was deceived by the applicant for the grant as the additional "disconforming" matter was not part of the invention for which provisional protection was claimed. The substantial reason for invalidating a patent on this ground is the wrong that would be inflicted by the grant on a rival inventor

who made the invention after the date of the application and before the applicant devised the same thing. The objection to validity is now co-extensive with the real evil.

This section is in harmony with sections 4 and 6. (For a full explanation of the law and digest of cases as to disconformity see the *Grant, &c. of Patents*, pp. **47, 64–71,** and the leading cases of *Newall* v. *Elliott*, 4 C.B. N.S. 269 **(201)**; *Bailey* v. *Roberton*, 3 App. Ca. 1055 **(270)**; *Woodward* v. *Sansum*, 4 R.P.C. 166 **(300)**; *Gadd* v. *Mayor of Manchester*, 9 R.P.C. 516 **(351)**; *Pneumatic Tyre Co.* v. *Leicester, &c.*, 16 R.P.C. 531 **(422)**; and *Castner-Kellner Alkali Co.* v. *Commercial Dev. Corporation* 17 R.P.C. 593 **(436)**, which are illustrated and noted in the same book, at the pages here indicated.)

The effect of this section will be to confine the issue of disconformity to those cases in which the person seeking to invalidate a patent is able to prove that the additional invention constituting disconformity was published, or commercially used, or invented, and provisional protection applied for by another inventor at some date prior to the filing of the complete specification of the patent in question.

As disconformity is nearly always unconscious, that is to say, the patentee imagines that what he claims is covered by his provisional specification, there will still be many cases in which a patentee's rights will be defeated by publication by the patentee himself, during the period of provisional protection and before the lodging of the complete specification, of the apparatus shown in such complete specification, of which the patentee wrongly imagines to be covered by his provisional specification. It therefore remains a point of extreme practical importance that a patentee, if he has made any modifications in the apparatus or process described in his provisional specification, should not show or otherwise publish it until the complete specification has been put in.

Patent on application of representative of deceased inventor.

[1883, s. 34; 1907, s. 20.]

43.—(1) If the person claiming to be inventor of an invention dies without making an application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2) Every such application must contain a declaration by the legal representative that he believes him to be the true and first inventor of the invention.

The amendment here made in the original section (34 of 1883) is the omission of the six months' limit of time for making the application, which was found to give rise to unnecessary hardship in many cases. By section 93 "inventor" and "applicant" in this Act include the legal representative of a deceased inventor or applicant.

This section applies to cases where the inventor has died before the commencement of the Act. His legal representatives, even if they had let the time for making application under the old law expire, may now obtain a patent if the invention has not been published.

Loss or destruction of patent.
[1883, s. 37.]

44. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Comptroller, the Comptroller may at any time seal a duplicate thereof.

Provisions as to exhibitions.
[1883, s. 39.]

45.—(1) The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—

(*a*) the exhibitor, before exhibiting the invention, gives the Comptroller the prescribed notice of his intention to do so; and

(*b*) the application for a patent is made before or within six months from the date of the opening of the exhibition.

[1886, s. 3.]

(2) His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.

Publication of illustrated journal, indexes, &c.
[1883, s. 40.]

46.—(1) The Comptroller shall issue periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that he may deem generally useful or important.

(2) Provision shall be made by the Comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents in force, with any accompanying drawings.

(3) The Comptroller shall continue, in such form as he deems expedient, the indexes and abridgments of specifications hitherto published, and shall prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he thinks fit.

47.—(1) The control and management of the Patent Museum and its contents shall remain vested in the Board of Education, subject to such directions as His Majesty in Council may think fit to give. Patent Museum. [1883, ss. 41, 42.]

(2) The Board of Education may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model, the amount to be settled, in case of dispute, by the Board of Trade.

48.—(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of His Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man. Foreign vessels in British waters. [1883, s. 43.]

(2) This section shall not extend to vessels of any foreign state of which the laws do not confer corresponding rights with respect to the use of inventions in British vessels while in the ports of that state, or in the waters within the jurisdiction of its courts.

This section only applies to foreign vessels, and not to British ships coming temporarily within the jurisdiction.

The following foreign states expressly confer corresponding rights on ships coming into their waters:—

Austria-Hungary.	Germany.
Denmark.	Mexico.
Finland.	Norway.

In the case of other foreign countries, the question whether they come within subsection (2) would depend on the interpretation given by their courts to the rights of patentees, and it is believed that in the case of most foreign countries the question has never been decided. The Supreme Court of the United States of America, in *Brown* v. *Duchesne*, 19 Howard 183, decided that use of an invention on a vessel coming into the ports of the United States was not infringement.

Part II.

Designs.

Registration of Designs.

49.—(1) The Comptroller may, on the application made in the prescribed form and manner of any person claiming to be the proprietor of any new or original design not previously Application for registration of designs. [1883, s. 47.]

published in the United Kingdom, register the design under this Part of this Act.

(2) The same design may be registered in more than one class, and, in case of doubt as to the class in which a design ought to be registered, the Comptroller may decide the question.

(3) The Comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal to the Board of Trade, and the Board shall, after hearing the applicant and the Comptroller, if so required, make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

[1907, s. 29.] (4) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time shall be deemed to be abandoned.

(5) A design when registered shall be registered as of the date of the application for registration.

The last two subsections are new.
In the first subsection the introduction of the words "made in the prescribed form and manner" render unnecessary the insertion of the subsections (2) and (3) of the original section 47 of the Act of 1883.
For definitions of "Design," "Article," and "Proprietor of a new and original Design," *see* section 93.
For the classes as at present prescribed, *see* Introduction, p. 32.

Registration of designs in new classes.
[1907, s. 33.]

50. Where a design has been registered in one or more classes of goods, the application of the proprietor of the design to register it in some one or more other classes shall not be refused, nor shall the registration thereof be invalidated—

(*a*) on the ground of the design not being a new and original design, by reason only that it was so previously registered ; or

(*b*) on the ground of the design having been previously published in the United Kingdom, by reason only that it has been applied to goods of any class in which it was so previously registered.

This section is new. It apparently does not cover publication by drawings, &c. of the design.

Certificate of registration.
[1883, s. 49.]

51.—(1) The Comptroller shall grant a certificate of registration to the proprietor of the design when registered.

(2) The Comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, furnish one or more copies of the certificate.

Register of designs. [1883, ss. 55, 114.]

52.—(1) There shall be kept at the Patent Office a book called the Register of Designs wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs and such other matters as may be prescribed.

(2) The register of designs existing at the commencement of this Act shall be incorporated with and form part of the register of designs under this Act.

(3) The register of designs shall be primâ facie evidence of any matters by this Act directed or authorised to be entered therein.

As to the effect of an entry of change of proprietorship, *see* section 71.
See also Introduction, p. 28.

Copyright in registered Designs.

Copyright on registration. [1883, s. 50.]

53.—(1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

[1907, s. 31 (1).]

(2) If within the prescribed time before the expiration of the said five years application for the extension of the period of copyright is made to the Comptroller in the prescribed manner, the Comptroller shall on payment of the prescribed fee extend the period of copyright for a second period of five years from the expiration of the original period of five years.

(3) If within the prescribed time before the expiration of such second period of five years application for the extension of the period of copyright is made to the Comptroller in the prescribed manner, the Comptroller may, subject to any rules under this Act, on payment of the prescribed fee, extend the period of copyright for a third period of five years from the expiration of the second period of five years.

Subsections (2) and (3) are new.
These new provisions make a design in certain cases nearly as valuable as a patent, since the applicant has a right to a term of 10 years certain and very probably 15 years. Apparently the Act does not contemplate any special reasons being necessary for this second extension, but the rules may deal with this point.
For definition of "Copyright," *see* section 93.

Requirements before delivery on sale.

[1883, ss. 50, 51.]

54.—(1) Before delivery on sale of any articles to which a registered design has been applied, the proprietor shall—

(*a*) (if exact representations or specimens were not furnished on the application for registration) furnish to the Comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the Comptroller may erase his name from the register, and thereupon the copyright in the design shall cease; and

[1907, s. 32.]

(*b*) cause each such article to be marked with the prescribed mark, or with the prescribed words or figures, denoting that the design is registered; and if he fails to do so the proprietor shall not be entitled to recover any penalty or damages in respect of any infringement of his copyright in the design unless he shows that he took all proper steps to ensure the marking of the article, or unless he shows that the infringement took place after the person guilty thereof knew or had received notice of the existence of the copyright in the design.

(2) Where a representation is made to the Board of Trade by or on behalf of any trade or industry that in the interests of the trade or industry it is expedient to dispense with or modify as regards any class or description of articles any of the requirements of this section as to marking, the Board may, if they think fit, by rule under this Act dispense with or modify such requirements as regards any such class or description of articles to such extent and subject to such conditions as they think fit.

Subsection (2) is new.

Paragraph (*b*) of subsection (1) is a modification of section 51 of the Act of 1883. By the provisions of that section the copyright in a design ceased if the requirements as to marking were neglected. Paragraph (*b*) of subsection (1) assimilates the law to that applicable to patents, and the only effect of neglect in marking the articles is that it throws on the plaintiff in an infringement action the burden of proving knowledge on the part of the defendant before he can recover penalty or damages.

In order to come within the provisions relieving a proprietor who has taken all proper steps to ensure the marking of the article it is necessary not only that the proprietor should give orders but should take precautions to see that they are obeyed (*Johnson* v. *Bailey*, 11 R.P.C. 21). It seems that a licensor should insert a clause in his licence as to the licensee marking articles in order to get the benefit of these provisions, as otherwise a default by the licensee may endanger his rights (*Wedekind* v. *The General Electric Company*, 14 R.P.C. 190).

There is nothing in the provisions of this section to affect the plaintiff's right to an injunction, although this is not expressly preserved as in the case of patents [section 33]. It should be noted that while in an action for infringement of a patent the onus is on the defendant to show that he did not know, or have the means of knowledge of, the existence of the patent, in an action for the infringement of a design the onus is on the plaintiff (in the absence of marking) of showing that the defendant knew or had received notice of the existence of the copyright before infringement, and it is not sufficient to show that he had reasonable means of knowledge. *See also* note to section 33.

The effect of an omission to mark an article changes the rights of a proprietor from those of a right of property, which he can protect from an invasion whether intentional or unintentional, to the right only of a cause of action against a person who with actual knowledge infringes his monopoly. Apparently the omission to mark a single article is enough to effect this change. It is submitted that the omission to mark articles within one class would not affect the right to recover penalties or damages for infringement of copyright within another class.

The mark may either be on the article or on a wrapping attached to each article (*Blank* v. *Footman, Pretty & Co.*, 5 R.P.C. 653). It need only be applied to articles delivered on sale.

Delivery on sale is effected when the proprietor of the trade mark parts with the property of the goods, even if the goods have to go through other processes before they can be sold to the public and the mark is affixed before this is done (*Woolley* v. *Broad*, 9 R.P.C. 429).

It must be applied to each separate article sold, and apparently if the article is so made that it must be ultimately sold in separate definite pieces (*e.g.*, a set of twelve squares for dusters) each of such pieces should be marked (*Hothersall* v. *Moore*, 9 R.P.C. 27). It is however sufficient in the case of an article made up of several pieces, that only one part should be marked (*Ingram* v. *Edwards Bros.*, 21 R.P.C. 463), but if the design only applies to one part it should be that part (*Morton's design*, 17 R.P.C. 117). *See also* note to section 91.

Effect of disclosure on copyright. [1907, s. 31 (2).]

55. The disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person other than the proprietor of the design, and the acceptance of a first and confidential order for goods bearing a new or original textile design intended for registration, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently to the disclosure or acceptance.

This section is new. It is intended to give protection similar to that given to patentees by subsection (2) of section 41 above, and to meet the case of one showing the design in confidence to intending

customers, which had been held to constitute publication of a design. *Blank* v. *Footman*, 14 R.P.C. 653; *Winfield* v. *Snow*, 8 R.P.C. 15.

It will be noted that the requirement as to obtaining protection as soon as the publication came to the knowledge of the patentee is not repeated in this section. If a publication is made by A. in breach of faith to B. who has no knowledge of such breach of faith, any subsequent user or publication by B. would not seem to be within this section and would invalidate the subsequent registration.

Inspection of registered designs.

[1883, s. 52, 1888, s. 6.]

56.—(1) During the existence of copyright in a design, or such shorter period not being less than two years from the registration of the design as may be prescribed, the design shall not be open to inspection except by the proprietor or a person authorised in writing by him, or a person authorised by the Comptroller or by the court, and furnishing such information as may enable the Comptroller to identify the design, and shall not be open to the inspection of any person except in the presence of the Comptroller, or of an officer acting under him, and on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof:

Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.

[1907, s. 34.]

(2) After the expiration of the copyright in a design, or such shorter period as aforesaid, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

(3) Different periods may be prescribed under this section for different classes of goods.

The last subsection is new, and also the power to leave the design open to inspection before the expiration of the copyright.

Section 52 of the Act of 1883 is reproduced in subsection (1) above. That provision was inserted for the benefit of the Nottingham trade. In future the period of concealment will last for two years at least. Whether it lasts longer as regards any particular class of goods will depend on the period that may be prescribed in the interests of that particular trade.

Information as to existence of copyright.

[1883, s. 53.]

57. On the request of any person furnishing such information as may enable the Comptroller to identify the design, and on payment of the prescribed fee, the Comptroller shall inform such person whether the registration still exists in respect of the design, and, if so, in respect of what classes of goods, and shall

state the date of registration, and the name and address of the registered proprietor.

Cancellation of registration of designs used wholly or mainly abroad.

58.—(1) At any time after the registration of a design any person may apply to the Comptroller for the cancellation of the registration on the ground that the design is used for manufacture exclusively or mainly outside the United Kingdom, and where such an application is made the provisions of this Act with respect to the revocation of patents worked outside the United Kingdom (including those relating to costs) shall apply with the necessary modifications, except that there shall be no appeal from the decision of the Comptroller. [1883, s. 54.] [1907, s. 35.]

(2) Such ground as aforesaid shall be available by way of a defence to an action for infringement of the copyright in the design.

This section replaces section 54 of the Act of 1883 and extends the provisions of section 27 above to designs. It modifies the law in favour of the proprietor of the design, as under the 1883 Act the copyright ceased if the design was used in any foreign country and not used in England within six months of registration.

See note to section 27.

Industrial and International Exhibitions.

Provisions as to exhibitions.

59.—(1) The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication during the holding of any such exhibition of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof: Provided that— [1883, s. 57.]

(*a*) The exhibitor, before exhibiting the design or article, or publishing a description of the design, gives the Comptroller the prescribed notice of his intention to do so; and

(*b*) The application for registration is made before or within six months from the date of the opening of the exhibition.

(2) His Majesty may, by Order in Council, apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the [1886, s. 3.]

exhibitor shall be relieved from the condition of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the order.

Legal Proceedings.

Piracy of registered design.
[1883, ss. 58, 59. 1888, s. 7; 1907, s. 36.]

60.—(1) During the existence of copyright in any design it shall not be lawful for any person—

(*a*) For the purposes of sale to apply or cause to be applied to any article in any class of goods in which the design is registered the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or

(*b*) Knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent of the registered proprietor to publish or expose or cause to be published or exposed for sale that article.

(2) If any person acts in contravention of this section he shall be liable for every contravention to pay to the registered proprietor of the design a sum not exceeding fifty pounds, recoverable as a simple contract debt, or if the proprietor elects to bring an action for the recovery of damages for such contravention, and for an injunction against the repetition thereof, he shall be liable to pay such damages as may be awarded and to be restrained by injunction accordingly:

Provided that the total sum recoverable as a simple contract debt in respect of any one design shall not exceed one hundred pounds.

The infliction of a penalty under subsection (1) for aiding and abetting the offence of fraudulently applying a design is new.

In subsection (2) the original provisions have been amended so as to give a remedy by injunction and a right to sue for damages as an alternative to the suit for the penalty.

As to "fraudulent" and "obvious" imitation see *Sherwood & Cotton* v. *Decorative Art Tile Co.*, 4 R.P.C. 210.

Application of certain provisions of the Act as to patents to designs.
[1907, s. 37.]

61. The provisions of this Act with regard to certificates of the validity of a patent, and to the remedy in case of groundless threats of legal proceedings by a patentee shall apply in the case of registered designs in like manner as they apply in the case of patents, with the substitution of references to the copyright in

a design for references to a patent, and of references to the proprietor of a design for references to the patentee, and of references to the design for references to the invention.

This section is new. For provisions referred to, *see* sections 35 and 36. The fact that the infringer would not be liable for penalty or damages, by reason of the provisions of section 54, would not, in the opinion of the authors, entitle him to succeed in an action for threats.

Part III.

General.

Patent Office and Proceedings thereat.

Patent Office. [1883, s. 82; 1902, s. 4.]

62.—(1) The Treasury may continue to provide for the purposes of this Act and the Trade Marks Act, 1905 [5 Edw. 7. c. 15], an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2) The Patent Office shall be under the immediate control of the Comptroller, who shall act under the superintendence and direction of the Board of Trade.

(3) Any act or thing directed to be done by or to the Comptroller may be done by or to any officer authorised by the Board of Trade.

[1907, s. 38.]

(4) Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere, and for any document or thing required by this Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established.

This last subsection is new.

Officers and clerks. [1883, s. 83.]

63.—(1) There shall continue to be a Comptroller-General of Patents, Designs, and Trade Marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the Comptroller, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament.

Seal of Patent Office.
[1883, s. 84.]

64. Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence.

Fees.

Fees.
[1883, ss. 24, 56.]

65. There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade, so however that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule to this Act shall not exceed those specified in that Schedule.

Although the maximum fees set out in the Schedule are the same as those set out in the Act of 1883, the reduced fees prescribed by the rules of 1893 will remain payable unless fresh ones are prescribed. The annual fees payable on certificate of renewal are as follows:—

Before the expiration of the—

	£	s.	d.
4th year from the date of the patent -	5	0	0
5th " " " -	6	0	0
6th " " " -	7	0	0
7th " " " -	8	0	0
8th " " " -	9	0	0
9th " " " -	10	0	0
10th " " " -	11	0	0
11th " " " -	12	0	0
12th " " " -	13	0	0
13th " " " -	14	0	0

Provisions as to Registers and other Documents in Patent Office.

Trust not to be entered in registers.
[1883, s. 85.]

66. There shall not be entered in any register kept under this Act, or be receivable by the Comptroller, any notice of any trust expressed implied or constructive.

This does not prevent entry of agreements having the effect of equitable assignments. *Casey's Patents*, 9 R.P.C., 9.
See section 71 below and notes thereto, and Introduction, pp. 28–30.

Inspection of and extracts from registers.
[1883, s. 88; 1888, s. 22.]

67. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Privilege of reports of examiners.

68. Reports of examiners made under this Act shall not in any case be published or be open to public inspection, and shall

not be liable to production or inspection in any legal proceeding unless the court or officer having power to order discovery in such legal proceeding certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed. [1883, s. 9 (5) 1888, s. 3; 1902, s. 1 (4).]

69.—(1) Where an application for a patent has been abandoned, or become void, the specifications and drawings (if any) accompanying or left in connexion with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the Comptroller. Prohibition of publication of specification, drawings, &c. where application abandoned, &c. [1885, s. 4; 1907, s. 29.]

(2) Where an application for a design has been abandoned or refused the application and any drawings, photographs, tracings, representations, or specimens left in connexion with the application shall not at any time be open to public inspection or be published by the Comptroller.

The extension of the former provision of section 4 of the Act of 1885 to the case of applications for designs effected by subsection (2) above is new. It is rendered necessary by the provisions of section 49 (4) as to the application for registration of a design being treated as abandoned, if not duly proceeded with.

70. The Comptroller may, on request in writing accompanied by the prescribed fee,— Power for Comptroller to correct clerical errors. [1883, s. 91; 1907, s. 41.]

(*a*) correct any clerical error in or in connexion with an application for a patent or in any patent or any specification;

(*b*) cancel the registration of a design either wholly or in respect of any particular goods in connexion with which the design is registered;

(*c*) correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs.

Under the former section (91 of 1883) the power to correct clerical errors was confined to the application. Subsection (*a*) extends this power to the correction of clerical errors in patents and specifications, subsection (*b*) gives power to cancel the registration of a design, and subsection (*c*) extends the power to correct a clerical error in the address of the proprietor on the register to other matters entered thereon.

71.—(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the Entry of assignments and trans-

missions in registers. [1883, s. 78; 1888, s. 21; 1907, s. 39.]

copyright in a registered design, the Comptroller shall, on request and on proof of title to his satisfaction, register him as the proprietor of a patent or design.

(2) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, the Comptroller shall, on request and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be.

(3) The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, licence, or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.

Subsection 2 is new. It will not greatly change the existing practice of the Patent Office. The Act of 1883 did not expressly provide for any distinction being made between mortgagees and other assignees, but it has been the practice of the Office to make this distinction. (See *Van Gelder Apsimon & Co.* v. *Sowerby Bridge Flour Society, Ltd.*, 7 R.P.C. 208.) Also by section 23 of the same Act notification of licences and all other matters affecting the proprietorship of patents could be entered on the register. *See* Introduction, pp. 28–30.

Rectification of registers by court. [1883, s. 90; 1888, s. 23; 1907, s. 40.]

72.—(1) The court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging, or varying such entry as it may think fit.

(2) The court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of a register.

(3) The prescribed notice of any application under this section shall be given to the Comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the court.

(4) Any order of the court rectifying a register shall direct that notice of the rectification be served on the Comptroller in

the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly.

By subsection (1) the power to rectify defects or errors in entries is given. The power to award damages in subsection (2) of section 90 of Act of 1883 has been omitted as being never used ; other powers have been omitted as being unnecessary.

The application to the court under this section being by motion and not by petition the provisions of section 92 (2) do not apply. The application, therefore, need not be made to any particular judge, and there is the ordinary right of appeal.

Powers and Duties of Comptroller.

Exercise of discretionary power by Comptroller. [1883, s. 94.]

73. Where any discretionary power is by or under this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard.

Power of Comptroller to take directions of law officers. [1883, s. 95.]

74. The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to a law officer for directions in the matter.

Refusal to grant patent, in certain cases. [1883, s. 86.]

75. The Comptroller may refuse to grant a patent for an invention, or to register a design, of which the use would, in his opinion, be contrary to law or morality.

Annual reports of Comptroller. [1883, s. 102.]

76. The Comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which the report relates, all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

Evidence, &c.

Evidence before Comptroller. [1907, s. 45.]

77.—(1) Subject to rules under this Act in any proceeding under this Act before the Comptroller the evidence shall be given by statutory declaration in the absence of directions to the contrary ; but in any case in which the Comptroller thinks it right so to do, he may take evidence vivâ voce in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the court

in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(2) In case any part of the evidence is taken vivâ voce, the Comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court.

The extended powers of the Comptroller under sections 11, 15, 26 and 27 above as to opposition to grants and revocation of patents could not be exercised properly when documentary evidence only was available.

See "Evidence" in the Introduction, p. 14.

Under Ord. 36, Rule 49 of the Rules of the Supreme Court the attendance of witnesses may be enforced by *subpœna*, and the trial must be conducted in the same manner, as nearly as circumstances will admit, as trials are conducted before a judge.

Certificate of Comptroller to be evidence.
[1883, s. 96.]

78. A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be primâ facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Evidence of documents in Patent Office.
[1883, s. 89.]

79. Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Transmission of certified printed copies of specifications, &c.
[1883, s. 100.]

80.—(1) Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office.

(2) Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee ; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland

and in the Isle of Man without further proof or production of the originals.

Applications and notices by post. [1883, s. 97.]

81. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller, or to any other person under this Act, may be sent by post.

Excluded days. [1883, s. 98; 1907, s. 42.]

82. Where the last day fixed by this Act for doing anything under this Act falls on any day specified in rules under this Act as an excluded day, the rules may provide for the thing being done on the next following day not being an excluded day.

This section replaces section 98 of the Act of 1883, which specified the excluded days, but applied only to the leaving of documents at the Patent Office or the payment of fees.

Declaration by infant, lunatic, &c. [1883, s. 99.]

83.—(1) If any person is, by reason of infancy, lunacy, or other disability, incapable of making any declaration or doing anything required or permitted by or under this Act, the guardian or committee (if any) of the person subject to the disability, or, if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing.

Register of Patent Agents.

Register of patent agents. [1888, s. 1.]

84.—(1) A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act or an Act repealed by this Act.

(2) Every person who proves to the satisfaction of the Board of Trade that prior to the twenty-fourth day of December, one thousand eight hundred and eighty-eight, he had been bonâ fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(3) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on

conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

(4) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

Agents for patents.
[1907, s. 48.]

85.—(1) Rules under this Act may authorise the Comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the Comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the Comptroller could refuse to recognise as such agent.

(2) Where a company or firm acts as agents, such rules as aforesaid may authorise the Comptroller to refuse to recognise the company or firm as agent if any person whom the Comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm.

(3) The Comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

Under the Act of 1888 a registered patent agent could be struck off the register if he were proved to the satisfaction of the Board of Trade, after due inquiry, to have been guilty of disgraceful professional conduct, and the Comptroller might refuse to recognise such a person as a Patent Agent. This rule, however, did not apply to persons whose names had never been on the register, and who could not therefore be prevented from practising as agents, though they might not describe themselves as Patent Agents. This clause gives power to make rules to enable the Comptroller to refuse to recognise such persons.

Powers, &c. of Board of Trade.

Power for Board of Trade to make general rules.
[1883, s. 101; 1888, s. 1 (2).]

86.—(1) The Board of Trade may make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(*a*) For regulating the practice of registration under this Act:

(*b*) For classifying goods for the purposes of designs:

(*c*) For making or requiring duplicates of specifications, drawings, and other documents:

(*d*) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, and other documents:

(*e*) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:

(*f*) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad:

(*g*) For regulating the keeping of the register of patent agents under this Act:

(*h*) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the Comptroller, or of the Board of Trade.

(2) General rules shall whilst in force be of the same effect as if they were contained in this Act.

(3) Any rules made in pursuance of this section shall be advertised twice in the official journal to be issued by the Comptroller, and shall be laid before both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules.

Proceedings of the Board of Trade.

87.—(1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board. [1888, s. 25.]

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

Provision as to Order in Council.
[1883, s. 104.]

88. An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act; but may be revoked or varied by a subsequent Order.

Offences.

Offences.
[1883, ss. 93, 105.]

89.—(1) If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

(2) If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

[1907, s. 43.]

(4) Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding five pounds.

(5) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds. [1907, s. 47.]

The last two subsections are new.

The practical necessity of marking articles as "patented" to preserve the right to sue for damages (*see* section 33) may in the case where the interpretation of the claims of a patent is doubtful bring many persons within subsection 2.

Unauthorised assumption of Royal Arms.

90.—(1) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

(2) If any person, without the authority of His Majesty, uses in connection with any business, trade, calling, or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds. [1883, s. 106; 1907, s. 44.]

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark.

Subsection (1) above is new.

Subsection (2) re-enacts section 106 of the Act of 1883 omitting the words "or any of the Royal Family, or of any Government Department" which followed "His Majesty," and might imply that permission could be given by a member of the Royal Family or a Government Department.

The proviso at the end of the section is new.

International and Colonial Arrangements.

International and Colonial arrangements.

91.—(1) If His Majesty is pleased to make any arrangements with the government of any foreign state for mutual protection of inventions, or designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that state shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants; and the patent or registration shall have the same date as the date of the application in the foreign state. [1883, ss, 103, 104; 1885, s. 6; 1901, s. 1.]

Provided that—

Sect. **91.**

(*a*) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months, from the application for protection in the foreign state ; and

(*b*) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered in this country.

(2) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

(*a*) in the case of a patent, by reason only of the publication of a description of, or use of, the invention ; or

(*b*) in the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design ; or

(*c*) in the case of a trade mark, by reason only of the use of the trade mark,

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or the Trade Marks Act, 1905 : Provided that—

(*a*) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months from the application for protection in the foreign state, shall with the drawings (if any) be open to public inspection at the expiration of that period ; and

(*b*) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

(4) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council declares them to be applicable, and so long only in the case of each state as the Order in Council continues in force with respect to that state.

(5) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs and trade marks, patented or registered in this country, it shall be lawful for His Majesty by Order in Council, to apply the provisions of this section to that possession, with such variations or additions, if any, as may be stated in the Order.

See Introduction, p. 18, for list of countries to which this section applies.

Applications under these sections are called in the Patent Rules "Convention applications," but the provisions of this section are not confined to the case of countries which have adhered to the Convention, but include any state (*e.g.*, Paraguay) or British Possession to which they have been duly applied by Order in Council.

These provisions enable any person who has applied for a patent in such a state, whether a subject of such state or not, to obtain a patent bearing the date of such application if he applies in this country within twelve months of such date. The rights given by an application in any state are, according to the Statute, quite independent of what has been done elsewhere. But, owing to some curious misreading of this section, the existing rules drawn up by the Board of Trade fail to carry into effect the provisions of the Statute, and lay down that an application under this section must be made within twelve months of the *first* foreign application. This rule, being inconsistent with the provisions of the Statute, was beyond the powers given by section 101 of the 1883 Act, which corresponded to section 86 of this Act, and probably if any person aggrieved had petitioned the Board of Trade, the rule would have been changed. New rules have now to be made when the error may be corrected.

One may illustrate the difference by considering the case of a German subject who applied for a patent in Germany on, say, the 1st of March. This section and the arrangements made thereunder between the British and German Governments would entitle him to apply for a British patent up to the 28th of February in the following year. But if he had applied in the United States three months earlier than he did in Germany, the rule would operate to curtail his twelve months to nine, and is therefore contrary to the Act. In such a case the applicant would run the risk of his British patent being held invalid if the invention were published before the date of the application in Germany by the publication of the United States application in the United Kingdom.

Subsection 3 (*a*) provides that the complete specification and drawings shall be open to public inspection, if the application is not accepted within twelve months of the foreign application. This does not

mean that the specification need be accepted in that time, but only that the specification and drawings will be then open to public inspection.

The complete specification must, as in the case of ordinary applications, be accepted within twelve months of the date of the British application, and the patent sealed within fifteen months, unless the time is extended. It is a condition precedent to the applicant's right to get a patent that he should enable this publication to take place at the proper time, and where an applicant by innocently giving a wrong date for his foreign application had prevented this being done, a decision of the Comptroller refusing the patent was upheld by the law officer, though it seems the Comptroller could have waived the irregularity. This case is reported in 25 R.P.C. at p. 288, and *post* in Appendix.

It is submitted that the provisions of section 54 as to marking of articles do not apply to sales during the period during which the applicant would get priority under this section. Subsection 2 (*b*) above would be otherwise almost useless, for "use" has been held to include "sale" in numerous cases, in fact, almost the commonest form of infringement of a patent is by sale, which the courts have held to come within the prohibition in the grant against others than the patentee "using" the invention, and it is clear that the articles cannot be marked before the design is registered. It should also be remembered in construing this section that the corresponding subsection of the 1883 Act (section 103 (2)) contained precisely similar words, and under that Act the sale of unmarked articles avoided the registration.

Definitions.

Provisions as to "the court."

[1883, s. 117.] [1907, s. 28.]

92.—(1) In this Act, unless the context otherwise requires, "the court" means, subject to the provisions as to Scotland, Ireland, and the Isle of Man, the High Court in England.

(2) Where by virtue of this Act a decision of the Comptroller is subject to an appeal to the court, or a petition may be referred or presented to the court, the appeal shall, subject to and in accordance with rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose, and the decision of that judge shall be final, except in the case of an appeal from a decision of the Comptroller revoking a patent on any ground on which the grant of such patent might have been opposed.

Subsection (2) is new. It is an approach to the constitution of a court for Patent and Design Cases by referring such cases (other than actions or motions) and certain appeals to a particular judge to be nominated by the Lord Chancellor.

Appeals from the Comptroller will be taken as follows:—

(1) To the law officer in cases of amendment of specifications, references to prior specifications, or refusal of a patent in consequence of proceedings consequent on the official search.

(2) To the High Court from a decision under section 26 with a right of appeal to the Court of Appeal and the House of Lords, if the Comptroller has given a decision revoking the patent.

(3) To the High Court from a decision under section 27 without any right of further appeal.

It will be noted that if a patent is opposed the law officer's decision is final, but if, instead of opposing the grant, the opponent allows the patent to be granted and then takes proceedings for revocation, the issue may be taken to the court, and in certain events to the highest court.

There seems little doubt that there has been an error in drafting this section : *see* notes to sections 25 and 26.

93. In this Act, unless the context otherwise requires,— Definitions. [1883, ss. 46, 60, 61, 117.]

"Law officer" means the Attorney-General or Solicitor-General for England :

"Prescribed" means prescribed by general rules under this Act :

"British possession" does not include the Isle of Man or the Channel Islands :

"Patent" means letters patent for an invention :

"Patentee" means the person for the time being entitled to the benefit of a patent :

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within section twenty-six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention :

"Inventor" and "applicant" shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant :

"Design" means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814 [54 Geo. 3. c. 56]) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined :

"Article" means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial and partly natural:

"Copyright" means the exclusive right to apply a design to any article in any class in which the design is registered:

"Proprietor of a new and original design,"—

(*a*) Where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed; and

(*b*) Where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(*c*) In any other case, means the author of the design;

and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

In the definition of invention "section twenty-six" of the Statute of Monopolies is an error for "section six."

Application to Scotland, Ireland, and the Isle of Man.

Application to Scotland. [1883, ss. 46, 107, 108, 109, 111.]

94. In the application of this Act to Scotland—

(1) In any action for infringement of a patent in Scotland the provisions of this Act with respect to calling in the aid of an assessor shall apply, and the action shall be tried without a jury, unless the court otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts; and for the purposes of the provisions so applied "court of appeal" shall mean any court to which such action is appealed:

(2) Any offence under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff court :

(3) Proceedings for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only, and service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act :

(4) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland in any proceedings relating to patents or to designs ; and with reference to any such proceedings, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of that Court :

(5) Notwithstanding anything in this Act, the expression "the court" shall, as respects petitions for compulsory licences on revocation which are referred by the Board of Trade to the Court in Scotland, mean any Lord Ordinary of the Court of Session, and shall in reference to proceedings in Scotland for the extension of the time of a patent mean such Lord Ordinary : [1907, s. 50.

(6) The expression "Rules of the Supreme Court" shall, except in section ninety-two of this Act, mean act of sederunt :

(7) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification, shall be served on the Comptroller, and he shall rectify the register accordingly :

(8) The expression "injunction" means "interdict."

In subsection (5) above "on" should be "or."

Application to Ireland. [1883, ss. 110, 111.]

95. In the application of this Act to Ireland—

(1) All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only:

(2) The provisions of this Act conferring a special jurisdiction on the court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Ireland in any proceedings relating to patents or to designs; and with reference to any such proceedings the term "the Court" means the High Court in Ireland:

(3) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification shall be served on the Comptroller, and he shall rectify the register accordingly.

Isle of Man. [1883, s. 112.]

96. This Act shall extend to the Isle of Man, subject to the following modifications:—

(1) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent or design competent to those courts:

(2) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court:

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal, Savings, and Short Title.

Saving for prerogative. [1883, s. 116.]

97. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the

granting of any letters patent or to the withholding of a grant thereof.

Repeal and savings.

98.—(1) The enactments mentioned in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that schedule.

(*a*) As respects the enactments mentioned in Part I. of that Schedule, as from the commencement of this Act;

(*b*) As respects the enactments mentioned in Part II. of that Schedule, as from the date when rules of the Supreme Court regulating the matters dealt with in those enactments come into operation;

(*c*) As respects the enactments mentioned in Part III. of that Schedule, as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation;

and the enactments mentioned in Part II. and Part III. of that Schedule, shall, until so repealed, have effect as if they formed part of this Act:

Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force, and may be repealed, altered or amended, as if it had been made under this Act.

[1883, s. 45, 1902, s. 3 (11).]

(2) Except where otherwise expressly provided, this Act shall extend to all patents granted and all designs registered before the commencement of this Act, and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

Short title and commencement.

99. This Act may be cited as the Patents and Designs Act, 1907, and shall, save as otherwise expressly provided, come into operation on the 1st day of January one thousand nine hundred and eight.

Section 65.

SCHEDULES.

FIRST SCHEDULE.

[1883, Sched. I.]

FEES ON INSTRUMENTS FOR OBTAINING PATENTS AND RENEWAL.

(a) Up to Sealing.

	£	s.	d.	£	s.	d.
On application for provisional protection - -	1	0	0			
On filing complete specification - - -	3	0	0			
				4	0	0
or						
On filing complete specification with first application -				4	0	0
On the sealing of the patent in respect of investigations as to anticipation - - - - - - - [1902, s.1(10).]				1	0	0

(b) Further before end of four years from date of patent.

On certificate of renewal - - - - -				50	0	0

(c) Further before end of eight years from date of patent.

On certificate of renewal - - - - -				100	0	0

*Or in lieu of the fees of £50 and £100 the following annual fees:**

Before the expiration of the fourth year from the date of the patent							10	0	0
,,	,,	,,	fifth	,,	,,	,,	10	0	0
,,	,,	,,	sixth	,,	,,	,,	10	0	0
,,	,,	,,	seventh	,,	,,	,,	10	0	0
,,	,,	,,	eighth	,,	,,	,,	15	0	0
,,	,,	,,	ninth	,,	,,	,,	15	0	0
,,	,,	,,	tenth	,,	,,	,,	20	0	0
,,	,,	,,	eleventh	,,	,,	,,	20	0	0
,,	,,	,,	twelfth	,,	,,	,,	20	0	0
,,	,,	,,	thirteenth	,,	,,	,,	20	0	0

* As to fees actually payable *see* note to section 65.

SECOND SCHEDULE.

Section 98.

ENACTMENTS REPEALED.

PART I.

Session and Chapter.	Short title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	The whole Act, except subsections (5), (6), and (7) of section twenty-six, section twenty-nine, subsections (2) and (3) of section forty-seven, and section forty-eight.
48 & 49 Vict. c. 63.	The Patents, Designs, and Trade Marks (Amendment) Act, 1885.	The whole Act.
49 & 50 Vict. c. 37.	The Patents Act, 1886 - -	The whole Act.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	The whole Act.
1 Edw. 7. c. 18.	The Patents Act, 1901 - -	The whole Act.
2 Edw. 7. c. 34.	The Patents Act, 1902 - -	The whole Act.
7 Edw. 7. c. 28.	The Patents and Designs (Amendment) Act, 1907.	The whole Act.

PART II.

Session and Chapter.	Short title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Subsections (5), (6) and (7) of section twenty-six, and section twenty-nine.

PART III.

Session and Chapter.	Short title.	Extent of Repeal.
46 & 47 Vict. c. 37.	The Patents, Designs, and Trade Marks Act, 1883.	Subsections (2) and (3) of section forty-seven and section forty-eight.

APPENDIX.

Abstracts of Recent Cases before the Comptroller and Law Officer.

Amendments on Opposition.

A patent was applied for for "a novel arrangement of railway for recreation"—a loop railway. The specification had been amended under section 18 of Act of 1883, and, as amended, had five claims. The grant was opposed on the ground that the invention had been patented on certain prior applications. The Chief Examiner refused to allow an amendment to confine the claim to the only novel feature in the invention, on the ground that it would necessitate a recasting of the specification and claims. The law officer, after considering the proposed amendment, dismissed the appeal (following *Thomas and Prevost's Application*, 16 R.P.C. 69):—"Amendments "must not be considered as a matter of course. They must be amendments "in the real sense, and not the practical rewriting of the whole specifi- "cation and the formation of some new claim." (*Crist's Application*, 20 R.P.C. 475.)

An application was made for a patent for certain improvements in the manufacture of sulphur dyestuffs. The complete specification contained a statement of the state of the art to the effect that dinitrophenol was heated with sodium sulphide and sulphur under various conditions. The improvements consisted essentially in heating the sodium salt of the dinitrophenol or its equivalent in the presence of an excess of sulphuretted hydrogren. The grant was opposed on the ground that the invention had been patented on an application of prior date. The alleged anticipating specification described a process of heating sulphuret of sodium and dinitrophenol, and adding thereto sulphur, in certain proportions. The opponent alleged (1) that the earlier patent was a master patent, (2) that its process was described in the statement of the art contained in the applicant's specification, and (3) that when a certain stage in the applicant's process was reached the subsequent reactions and substances produced were identical. He asked for a specific reference to his patent. The patent was sealed and a specific reference refused by the Chief Examiner and the law officer, on the ground that, as certain operations in the opponent's earlier process were not found in the applicant's, the latter was not previously claimed, that no reference should be allowed, and that the public would not be misled. (*Meyenberg and Clayton Aniline Co.'s Application*, 22 R.P.C. 353.)

Where the proposed amendments are insufficient to meet the case of the opponent the grant will be refused. But if the opposition be withdrawn, and the applicant appeal, it by no means follows that the appeal will be allowed. In such cases the opposition may have been withdrawn, not by reason of its not being substantiated, but for other reasons. (*Kempton and Mollan's Application*, 22 R.P.C. 573.)

Application to amend by Patentee.

A patent was granted in 1897 for certain improvements in dobby looms for weaving. In 1901 the specification was amended. Originally there were four claims. The first was for "a dobby in which the knife guides are

" inclined towards each other substantially as herein shown and described;" the second was for a "dobby which, when the jack levers are not lifting, " has the fulcrum of the bell crank levers in the same plane as the centres " of connection of the hooks to the balk levers, and in which the centre of " connection of the balk levers to the jack levers is in such a position that " in the movements of the latter, such centre passes equidistant on each side " of the said plane, substantially as herein shown and described"; the remaining claims were for specific combinations denoted by letters. The amendments made in 1901 consisted (*inter alia*) in striking out the second claim, and a portion of the letterpress in which the position of the centres of the jack levers were described by specific references to the drawings. The drawing was not altered.

An action was brought (*Hattersley* v. *Hodgson*, 20 R.P.C. 591) in which it was held that the invention was essentially one of a combination of the inclined knife guides with a particular arrangement of centres of the jack levers, but that such was not claimed, there being no reference in the letterpress to the arrangement of centres of the levers, which was essential to success.

An application was made subsequently to the Comptroller for leave to amend by explaining the drawing by restoring a paragraph that had been deleted by the previous amendment, and to narrow the claims by inserting a disclaiming note—"we make no claim to a dobby with inclined guides, " except when the centres B^4, B^6, and B^8 are arranged in relation to one " another, and to the inclined guides as shown and described"; and to insert after "each other" in claim 1 the words "and having the centres B^4, " B^6, and B^8 as shown in Fig. 2 arranged." Fig. 2 was a figure in the original specification, and the paragraph previously struck out described the centres B^4, B^6, and B^8.

The amendments were allowed by the Chief Examiner, but refused on appeal by the law officer on the ground that they would make the specification as amended claim an invention substantially different from the invention claimed by the specification as it stood before amendment. In giving his decision the law officer said, "The specification before it was " amended—purposely I think—claimed the inclined knife guides and the " alteration of the centres of the jack levers, &c., separately, in the belief " that each constituted a patentable invention. No doubt, if an application " was made to amend the claim by claiming the two in combination, there " would be a strong ground for contending that as each had been claimed " separately the claim could be limited by claiming them in combination. " The patentee, however, upon finding that he could not sustain the second " claim, instead of applying for an amendment by way of combination, " preferred to abandon his second claim and to rely upon his first claim, " which was a larger claim than in combination it would have been, and " in the form which the specification assumed after amendment. Claim 2, " and all references to it in the specification, became eliminated. . . . . " I find no reference to the suggested combination, except so far as the " drawings show it. As regards the drawings it is to be observed that they " show equally a combination of the inclined knife guides and all the " various parts of the dobby which are shown. . . . . If I were to treat " the claim as a combination of all the parts shown, including the inclined " knife guides and the alteration of centres, I should be compelled to yield " to the argument that the proposed amendment would make the invention " 'substantially larger than the invention as claimed' . . . . I am of " opinion, therefore, that I should not be justified in allowing the amend- " ment. I shall reverse the decision of the Chief Examiner, with 20 guineas " costs to be paid by the respondents to the appellants." *Hattersley and*

Jackson's Patent, 21 R.P.C. 233. [It was subsequently held in the Court of Appeal (21 R.P.C. 517) and in the House of Lords (23 R.P.C. 192) that the first claim was for a combination in a dobby of the knife guides inclined to one another and having the system of centreing shown in the drawings, that it was a good claim and the patent was valid. The proposed amendments, therefore, which were refused, appear, when the specification was construed by the House of Lords, to have been unnecessary.]

Convention Application.

The date of a certain application for a German Patent was 18th of June 1903. On 11th June 1904 an application was made under the Convention. This was not accompanied by a certified copy of the German specification and translation thereof as required by Rule 14 of the Rules of 1903. Such copy and translation were not supplied until 7th June 1905. It was then seen that there had been a mistake as to the date of the German application, which had been represented in the British application as being 30th instead of 18th June 1903. It resulted from the mistake that the German specification was not open to inspection at the expiration of 12 months from the German application as required by section 1 (2) of the Act of 1901 [now section 91 (3*a*)]. Under section 9 (4) of the Act of 1883 [now section (6) 5] the application would be void unless the specification was accepted within 12 months of the British application, that is, by 11th June 1905. There were therefore only four days left in which the Comptroller could compare the British and German specification. *Held*, that compliance with the Acts and Rules are conditions precedent to obtaining the benefits of the Convention, and that the Comptroller was justified in refusing the application to grant priority for the invention under the Convention. *In the matter of an application, &c.*, 23 R.P.C. 788.

TABLE showing the SECTIONS in the NEW ACT CORRESPONDING with the SECTIONS of the OLD ACTS which they replace.

The Patents, &c. Act of 1883 (46 & 47 Vict. c. 57.)		The Act of 1907.
Application, &c., for Patents.		
	Section.	Section.
Any person may apply. Joint applications	4	1
Application and specification	5	1, 2
Reference of application to examiner	6	3
Time for leaving complete specification	8	5
Comparison of specifications	9	6
Reports of examiners not to be published	9 (5)	68
Advertisement of acceptance	10	9
Opposition to grant	11	11
Sealing of patent	12	12, 14
Date of patent	13	13
Provisional Protection.		
Provisional protection	14	4
Protection by Complete Specification.		
Effect of acceptance of complete specification	15	10

The Patents, &c. Act of 1883—*continued.*		The Act of 1907.
	Section.	Section.
Patent.		
Extent of patent	16	14 (1)
Term of patent	17	17
Amendment.		
Amendment of specification	18	21
Leave to amend during legal proceedings	19	—
Amendment by the Court	—	22
Restriction on recovery of damages	20	23
Advertisement of amendment	21	21 (2)
Register of Patents.		
Register of patents	23	28
Fees.		
Fees as in schedule	24	65
Prolongation.		
Prolongation by Privy Council	25	—
„ „ High Court	—	18
Revocation.		
Revocation	26	25
Fraud—new patent	26 (8)	15
Delivery of particulars, etc.	26 (5, 6, 7)	—
Subject to rules of Court	—	98 (1*b*)
Crown.		
Patent to bind Crown	27	29
Legal Proceedings.		
Hearing with assessor	28	31
Delivery of particulars in action	29	—
Subject to rules of Court	—	98 (1*b*)
Order for inspection, &c.	30	34
Certificate of validity	31	35
Action to restrain threats	32	36
Miscellaneous.		
Patent for one invention only	33	14 (2)
Patent to representative of deceased inventor	34	43
Fraudulent applications	35	15 (1)
Assignment for particular places	36	14 (1)
Loss or destruction of patent	37	44
Proceedings before law officer	38	40
Industrial and International Exhibitions	39	45 (1)
Publication of journal, indexes, &c.	40	46
Patent Museum	41	47 (1)
Power to require models	42	47 (2)
Foreign vessels in British waters	43	48
Assignment to Secretary for War	44	30

The Patents, &c. Act of 1883—*continued.*	Section.	The Act of 1907. Section.
Existing Patents.		
Provisions respecting existing patents	45	—
Application of Act to existing patents	—	98 (2)
Definitions.		
Definitions	46	93, 94
Registration of Designs.		
Registrations of designs	47	49
Certificate of registration	49	51
Copyright in Design.		
Copyright in registration	50	53 (1), 54
Marking registered designs	51	54
Inspection of registered designs	52	56
Information as to copyright	53	57
Cesser of copyright	54	58
Register.		
Register of designs	55	52
Fees.		
Fees on registration, &c.	56	65
Industrial, &c., Exhibitions.		
Exhibitions	57	59 (1)
Legal Proceedings.		
Penalty for piracy of design	58	60
Action for damages	59	60
Definitions.		
Definitions	60, 61	93
Patent Office and Proceedings thereat.		
Patent Office	82	62
Offices and clerks	83	63
Seal of the Patent Office	84	64
Trusts not to be registered	85	66
Refusal to grant by Comptroller	86	75
Entry of assignments, &c. on register	87	71
Inspection, &c. of register	88	67
Sealed copies as evidence	89	79
Rectification of register by Court	90	72
Correction of clerical errors	91	70
Falsification of register	93	89
Exercise of discretion by Comptroller	94	73
Directors of law officers	95	74
Certificate of Comptroller to hear evidence	96	78
Applications, &c., by post	97	81
Excluded days at Patent Office	98	82

The Patents, &c. Act of 1883—*continued.*	Section.	The Act of 1907. Section.
Patent Office and Proceedings thereat—continued.		
Declarations by infant, &c.	99	83
Transmission of specifications, &c.	100	80
Board of Trade Rules	101	83
Annual Report of Comptroller	102	76
Convention.		
International and Colonial arrangements	103	91
India and Colonies	104	88, 91
Offences.		
False representation as to patented articles	105	89
Unauthorised use of Royal Arms	106	90
Scotland, Ireland, &c.		
Proceedings in Scotland	107, 108, 109	94
Savings as to Ireland	110	95
Savings as to jurisdiction of Courts	111	94, 95
Isle of Man	112	96
Repeals, &c.		
Former registers continued	114	28, 52
Saving for existing rules	115	98 (1)
Saving for prerogative of the Crown	116	97
General definitions	117	93
Definition of "Court"	117 (1)	92 (1)
The Patents, &c. (Amendment) Act, 1885 (48 & 49 Vict. c. 63).		
Amendment as to declarations	2	1
Extension of times	3	5, 12
Secrecy of abandoned applications	4	69
Grant to joint patentees	5	12, 21
Date of Convention protection	6	91
The Patents Act, 1886 (49 & 50 Vict. c. 37).		
Reference to drawings with provisional	2	2, 3
International exhibitions	3	45 (2), 59 (2)
Patents, &c. Act, 1888 (51 & 52 Vict. c. 50).		
Register of Patent agents	1	84, 85
Board of Trade Rules as to	1 (2)	86
Amendment or refusal of application	2	3
Secrecy of examiner's reports	3	68
Opposition on third ground	4	11
Amendment during legal proceedings	5	21 (8)
Entry of assignments on register	21	71 (3)

Patents, &c. Act, 1888—*continued.*	Section.	The Act of 1907. Section.
Inspection, &c. of register	22	67
Rectification of register	23	72 (1)
Correction of errors	24	70
Proceedings of the Board of Trade	25	87
The Patents Act, 1901 (1 Edw. 7. c. 18).		
Twelve months for Convention applications	1	91 (1*a*, 3*a*)
The Patents Act, 1902 (2 Edw. 7. c. 34).		
The official search	1	7
Secrecy of reports	1 (4)	68
Time for leaving complete specification	1 (8)	5
Fee for search	1 (10)	Sched. I.
Limits as to anticipations	2	41 (1)
Compulsory licences	3	24
Pending applications	3 (1)	98 (2)
Deputy for Comptroller	4	62
The Patents (Amendment) Act, 1907 (7 Edw. 7. c. 28). (Contains all the alterations in the law in the new Act, c. 29.)		
Patents.		
Grant to joint patentees	1	37
Drawings to be supplied if required	2	2
Deposit of samples	3	2 (5)
Supplementary provisional specifications	4	16
Patents of addition	5	19
Second official search	6	8
Refusal of patent by Comptroller	7	7 (4)
Post-dating in case of disconformity	8	6
Disconformity, limit to	9	42
New grounds of opposition	10	11 (1*b*, *c*)
Extensions of time for sealing	11	12 (*d*)
Extensions of time in other cases	12	5 (1), 6 (5), 17 (2)
Amendment of specification by Court	13	22
Comptroller's power of revocation	14	26
Revocation for non-working	15	27
Compulsory licences	16	24
Prolongation by High Court	17	18
Fraudulent applications	18	15 (2)
Particulars and procedure on revocation	19	98 (*b*)
Applications by personal representatives	20	43
Patents acquired by Admiralty	21	30

The Patents (Amendment) Act, 1907—*continued.*		The Act of 1907.
Patents—continued.	Section.	Section.
Limit to anticipation	22	41 (2)
Restriction of lapsed patents	23	20
Avoidance of conditions in contracts	24	38
Defences in infringement action	25	25 (2)
Counterclaim for revocation	26	32
Infringer's knowledge of patent	27	33
Appeals and references to Court	28	92 (2)
Designs.		
Registration of designs	29	49 (4), 69 (2)
Rules as to designs	30	86 (1)
Extension of copyright	31 (1)	53 (2, 3)
	31 (2)	55
Marking of designs	32	54 (1*b*, 2)
Registration in new class	33	50
Inspection of register	34	56
Cancellation for non-working	35	58
Penalty and damages	36	60
Threats and certificate of validity	37	61
General.		
Branch patent offices	38	62
Entries in register	39	71 (2)
Rectification of register	40	72
Correction of clerical errors	41	70
Excluded days	42	82
Penalties for false representations	43	89 (4)
Misuse of Royal Arms	44	90
Evidence before Comptroller	45	77
Costs and security for costs	46	39
Use of term "Patent Office"	47	89 (5)
Agents for patents	48	85
Application to existing patents	49	98
Application of Act to Scotland	50	94 (5, 6)
Repeals, savings, &c.	51	98

INDEX.

Page

ABANDONMENT:
of application - - - - - - - 93
of patent - - - - - - - 62
of design - - - - - - - - 93

ACT, commencement of - - - - - 109

ADMIRALTY. *See* WAR OFFICE.

ADVERTISEMENT:
of acceptance - - - - - - - 43
of amendment to specification - - - - 21, 57
by the Court - - - - - - - 58

AGENTS for patents. *See* PATENT AGENTS.

AMENDMENT - - - - - - - - 20
of application - - - - - - - 38
of provisional specification - - - - - 22
of complete specification. *See* COMPLETE SPECIFICATION.

ANTICIPATION:
not by provisional specification only - - - 79
not by complete specification 50 years old - - - 9, 79
rule as to - - - - - - - 15

APPEAL - - - - - - - - 104
on application to Comptroller for revocation - - - 62, 64
on petition for revocation - - - - 61
from refusal to accept - - - - - - 39
opposition cases - - - - - 45
from refusal to register design - - - - - 84

APPLICANT, includes personal representative of - - - 105

APPLICATION:
for patent, modes of - - - - - - 3
persons who may apply - - - - - - 3
forms and specifications required - - - - 4, 36
fee on - - - - - - - - 4, 5, 110
acceptance of - - - - - - 7, 38
first examination of - - - - - - 6, 37
abandoned - - - - - - - 93
amendment - - - - - - - - 39
under treaty arrangements. *See* CONVENTION.
for design. *See* DESIGN.

ARTICLE, definition of, as regards designs - - - - 106

BOARD OF TRADE:
jurisdiction and powers of - - - - - 3
Compulsory licences, grant of - - - - - 58–60
Rules made by - - - - - - 98
advertisement of rules - - - - - 99
acts by officials of - - - - - 99, 100

Page

CERTIFICATE of Comptroller, to be evidence - - - - 96

CHEMICAL invention, samples of - - - - 6, 37

CLAIMS:
- may be several - - - - - - - 11, 49
- construction of - - - - - - 9 *et seq.*
- samples and drawings - - - - - - 37
- each must have subject-matter - - - - 11

COGNATE INVENTIONS. *See* INVENTIONS.

COLONIAL APPLICATIONS. *See* CONVENTION.

COMPANY, as patent Agents - - - - - - 98

COMPLETE SPECIFICATION:
- application with - - - - - 4
- examination of - - - - - - - 6
- time for filing - - - - - - 7, 38
- fee on filing - - - - - - - 110
- acceptance, time for - - - - - 14, 39
  - advertisement of - - - - - 43
  - effect of - - - - - - 44
- refusal to accept - - - - - - 39
- with Convention application - - - 103, 104
  - publication of - - - - - 102, 104
- with several provisionals - - - - 49, 50
- amendment of - - - - - - 7
  - by the Comptroller - - - - 56, 57
  - by the Court - - - - - 57, 58
  - by applicant after official search - - 8, 41
  - on second search - - - - - 42
  - how shown - - - - 20, 21
  - of clerical errors - - - - - 22, 93
  - during opposition - - - - - 13
  - during action for infringement - - - - 57
  - object of - - - - - 20
  - how effected - - - - - - 21, 22
  - must be real and sufficient - - - 112
  - recent cases on - - - - - 112
  - restriction on recovery of damages - - 58

COMPTROLLER:
- powers and duties of - - - - - 2, 11, 95
- exercise of discretion by - - - - 95

See also REVOCATION, &c.

COMPULSORY LICENCE:
- petition for - - - - - - - 24
- grant of - - - - - 58–60
- revocation by Court as alternative - - - 59

COMPULSORY WORKING - - - - - - 63

CONCURRENT APPLICATIONS:
- search and references - - - - - 42
- opposition in cases of - - - - - 45

CONTRACTS:
- with regard to patents - - - - 30, 74 *et seq.*
- certain condition unlawful - - - - 74
  - defence to action - - - - - 75

Page

CONVENTION:
applications under - - - - 4, 18 *et seq.*, 101
official search - - - - - - 19
forms and fees - - - - - - 5
countries adhering to - - - - - - 18
arrangements with foreign countries and colonies - - 101–103
when come into force - - - - - 103
rules to be strictly followed - - - - 114

CO-PATENTEES, rights of - - - - - - 30, 73

COPYRIGHT in design. *See* DESIGN.

COSTS:
Comptroller or law officer has power to give - - 14, 78, 79
Comptroller can order security for - - - 78

COURT:
jurisdiction and powers of - - - - - 3
definition of - - - - - - 104

CROWN:
deceived, ground of invalidity - - - - - 25
effect of patent against - - - - - 30, 65
its officers may use invention subject to payments - - 66
saving of prerogative of - - - - - 108

DAMAGES:
none if no notice of patent - - - 27, 69 *et seq.*
none if infringer ignorant of copyright - - - 34, 86
restriction on recovery of - - - - - 51, 58

DATE:
of registration of design - - - - - 84
of patent - - - - - - - 5, 48
where disconformity - - - - - 39
of single patent for cognate inventions - - - - 5, 50
of patent issued in lieu of revoked patent - - - 49
on Convention application. *See* CONVENTION.

DECEASED INVENTOR. *See* INVENTOR.

DECLARATIONS:
accompanying application - - - - 4, 36
by representatives of deceased inventor - - - - 4, 81
evidence given by - - - - - - 95
by infant, lunatic, &c. - - - - - 97

DEFINITIONS - - - - - - - - 105
of court - - - - - - 104
for Scotch procedure - - - - - 106
for Irish procedure - - - - - 108

DESIGN:
definition of - - - - - - 31, 105
definition of article - - - - - 106
definition of copyright - - - - - 106
definition of proprietor - - - - 32, 106
registration of - - - - - - 31, 83
registration in new class - - - - - 31, 84
classes of - - - - - - 32, 84
certificate of registration - - - - - 84
register of - - - - - - 85
certain publications not to affect copyright - - - 87

Page

DESIGN—*continued.*
- inspection of - 88
- information as to existence of copyright - 88
- abandoned, application for - 93
- cancellation of - 34, 89, 93
- piracy of - 90
- marking of - 34, 86
- non-user of - 34, 89
- action to restrain threats - 34, 90
- certificate of validity - 34, 90
- marking "registered" illegally - 34, 100

DISCONFORMITY:
- examination for - 6, 38, 39
- as ground for opposition - 12, 44
- as defence and ground for revocation - 25, 61, 80

DRAWINGS:
- may be required - 5, 37
- form part of specification - 5, 37
- with registration of design - 32

EVIDENCE:
- certificate of Comptroller is - 96
- of documents, Patent Office - 96
- before the Comptroller - 11, 14 *et seq.*
  - by statutory declaration - 11, 95
  - in opposition cases - 12
  - on revocation proceedings - 23

EXAMINATION:
- of application - 6, 37, 38
- of complete specification - 6, 39
- *See* OFFICIAL SEARCH.

EXCLUDED DAYS - 97

EXHIBITIONS, protection to exhibitors - 82, 89

EXISTING PATENTS, application of Act to - 109

EXTENSION:
- of term of patent. *See* PROLONGATION.
- of time for leaving complete specification - 38
- for acceptance of complete specification - 39
- for sealing of patent - 47
- for paying renewal fees - 50, 51

FALSE REPRESENTATIONS as to "patented," "registered" - 100

FEES:
- for registration of design - 33
  - sealing of patent, how paid - 48, 110
  - renewal of patent - 92
  - maximum in schedule - 92, 110
  - none for patent of addition - 53
  - extension of time for paying - 50, 51

FRAUD:
- application by - 49
- revocation on ground of - 60

HIGH COURT. *See* COURT.

HOLIDAYS, excluded days at Patent Office - 97

Page

IMPROVEMENT:
patent of, addition for - - - - - - 53
separate patent for - - - - - 39

INFANT, declarations, &c., by - - - - - - 97

INFRINGEMENT:
action for - - - - - - 27
defences in - - - - - - - 27, 60
amendment during - - - - - 22, 57

INSUFFICIENCY, a ground of opposition - - - - 44, 46

INTERDICT in Scotland - - - - - 107

INTERNATIONAL CONVENTION. *See* CONVENTION.

INVENTION:
definition of - - - - - - 2, 105
patent for one only - - - - - - 49
single patent for cognate - - - - 5, 49

INVENTOR:
representative of deceased, may apply - - - 3, 81, 105
declarations required - - - - 4, 81

IRELAND, application of Act to - - - - - 108

ISLE OF MAN, application of Act to - - - - 108

JOURNAL of Patents - - - - - - 82

LAPSE OF PATENT, restoration of lapsed patent - - - 54

LAW OFFICER:
definition of - - - - - - 105
directions of, for Comptroller - - - - - 95
compulsory licence petition, appears on - - - 59
appeal to:
as to refusal:
of acceptance - - - - - 39
of patent - - - - - 41
as to official search - - - - - 41
in opposition cases - - - - - 45

LEGAL PROCEEDINGS:
revocation by the Court - - - - - 24, 60
action:
for infringement - - - - - 27
counterclaim for revocation - - - - 68
order for inspection - - - - - 72
certificate of validity - - - - 72, 90
hearing with assessor - - - - - 68
exemption of innocent infringer - - - - 69–72, 86
amendment during - - - - - 22, 57
remedy for groundless threats of - - - - 72, 90

LUNATIC, declarations, &c. by - - - - - 97

MUSEUM, Patent - - - - - - - 83

NOVELTY, search for. *See* OFFICIAL SEARCH.

OFFENCES:
misuse of "patent agent" - - - - - 97
falsification of register - - - - - 100
false representation as to "patented," "registered" - - 100
misuse of term "Patent Office" - - - - - 101
unauthorised use of Royal Arms - - - - 101

Page

OFFICIAL SEARCH:
time for and mode of - - - - - - 7, 40
limits of - - - - - - 9
on Convention applications - - - - - 19
second search after grant - - - - - 8, 42
refusal of patent on - - - - - - 41
amendment. *See* COMPLETE SPECIFICATION.

OPPOSITION TO GRANT OF PATENT - - - 12, 44–47
grounds for and procedure - - - - 12, 44
hearing and evidence - - - - - 13–17
amendment during - - - - - - 13
appeal to law officer - - - - 14, 45
costs - - - - - - - - 14
insertion of references - - - - 13, 14
successful, patent not necessarily refused - - - - 45
recent cases - - - - - - 112

ORDERS IN COUNCIL:
effect of - - - - - - - - 100
arrangements with foreign countries, &c. - - - 103

PATENT:
defined - - - - - - - 105
date of - - - - - - - - 5, 48
effect of - - - - - - - 48
term of - - - - - - - - 50
application for. *See* APPLICATION.
may be refused if not for an invention - - - 11
sealing - - - - - - - 20, 47, 48
fraudulent applications for - - - - 49
new issue of, on revocation for fraud - - - - 26, 49
issue of duplicate if lost - - - - 82
abandonment of - - - - - - - 62
prolongation of - - - - - - 51
lapse through non-payment of fees - - - - 50, 51
restoration of - - - - - - 54

PATENTEE:
definition of - - - - - - 105
must work - - - - - - - 30
must not prejudice industry - - - - 30
should mark articles - - - - - - 30

PATENTS OF ADDITION - - - - - 20, 53, 54

PATENT AGENTS - - - - - - - 34, 98
register of - - - - - - 97, 98
misuse of term "patent agent" - - - - - 97
rules as to - - - - - - - 98

PATENT OFFICE - - - - - - - 91
branches - - - - - - - 91
officers - - - - - - - - 91
privilege of reports of officers - - - - 92
seal of - - - - - - - - 92
Journal - - - - - - - 82
museum - - - - - - - - 83
evidence of documents in - - - - 96

Page

PATENT OFFICE—*continued.*
excluded days at - - - - - - 97
misuse of term "Patent Office" - - - - 101
register. *See* REGISTER of PATENTS and DESIGNS.

PETITION for compulsory licence, &c. *See* COMPULSORY LICENCE, &c.

POST, documents sent by - - - - - 97

PREROGATIVE OF CROWN. *See* CROWN.

"PRESCRIBED," meaning of - - - - - - 105

PRIOR APPLICATION, when search extends to - - - 42, 43

PRIOR GRANT:
what is - - - - - - - - 9
search to avoid - - - - - 42, 43

PROLONGATION:
of patent - - - - - - - 26, 51–3
of design - - - - - - 85

PROPRIETOR:
rights of, registered - - - - - 28, 94
of design - - - - - 32, 106

PROVISIONAL PROTECTION - - - - - - 38

PROVISIONAL SPECIFICATION:
application with - - - - - - 4, 36
contents of - - - - - - 4, 36, 37
supplementary - - - - - 5, 49
amendment of - - - - - - - 22

REFERENCES:
in consequence of official search - - - - 41, 42
none if claim sufficiently restricted - - - - 11
in opposition cases - - - - - 13, 14

REFUSAL:
of patent by Comptroller - - - - - - 8, 41
for illegality - - - - - - - 95

REGISTER OF PATENTS AND DESIGNS - - - - - 28–30
establishment of - - - - - 65
falsification of - - - - - - - 100
proceedings as to designs - - - - 34, 85
no entry of trusts - - - - - - 29, 92
inspection of, extracts from - - - - 92
rectification of, by court - - - - - 29, 34, 94
service of Scottish and Irish orders on Comptroller - 107, 108
correction of clerical errors - - - - - 93
different classes of entries - - - - - 28
of patent agents - - - - - - 97, 98

REGISTRATION:
of designs. *See* DESIGNS.
of title to patent - - - - 28, 65, 93
rights given by - - - - - - 28, 94
practice - - - - - - 29
whether necessary before suing - - - - 30

Page

RENEWAL FEES - - - - - - 92
maximum authorised - - - - - 92, 110
failure to pay, avoids patent - - - - 50

REPEAL:
of older Acts - - - - - - 109, 111
comparative table of enactments - - - - 114

REPORT, Annual, to Parliament - - - - - 95

RESTORATION of lapsed patent - - - - - 26, 54–56

REVOCATION:
by Comptroller - - - - - 22, 61–63
who may apply - - - - - - 61
grounds for - - - - - - 62
appeal - - - - - - 63
for non-working - - - - 23, 63–65
by Board of Trade - - - - - 24, 58
by Court:
grounds for - - - - - 24, 60
who may petition - - - - - 26, 61
appeal - - - - - - 61
may be sought by counterclaim - - - - 68
in Scotland by action of reduction - - - 107
for fraud, grant of new patent - - - - 49
of patent of addition - - - - - 54

ROYAL ARMS, unauthorised use of - - - - - 101

RULES OF BOARD OF TRADE - - - - - 98, 99

RULES OF SUPREME COURT, substituted - - - - 109

SAMPLES, when required - - - - - 6, 37

SCOTLAND, application of Act to - - - - - 106–107

SEALING OF PATENT - - - - - 20
time for - - - - - - - - 47
mode of applying for - - - - - 48
effect of - - - - - - - - 48
fee on - - - - - - 20, 110

SECURITY FOR COSTS. *See* COSTS.

SHIPS, use of patented invention on foreign - - - - 83

SPECIFICATIONS:
when not anticipations - - - - - 79
to be sent to public bodies - - - - - 96
See also COMPLETE SPECIFICATION.
PROVISIONAL SPECIFICATION.

SUBJECT MATTER, meaning of - - - - 25

TECHNICAL TERMS, to be explained by evidence - - - 11, 17

TERM:
of patent - - - - - - 50
of patent of addition - - - - - - 53

THREATS, action for groundless - - - 27, 34, 72, 90

Page

TIME:
for leaving complete specification - - - - - 38
for acceptance of - - - - - - - 39
for sealing - - - - - - - - 47

TITLE:
to commence specification - - - - - - 37
object and extent of - - - - - - - 4
registration of. *See* REGISTRATION OF TITLE.

WAR OFFICE OR ADMIRALTY:
may acquire patent - - - - - - 30, 66
may keep patent secret - - - - - - 30, 66

MIDDLE
TEMPLE